



TTAB

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January 12, 2010

**VIA EXPRESS MAIL**

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

Attention: Cheryl Goodman, Interlocutory Attorney

# 78751105

**Re: UMG Recordings, Inc., Opposer v. Mattel, Inc., Applicant**  
**Opposition No.: 91176791**

Dear Ms. Goodman,

Enclosed please find the following documents in connection with the above-referenced Opposition:

1. Motion to File Trial Brief of Opposer UMG Recordings, Inc., In Support Of Notice Of Opposition Under Seal;
2. Trial Brief of Opposer UMG Recordings, Inc., In Support Of Notice Of Opposition (redacted version and "under seal" version);
3. Opposer UMG Recordings, Inc.'s Evidentiary Objections to Evidence of Applicant Mattel, Inc.; and,
4. Appendix of Cases to Trial Brief of Opposer UMG Recordings, Inc., Pursuant to Official Gazette Notice of 23 January 2007.

Sincerely,

Alexa L. Lewis  
MITCHELL SILBERBERG & KNUPP LLP



01-11-2010

Enclosures -- As noted.

U.S. Patent & Trademark Office Report 01-11-2010

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 78/751,105  
Published for Opposition in the OFFICIAL GAZETTE on December 12, 2006

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UMG RECORDINGS, INC.

Opposition No.: 91176791

Opposer

v.

MATTEL, INC.,


Applicant

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**MOTION TO FILE TRIAL BRIEF OF OPPOSER UMG RECORDINGS, INC.,**  
**IN SUPPORT OF NOTICE OF OPPOSITION UNDER SEAL**

Opposer, UMG Recordings, Inc. ("Opposer"), by its counsel, submits the Trial Brief of Opposer UMG Recordings, Inc., In Support of Notice of Opposition, which contain material that has been designated as confidential pursuant to the provisions of the Board's Standard Protective Order, under seal, respectfully requests that the Board maintain the confidentiality of said document. 37 C.F.R. § 126(c). Opposer contemporaneously files a redacted version of that document.

Date: January 12, 2010




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**CERTIFICATE OF MAILING**

Date of Deposit: January 12, 2010

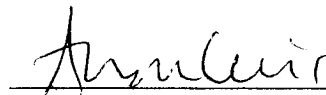
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I hereby certify that this paper or fee, **MOTION TO FILE TRIAL BRIEF OF OPPOSER UMG RECORDINGS, INC., IN SUPPORT OF NOTICE OF OPPOSITION UNDER SEAL**, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" on the date indicated above and is addressed to: UNITED STATES PATENT AND TRADEMARK OFFICE, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451.

  
\_\_\_\_\_  
Alexa L. Lewis

**CERTIFICATE OF SERVICE**

I hereby certify that on this 12th day of January, 2010, a true and correct copy of the foregoing **MOTION TO FILE TRIAL BRIEF OF OPPOSER UMG RECORDINGS, INC., IN SUPPORT OF NOTICE OF OPPOSITION UNDER SEAL**, was served upon Opposer's counsel of record by hand delivery, to the following address: Lawrence Y. Iser, Patricia A. Millett, Chad R. Fitzgerald, Kinsella, Weitzman, Iser, Kump & Aldisert LLP, 808 Wilshire Boulevard, 3rd Floor, Santa Monica, CA 90401.

  
\_\_\_\_\_  
Alexa L. Lewis



ORIGINAL

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 78/751,105

Published for Opposition in the OFFICIAL GAZETTE on December 12, 2006

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UMG RECORDINGS, INC.,

Opposition No.: 91176791

Opposer

v.

MATTEL, INC.,

Applicant

---

**TRIAL BRIEF OF OPPOSER UMG RECORDINGS, INC.,**

**IN SUPPORT OF NOTICE OF OPPOSITION**

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## I. INTRODUCTION

This is a simple case. The MOTOWN Mark was created almost fifty years ago by the predecessor to Opposer UMG Recordings, Inc., it has been in continuous, nationwide use since then, is the subject of numerous registrations encompassing a family of marks, and has been widely recognized by the public and the media as a famous mark, including as discussed in the Board's recent, precedential decision UMG Recordings, Inc. v. O'Rourke, 92 U.S.P.Q.2d 1042 (T.T.A.B. 2009).

Opposer has used (or has licensed the use of) the MOTOWN family of marks on a variety of goods, not limited to musical recordings, but spanning such diverse products as T-shirts, hats and other clothing, merchandise such as magnets, pins, wristbands, totebags, glassware, and coasters, and "Motown Cafés" in Orlando, New York, and Las Vegas, among many others. Of particular interest in this Opposition, licensed goods bearing the MOTOWN Mark also include toys, games, and playthings. Applicant seeks to use the identical mark, MOTOWN (including also the use of a capital "M" in conjunction with the mark, which also is subject to Opposer's registrations) on the same category of goods as Opposer, toys, games, and playthings (although unlike Opposer, Applicant's use is minimal and essentially gratuitous).

In the face of these indisputable facts, Applicant relies on two irrelevant arguments, and virtually all of its submitted evidence is based on these two arguments: *First*, that MOTOWN has come to be used as (one of several) nicknames for the city of Detroit. But even assuming that to be true, it is unavailing to Applicant. Opposer created and used the MOTOWN Mark at least a decade before it was ever applied to Detroit; Opposer's use has been a trademark use and (although unnecessary) it has a secondary meaning, whereas no evidence submitted indicates that Detroit (or anyone else) has made such a trademark use of the word MOTOWN; and, in any

event, geographic terms (assuming without conceding MOTOWN is such a term), even those (unlike here) which *precede* the trademark use, can be valid trademarks.

*Second*, Applicant's sole expert opines that MOTOWN has come to describe a "style" of music. That argument, too, does not help Applicant. Applicant's use of the MOTOWN Mark is decidedly not for the purpose of describing a musical style. More important (again assuming without conceding that there is a "Motown style"), that designation merely would reinforce the trademark significance of Opposer's mark, as the style it refers to is the style created by Opposer. In contrast to Applicant's expert -- a musicologist who has no experience or expertise in marketing or branding, Opposer's expert -- who has precisely this relevant experience -- provides probative evidence in support of the Opposition, as more fully described herein. Tellingly, although it had the opportunity to do so, Applicant did not provide the Board with any rebuttal expert testimony. See 4 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 23:2.75 at 23-19 (2009) (hereinafter "McCarthy") ("expert testimony on the factual factors that go into the ultimate finding on the confusion issue is generally quite proper and helpful to both judge and jury").

The Board recently held in O'Rourke that there was a likelihood of confusion between MTOWN CLOTHING and Opposer's MOTOWN Mark and sustained the opposition. O'Rourke, 92 U.S.P.Q.2d at 1050. Here, unlike in O'Rourke, the marks are essentially identical and inevitably a likelihood of confusion exists between Applicant's mark and Opposer's. Moreover, Applicant's use of MOTOWN METAL dilutes Opposer's famous MOTOWN Mark. The Board should sustain this Opposition and reject the application.

## **II. STATEMENT OF ISSUES**

The issues are:

- 1) Whether there exists a likelihood of confusion between Opposer's MOTOWN Mark and MOTOWN METAL under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).
- 2) Whether Applicant's use of MOTOWN METAL dilutes Opposer's famous MOTOWN Mark, in violation of Section 2(c) of the Lanham Act, 15 U.S.C. § 1125(c).

## **III. DESCRIPTION OF THE RECORD**

### **A. Stipulations of the Parties**

The parties have stipulated to the introduction of evidence as follows:

- 1) The parties stipulated to the submission of testimony by declaration. (Stipulation for Introduction of Evidence at Trial, dated February 5, 2009, and filed March 2, 2009.)
- 2) The parties stipulated to the submission of evidence filed by Opposer in UMG Recordings, Inc. v. O'Rourke. (Id.)
- 3) The parties stipulated that documents produced in discovery in the instant proceedings may be relied on at trial. (Stipulation for Introduction of Evidence at Trial, dated and filed June 17, 2009.)

### **B. Opposer's Evidence**

Opposer submitted the following:

- 1) Notices of Reliance:
  - U.S. Trademark Registrations And Other Official Documents
  - Produced Evidence
  - Written Discovery Responses

- Printed Publications
- Printed Publications (supplemental)
- Discovery Depositions
- Evidence Filed In UMG Recordings, Inc. v. O'Rourke
- Official Records

2) Trial Declarations:

- Gary Atkinson (“Atkinson Decl.”)
- Peter Caparis (“Caparis Decl.”)
- Melissa K. Cote (“Cote Decl.”)
- Diana Czapla (“Czapla Decl.”)
- Anton Handal (“Handal Decl.”)
- Jerry Juste (“Juste Decl.”)
- Michael Rajna (“Rajna Decl.”)
- William Schulte (“Schulte Decl.”)
- William Waddell (“Waddell Decl.”)

3) Request for Judicial Notice Re: Websites

**C. Applicant’s Evidence**

In addition to Applicant's Trademark Application Serial No. 78/751,105, Applicant submitted the following:

1) Notices of Reliance:

- Produced Evidence (vols. 1-2)
- Printed Publications (vols. 1-7)

- Printed Publications (supplemental, vols. 1-2)
  - Discovery Depositions (vols. 1-3)
- 2) Trial Declarations:
- Raymond Adler (vols. 1-3)
  - Christopher Bouman
  - Lawrence Ferrara (“Ferrara Decl.”)
  - Jan Heininger

#### **IV. RECITATION OF FACTS**

##### **A. Opposer’s Rights in the MOTOWN Mark**

###### **1. A Brief History of MOTOWN**

The MOTOWN recording label was founded in 1959 by Berry Gordy, Jr. and met with almost immediate success. (Juste Decl., ¶ 4.) As discussed in further detail below, throughout the label’s five decades in existence, its recognition in the media and among consumers has grown to a level virtually unmatched by any other recording label.<sup>1</sup> (Id., ¶¶ 3, 13.)

The 1960s: Between 1961 and 1971, Motown released more than 160 “Top-20” hits, including recordings by Stevie Wonder, Marvin Gaye, Diana Ross & The Supremes, The Four Tops, The Jackson 5, The Temptations, Martha & The Vandellas, Gladys Knight & The Pips, and many other widely recognized artists. (Id., ¶ 5.) In 1968 alone, an unprecedented seventy-five percent of Motown’s releases made the national top-selling record charts. (Id.) Motown’s renown extended beyond music: Motown’s artists were featured on the cover of general-interest

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<sup>1</sup> A more detailed history is included in Mr. Juste’s Trial Declaration, paragraphs 4 through 14.

publications such as Time magazine and Motown itself received considerable media coverage. (Id.)

The 1970s: During the 1970s, Motown released an average of one “Top-10” hit every three weeks, including releases by well-known and highly successful artists as Stevie Wonder, Marvin Gaye, Diana Ross, Smokey Robinson, and the Commodores. (Id.) MOTOWN recordings and artists also received numerous prestigious and highly publicized music-industry awards. For example, Stevie Wonder won several Grammy Awards in 1975, and Rolling Stone magazine named Marvin Gaye’s 1971 MOTOWN release “What’s Going On” as Album of The Year and his 1973 MOTOWN single “Let’s Get It On” as Best Single of the Year. (Id.) Motown also branched out into film, broadening the recognition of the MOTOWN Mark to an even wider audience. MOTOWN films of the 1970s included “Lady Sings the Blues,” for which Motown artist Diana Ross (who played the part of legendary jazz singer Billie Holliday), received an Oscar nomination for Best Actress, “Thank God Its Friday,” and “The Wiz,” the latter of which featured several famous Motown artists, including Diana Ross and Michael Jackson. (Id.)

The 1980s: Motown’s commercial success and public recognition continued in the 1980s (Id., ¶ 8) even after it moved from Detroit in the early 1970s. (See, e.g., Caparis Decl., Exs. 13-14.) In addition to albums by established Motown artists such as Stevie Wonder, Diana Ross, and Smokey Robinson (whom Rolling Stone magazine declared Best Soul Artist of 1980), Motown released hits from emerging talent such as Rick James, DeBarge, and Lionel Ritchie. (Juste Decl., ¶ 8.) Motown artists continued to win top music industry awards in the 1980s. For example, Stevie Wonder and Lionel Ritchie each won an Oscar Award for Best Song In A

Motion Picture, and Motown legends Smokey Robinson, Marvin Gaye, and Berry Gordy, Jr., were inducted into the Rock & Roll Hall of Fame. (Id.)

The 1960s-era MOTOWN remained popular in the 1980s, as demonstrated by its prominence in a top-rated television special entitled “Motown 25: Yesterday, Today and Forever,” as well as in the acclaimed motion picture “The Big Chill.” (Id.) Motown’s two soundtrack albums from “The Big Chill” have sold more than seven million copies, with the first album surpassing the six times Platinum mark as determined by the Recording Industry Association of America, Inc. (“RIAA”),<sup>2</sup> making it one of the top-one hundred best-selling albums of all time. (Id., ¶¶ 8, 11 & Exs. C, D, E.)

The 1990s: During the 1990s Motown continued to release successful records, including some of the best-selling albums of all time. In the 1990s alone, more than fifty MOTOWN records surpassed the RIAA’s Gold, Platinum, and/or Multi-Platinum certification levels. For example, Boys II Men’s 1994 album “II,” released by Motown, sold a total of 25 million copies worldwide, including more than 12 million copies in the United States, making it one of the all-time domestic “Top 50” best-selling albums. (Id., ¶¶ 9, 11 & Ex. E.)

Motown Today: Motown continues to sell its classic recordings and to release widely acclaimed hit music by modern popular artists such as Erykah Badu, Nelly, Akon, and Lil Wayne. (Id., ¶ 9.) Since 2000, more than thirty MOTOWN albums have surpassed the RIAA’s Gold, Platinum, and/or Multi-Platinum certification thresholds. (Id., ¶ 10 & Ex. C.)

The achievements over the lifetime of the MOTOWN label are among the most impressive in the music industry. (Id., ¶ 11.) In total, Motown has sold more than eighty Gold

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<sup>2</sup> RIAA issues Gold Record certification when U.S. sales exceed 500,000 copies, Platinum Record certification when U.S. sales exceed 1,000,000 copies, and Multi-Platinum Record certifications for every 1,000,000 records sold thereafter. (Id., ¶ 10, n. 2 & Ex. D.)

albums, more than forty Platinum albums, and fourteen Multi-Platinum albums. (Id., ¶ 11 & Ex. C.) Motown has five entries on the “Top 100” Albums of all time (based on U.S. sales). (Id., ¶ 11 & Ex. E.) And over the course of its history, Motown has had over 50 Number-One Singles in the United States on Billboard Magazine's “The Billboard Hot 100” and over 150 Number-One hits across the Billboard charts (e.g., Pop, R&B). (Id., ¶ 11.) See O’Rourke, 92 U.S.P.Q.2d at 1048 (“the record is substantial that the ‘Motown’ legacy and contributions to the music industry are well-known”).

## 2. The MOTOWN Mark and the Success of the MOTOWN Brand

For almost fifty years, Opposer has used and licensed others to use the MOTOWN Mark in connection with a wide range of goods and services, including not only musical and theatrical sound and video recordings (in all principal recording formats), but also for live concert events, clothing, headwear, footwear, and various other merchandise and services. (Trial Declaration of Lori Froeling, ¶¶ 3-4, 7-13, attached as Exhibit A to Notice of Reliance re Evidence Filed In UMG Recordings, Inc. v. O’Rourke (“Froeling Decl.”))

Opposer’s audio and video recordings bearing the MOTOWN Mark have been immensely successful, generating [REDACTED] of dollars in sales. (Id., ¶ 4 & Ex. 14 **confidential**.) Motown’s enduring impact over the course of the last half-century is demonstrated by the fact that its classic recordings still, to this day, are top sellers. Over a recent five-year period, Opposer’s sales of classic MOTOWN records from the MOTOWN catalog alone have exceeded [REDACTED] (Id. **confidential**.)

The value of the MOTOWN brand to Opposer and its renown to consumers extends well beyond music. Capitalizing on the pervasive fame of the MOTOWN brand, Opposer has entered into numerous license agreements with third parties for use of the MOTOWN Mark in connection with a variety of goods and services, including such diverse products as T-shirts, hats



and other clothing, and merchandise such as magnets, pins, wristbands, totebags, glassware, and coasters, among many others. (Id., ¶¶ 7-12 & Exs. 18-23; Waddell Decl., ¶¶ 3-9 & Exs. I-T; Caparis Decl., ¶ 7 & Ex. 11.) Additionally, Opposer has licensed Motown Cafés in Orlando, New York, and Las Vegas, and is the subject of the Motown Historical Museum. As the Board recently noted, “Opposer’s licensed or franchised operators may utilize décor and displays of memorabilia that draw an association between Opposer’s history in the music industry and the items marketed in locations such as the Motown Music Review store in the Detroit airport and the Motown Café Orlando.” O’Rourke at 1049. Further, “[a] licensing arrangement beginning in 1988 with the Motown Historical Museum covers the sale of clothing bearing the MOTOWN Marks.” (Id. at 15. See also Caparis Decl., ¶ 5 and Exs. 8, 11.) Such licensing activity has generated significant additional fame for the MOTOWN Mark and revenue for Opposer. (Froeling Decl., ¶ 7; Waddell Decl., ¶¶ 3, 10 & Exs. I, U.)

Among Opposer’s licensed goods bearing the MOTOWN Mark are the related categories of toys, games, and playthings, which have generated in excess of [REDACTED] dollars in sales since 2005 alone. (See, e.g., Czapla Decl., ¶ 8 & Ex. 4; Schulte Decl., ¶ 6; Atkinson Decl., ¶ 3 & Ex. 1; Cote Decl., ¶ 6 & Ex. 5. **Confidential.**) Opposer’s licensees in that field include the following:

- *Konami Inc.*: Under a license from Opposer dated November 16, 2004, Konami Inc. has used at least the following marks in connection with the video game “Karaoke Revolution”:

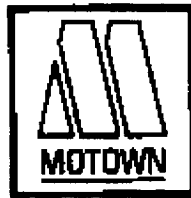
MOTOWN



(Waddell Decl., ¶ 8 & Exs. P, Q; Rajna Decl., ¶¶ 2-5 & Exs. 1-2.)

• *Late for the Sky Production Company*: Under a license from Opposer dated October 31, 2002, Late for the Sky Production Company has used at least the following marks in connection with the board game “Motownopoly”:

**MOTOWN**



(Waddell Decl., ¶ 6 & Exs. L, M; Schulte Decl., ¶¶ 2-5 & Exs. 1-2.)

• *The Singing Machine Company*: Under a license from Opposer dated February 7, 2003 (amended on or around November 30, 2004), The Singing Machine Company has used at least the following marks in connection with Karaoke CDGs and a Karaoke machine:

**MOTOWN**



(Waddell Decl., ¶ 7 & Exs. N, O; Handal Decl., ¶¶ 2-5 & Exs. 1-3.)

• *Hasbro, Inc.*: Under, respectively, a license from Opposer dated May 19, 2004, and a license relationship with Opposer entered into on or around November 6, 2008, Hasbro, Inc. has used at least the following marks in connection with “Hit Clips” and “ToothTunes”:

**MOTOWN**



(Waddell Decl., ¶ 9 & Exs. R-T; Cote Decl., ¶¶ 2-5 & Exs. 1-3.)

• *CA One Services*: Under a license from Opposer dated December 1, 2001, CA One Services has used at least the following marks in connection with a variety of toys, games and playthings, including a toy stuffed bear, a novelty pencil, a light-up ball, a toy mood light, a toy harmonica keychain, and a jumbo novelty pen:

**MOTOWN**



**MOTOWN MUSIC REVIEW**

**MOTOWN MUSIC**

(Waddell Decl., ¶ 5 & Exs. J, K; Czapla Decl., ¶¶ 3-7 & Exs. 1-3.)

In addition, one of Opposer's predecessors established Motown Animation, which through Image Comics manufactured and sold comic books employing at least the following marks:

**MOTOWN  
MACHINEWORKS**



(Juste Decl., ¶ 14 & Ex. H.)

3. Advertising, Promotion, and Media Coverage of the MOTOWN Mark

The MOTOWN Mark is so famous and MOTOWN is such an iconic brand in American culture that any further advertising and promotion of the MOTOWN Mark would be superfluous. (Each of the many millions of copies of recordings sold by Opposer over the past fifty years include the MOTOWN Mark.) Nevertheless, to further bolster the MOTOWN brand, Opposer continues to spend significant sums advertising and promoting its goods and services all of which display the MOTOWN Mark. (Froeling Decl., ¶¶ 5-6.). For example, during the five-year period from 2003 through 2007, Opposer spent over [REDACTED] advertising and promoting the MOTOWN products and brand. (Id. ¶ 5 & Ex. 16 **confidential**.) Opposer also markets and promotes its goods and services under the MOTOWN Mark through its popular website at www.motown.com, which was registered in 1995, and which attracts approximately 10,000 unique U.S. visitors per month. (Id., ¶ 6 & Ex. 17.)

MOTOWN and its lengthy history often are chronicled in popular books and reference publications. Some of the numerous books written exclusively about Motown, in addition to Berry Gordy's own book, To Be Loved: The Music, The Magic, The Memories of Motown,

include P. Benjaminson, The Story of Motown (1979); D. Waller, The Motown Story: The Inside Story of America's Most Popular Music (1985); S. Davis, Motown: The History (1988); J. R. Taraborelli, Hot Wax, City Cool and Solid Gold: Motown (1986); B. Fong-Torres, The Motown Album (1990); and G. L. Early, One Nation Under A Groove: Motown and American Culture (revised ed. 2004). (Caparis Decl. ¶ 4 & Ex. 3.) The widespread general media coverage of Motown's recently celebrated 50th anniversary, which coincided with the release of a 10-CD boxed set containing all of Motown's #1 singles, included feature articles in Vanity Fair ("It Happened In Hitsville" [December 2008]) and the New York Times ("Motown Turns Fifty, But the Party's Far from Over" [September 5, 2009]). (Id., ¶ 4 & Exs. 4-5.)

***MOTOWN is even referred to in dictionaries as a "trademark," including in evidence submitted by Applicant.*** (See Caparis Decl., ¶ 6 & Ex. 10, citing The New Grove Dictionary of Music and Musicians (2d ed. 2001), attached to Ferrara Decl. as Ex. B, pp. 17-18 ("Motown: American record company specializing in black soul music; the name is the registered trademark of the company") and The World Book Dictionary (2003) (referring to "Motown" as "a trademark of a Detroit record company").)

4. Opposer's Federal Registrations for the MOTOWN Mark<sup>3</sup>

In addition to Opposer's strong common law rights that derive from decades of use of the MOTOWN Mark as outlined above, Opposer owns several federal registrations for the MOTOWN Mark, many of which have been registered for decades, including the following:

- Registration No. 881,471: **MOTOWN** for "providing popular musical entertainment," registered in 1969;

- Registration No. 985,972:

**MOTOWN**

for "phonograph records, tapes and cassettes," registered in 1974;

- Registration No. 985,976:



for "phonograph records, tapes and cassettes," registered in 1974;

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<sup>3</sup> Applicant's fourth affirmative defense states that "UMG has not registered the marks MOTOWN and/or MOTOWN and Design for 'toys, games and playthings, namely, toy vehicles and accessories therefor,' in Class 28, the class in which Mattel seeks to register MOTOWN METAL." However, even if Opposer were solely relying on its (unregistered) use of MOTOWN in connection with toys, games, and playthings (which it is not), an opposition may be based on common law use. Fossil, Inc. v. Fossil Group, 49 U.S.P.Q.2d 1451 at \*3 (T.T.A.B. 1998) ("[I]t is quite true that an opposer is not limited in an opposition to relying solely on those marks for which it has registrations. An opposer can rely upon other forms of its marks or indeed other marks for which it lacks registrations, provided opposer is the prior user."); see O'Rourke, 92 U.S.P.Q.2d 1042 (sustaining opposition to MTOWN CLOTHING mark, even though at the time Opposer did not have a registration in that category of goods).

- Registration No. 1,075,409:



for “records, tapes, cassettes, cartridges and audio video reproducing devices in the form of tapes, cassettes, disks and cartridges,” registered in 1977;

- Registration No. 2,516,930:



for “musical sound recordings,” registered in 2001;

- Registration No. 2,767,101: **MOTOWN** for “restaurant services,” registered in 2003;
- Registration No. 3,073,897: **MOTOWN MUSIC REVIEW** for “retail gift store featuring music, clothing, reading materials and souvenirs,” registered in 2006; and,
- Registration No. 3,550,672: **MOTOWN** for “footwear; shoes; ties; hats; caps; jackets; scarves; shirts; visors; sweat shirts; sweat pants; sweat jackets; sweaters; t-shirts; tank tops; tops; wrist bands; and childrens’ clothing, namely, infantwear, headwear, shirts, t-shirts, tank tops, cloth bibs, sweat shirts,” registered in 2008.

**B. Applicant's Use of and Application to Register MOTOWN METAL**

On November 10, 2005, Applicant filed Application Serial No. 78/751,105 ("the Application"), which attempts to register MOTOWN METAL in connection with "toys, games and playthings, namely, toy vehicles and accessories therefor." The Application was published for opposition on December 12, 2006.

Applicant asserts that it began use of MOTOWN METAL in commerce in or about the second quarter of 2006. (Mattel's Response to UMG Interrogatory No. 10, attached as Exhibit B to Notice of Reliance re: Discovery Responses ("Mattel's Response to UMG Interrogatory").) However, it has used that mark in connection with only two varieties of die-cast toy cars: the "basic" Hot Wheels car, and a special "collector's edition" car, and with a total of only five individual cars and one two-car set out of more than 200 cars marketed yearly under the Hot Wheels name. (Mattel's Response to UMG Interrogatory No. 1; Adler Depo. at 35:21-36:4, attached as Exhibit C to Notice of Reliance re: Discovery Depositions ("Adler Depo."); Bouman Depo. at 30:4-10, attached as Exhibit D to Notice of Reliance re: Discovery Depositions ("Bouman Depo.").) In its packaging, Applicant used MOTOWN METAL in conjunction with an "M" design mark:



(Caparis Decl., ¶ 12 & Ex. 17 at 138.) Applicant claims it ceased using MOTOWN METAL in 2007 and has no plans to reinstate its use. (Mattel's Supplemental Response to UMG's Interrogatory Nos. 11, 13, attached as Exhibit C to Notice of Reliance re: Discovery Responses ("Mattel's Supplemental Response to UMG's Interrogatory").)



## V. ARGUMENT

Throughout this Opposition proceeding, Applicant has all but conceded the merits of Opposer's claims of likelihood of confusion and dilution, focusing instead on its primary "defenses" -- that MOTOWN is purportedly geographically descriptive of Detroit or is a "style of music." Therefore, Opposer explains first the lack of merit to those specific "defenses," then turns to the merits of its claims and establishes both likelihood of confusion and dilution.

### A. Applicant's Primary Defense, That MOTOWN Is Geographically Descriptive of Detroit, Is Unavailing.<sup>4</sup>

Applicant alleges that the word "Motown" is geographically descriptive. "A 'geographically descriptive term' is any noun or adjective that designates geographical location and would tend to be regarded by buyers as descriptive of the geographic location of origin of the goods or services." McCarthy, §§ 14:1, 14:2. As a trademark, however, the MOTOWN Mark does not designate a geographical location. Indeed, it could not, for the simple reason that the MOTOWN Mark *pre-dated* any reference to Detroit as "Motown," and continued to act as Opposer's trademark long after the record company left Detroit in the early 1970s. (See, e.g., Caparis Decl., ¶ 9 & Ex. 13.) Under these circumstances "Motown" cannot be "*primarily* geographically descriptive." 15 U.S.C. § 1052(e); see McCarthy § 14:28 at 1486 ("a designation that originally was used as a trademark and later becomes attached to a specific location is not 'primarily' geographically descriptive"); see also Scheder v. Touristik Arbeitsgemeinschaft Romantische Strabe GBR, 2007 WL 1849136 (T.T.A.B. 2007) (the fact that a coined term used by registrant for over fifty years later developed a reputation connoting a particular region did not make registrant's trademark primarily a geographic term); In re Pebble Beach Co., 19 U.S.P.Q.2d 1687 (T.T.A.B. 1991) (overruling opposition to registration of 17 MILE DRIVE;

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<sup>4</sup> Applicant's additional affirmative defenses are discussed *infra* at Section VI.

applicant's predecessor coined the term and it functioned as a mark even though the geographic area *later* became known as "17 Mile Drive," including in excerpts of articles from NEXIS database).<sup>5</sup>

Berry Gordy, the founder of Motown, created the MOTOWN Mark a decade before it became associated with Detroit. As he explained in his autobiography:

"...I wanted something that meant more to me, something that would capture the feeling of my roots – my hometown. Because of its thriving car industry, Detroit has long been known as the 'Motor City.' In tribute to what I had always felt was the down-home quality of warm, soulful country-hearted people I grew up around, I used 'town' in place of 'city.' A contraction of 'Motor Town' gave me the perfect name – Motown."

(Caparis Decl., ¶ 3, Ex. 2 at 21; see Applicant's Notice of Reliance Re: Printed Publications, vol. 3 of 7, Ex. A, at p. 344 ("Detroit had long been known as the Motor City because of the car industry. In place of city, Gordy substituted town, and a contraction of the two gave him Motown.")). In fact, the evidence submitted by Mattel that refers to the city of Detroit as "Motown" actually evidences the strength of the MOTOWN Mark, since it demonstrates that Detroit had never been referred to as "Motown" until many years after Mr. Gordy created the term. As reported in the Oxford English Dictionary Online, the earliest use of "Motown" to refer to the record company is 1960, while the earliest use of "Motown" to refer to the city of Detroit is ten years later in 1971. (See Caparis Decl., ¶ 9, citing Applicant's Notice of Reliance Re:

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<sup>5</sup> The case submitted by Applicant, Nike, Inc. v. Bordes, Opp. No. 91178960 (Sept. 30, 2009), actually illustrates why MOTOWN is not primarily geographically descriptive. The Board emphasized the *primary* significance of the mark at issue -- B-MORE -- was geographic. Id. at \*7. That was so because, unlike here, (1) the applicant admitted the term was derived from and chosen in part for the slang nickname for the city of Baltimore; (2) the applicant's business was located in Baltimore and he hoped to use his apparel bearing the B-MORE mark for the purpose of promoting Baltimore; (3) the applicant focused on selling his goods to the local Baltimore market; and (4) the USPTO previously had treated the phrase B-MORE as a geographically descriptive term. None of these facts are present here.

Printed Publications, vol. #3 of 7, at pp. 317-18.) (Of course, Detroit is also known as “the Motor City” and “the big D,” among other nicknames. (Caparis Decl, ¶ 9).)

Thus, the association of “Motown” with the city of Detroit has been derived from the previous and ongoing fame and power of the MOTOWN Mark, not the other way around. (Id.) An official Michigan website concerning historic preservation specifically refers to the record company’s influence: “In 1980 the Motown Historical Museum was established at Hitsville U.S.A. to commemorate the Motown Sound and to memorialize Motown’s distinctive heritage and its global impact.” (Caparis Decl., ¶ 9 & Ex. 13.) In essence, this “distinctive heritage” caused the city to become known (and sometimes referred to) by one of, if not its most, significant businesses and strongest trademarks: “Nashville has country music. Chicago has the blues. New Orleans has Dixieland. Seattle has grunge. *And Detroit will always identify itself with Motown, the 40-year-old record label that set new standards for black performers in the record industry and the rest of the business world.*” (Caparis Decl., ¶ 9 & Ex. 14, citing Crain’s Detroit Business, November 1, 1999) (emphasis added).<sup>6</sup>

Moreover, virtually all of the references to “Motown” as one of the nicknames for Detroit that were submitted in Applicant’s evidence are references in various local media articles or blogs. (Id.) *These uses do not represent trademark uses or associations with a product, in distinction to the trademark uses of Opposer and now Applicant.* See O’Rourke at 1048-49

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<sup>6</sup> Nor can MOTOWN be primarily geographically descriptive when applied by Opposer to toys, games, and playthings. McCarthy notes: “It is only when a geographic mark is used as a descriptive term that the law requires proof of secondary meaning. When a geographic term is used in an arbitrary manner, taking into consideration the nature of the goods or services in issue, no secondary meaning is required. For example, arbitrary uses of geographical terms would be NORTH POLE for bananas; SALEM for cigarettes; ATLANTIC for magazines; ENGLISH LEATHER for men's after-shave lotion; or ARCTIC for ice cream.” McCarthy § 14:7; see also Am. Can Co. v. Dixie Wax Paper Co., 150 U.S.P.Q. 823 (T.T.A.B. 1966), aff’d 407 F.2d 420, 160 U.S.P.Q. 721 (C.C.P.A. 1969) (DIXIE for wax paper). Here, the use of MOTOWN in connection with toys, games and playthings also is arbitrary.

(rejecting applicant's claim that the MTOWN CLOTHING mark is distinctly different than the MOTOWN Mark because it is an abbreviation for Middletown, New Jersey, and applicant's goods were sold only in New Jersey).

Even assuming *arguendo* that "Motown" somehow could be considered primarily geographically descriptive, it is still protected as a trademark upon proof that through usage it has become distinctive and, therefore, achieved secondary meaning. McCarthy, § 14:1 (4th ed. 2007) "Secondary meaning is defined as association, nothing more. The base element of secondary meaning is [...] the mental association by a substantial segment of consumers and potential consumers between the alleged mark and a single source of the product." Levi Strauss & Co. v. Blue Bell, Inc., 778 F.2d 1352, 1355 (9th Cir. 1985) citing McCarthy, §§ 15.2 at 69; 15:11 at 686. "Once proof of secondary meaning is established, a geographical term generally will be protected in the same manner as any 'strong' mark." McCarthy, § 14:10; see Duncan McIntosh Co., Inc. v. Newport Dunes Marina, LLC, 120 Fed. Appx. 119 (9th Cir. 2005) (NEWPORT BOAT SHOW was geographically descriptive, had acquired secondary meaning and preliminary injunction was granted and affirmed); Resorts of Pinehurst, Inc. v. Pinehurst Nat'l Corp., 148 F.3d 417 (4th Cir. 1998) (PINEHURST had achieved secondary meaning); California Cooler, Inc. v. Loretto Winery, Ltd., 774 F.2d 1451 227 U.S.P.Q. 808 (9th Cir. 1985) (the mark CALIFORNIA COOLER for a wine beverage had sufficient secondary meaning to support a preliminary injunction). MOTOWN has not only achieved secondary meaning; as set forth below, it is famous.<sup>7</sup> See infra at Section V(C)(1).

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<sup>7</sup> Applicant has a conundrum. Its position that "Motown" is geographically descriptive, if anything, would disqualify **Applicant** from trademark protection, as Applicant is the one claiming to use it in a geographic sense (and the "Metal" part of its mark merely describes the composition of its toy cars). See Sections V(A), (C)(2), infra.

**B. To the Extent There is a “Motown Style” it Serves to Reinforce Opposer’s Mark.**

Applicant’s other “defense” – presented through its musicologist (Mr. Ferrara) “on the basis of musicological research” – apparently is that there is a “Motown Style” which Applicant claims somehow excuses its use of the MOTOWN Mark on toy cars. (Ferrara Decl., ¶ 16.) This argument can be dismissed briefly. Mr. Ferrara does not purport to be a trademark or branding expert (although he does concede that “Motown is known as a record company.” *Id.*) It is, in fact, the case that Motown was more than a collection of artists; rather, the unique, soulful sound with enormous pop appeal that pervaded Motown releases sometimes was referred to as “The Motown Sound” -- almost always with reference to Motown artists. However, as is evidenced by Mr. Ferrara’s examples, the “Motown Style” specifically refers to Opposer as the source of that style; therefore, this designation only serves to strengthen the evidence of the wide recognition of Opposer’s MOTOWN Mark. (Juste Decl., ¶ 6; Caparis Decl., ¶ 8.)

Tellingly, Mr. Ferrara does not explain why a “Motown Style” of music would excuse Applicant’s use of the MOTOWN Mark, not to describe a style of music, but as a trademark on toy cars. It does not. In fact, marks that have achieved trademark significance often are used in a descriptive manner, without losing their trademark status or permitting others to usurp those marks as their own trademarks. (See Caparis ¶ 8) (referring to certain acts as “mickey mouse,” or a politician “teflon,” or referring to the “Rolls Royce of products”). Applicant should be well aware of this principle. In Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900 (9th Cir. 2002), the Court held that the use of the “Barbie” mark to describe “Barbie, or at least a girl like Barbie” (*id.* at 901), was not infringing because “[s]ome trademarks enter our public discourse and become an integral part of our vocabulary.” *Id.* at 900. While the trademark owner “does not have the right to control public discourse whenever the public imbues his mark with a meaning

beyond its source identifying function” (id.), that use does not diminish the mark’s trademark significance or permit others to “label[] its commercial good with a confusingly similar mark.” Id.; see id. at 900 (citing popular uses of trademarks such as “Rolls Royce” and “Band-Aid”). Applicant does not purport to be using the MOTOWN Mark to describe a style of music. It is using it as a trademark for its own product. That is not permissible.

**C. Applicant’s Use of MOTOWN METAL Inevitably Will Cause Confusion with Opposer’s MOTOWN Mark.**

The Lanham Act states, in pertinent part:

“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it...(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive...”

15 U.S.C. § 1052(d). In determining likelihood of confusion, the Board applies the factors in In re E.I. DuPont de Nemours & Co., 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Different factors may play dominant roles in determining each case. In re Majestic Distilling Co., 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003) (“Not all of the DuPont factors may be relevant or of equal weight in a given case, and any one of the factors may control a particular case”); Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc., 12 U.S.P.Q.2d 1901, 1903 (Fed. Cir. 1989) (“Different elements may play the dominant role in different cases.”). In this case, the dominant factors are the following:<sup>8</sup> (1) MOTOWN’s fame; (2) the similarity of the marks; (3) the

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<sup>8</sup> The complete list of factors is: “(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. (3) The similarity or dissimilarity of established, likely-to-continue trade channels.

(continued...)

similarity of the goods; (4) the similarity of the channels of trade; (5) the similarity of the conditions under which and buyers to whom sales are made; (6) the variety of goods and services on which the MOTOWN Mark is used; and (7) Applicant's intent in adopting MOTOWN METAL.

In analyzing the relevant factors, three broad principles are applicable here:

**First**, because Opposer's MOTOWN Mark is famous, it is entitled to a broad scope of protection. Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992).

**Second**, newcomers such as Applicant have the duty to avoid selecting a mark close to an established mark in order to protect the senior user's goodwill and investment and to protect consumers from confusion. *Id.*; Nina Ricci, 12 U.S.P.Q.2d at 1904.

**Third**, in assessing whether a likelihood of confusion exists, all doubts must be resolved in favor of the prior user. *Id.*; Hancock v. Am. Steel & Wire Co. of N.J., 97 U.S.P.Q. 330, 333 (C.C.P.A. 1953).

With the above principles in mind, analysis of the relevant DuPont factors leads to the conclusion that MOTOWN METAL is so clearly similar to the famous MOTOWN Mark as to be

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(...continued)

(4) The conditions under which and buyers to whom sales are made, *i.e.* "impulse" vs. careful, sophisticated purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark). (10) The market interface between applicant and the owner of a prior mark: (a) a mere "consent" to register or use. (b) agreement provisions designed to preclude confusion, *i.e.* limitations on continued use of the marks by each party. (c) assignment of mark, application, registration and good will of the related business. (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion. (11) The extent to which applicant has a right to exclude others from use of its mark on its goods. (12) The extent of potential confusion, *i.e.*, whether de minimis or substantial. (13) Any other established fact probative of the effect of use." DuPont, 177 U.S.P.Q. at 567.

likely, when used on or in connection with Applicant's goods, to cause confusion, or to cause mistake, or to deceive.

1. The Fame of The MOTOWN Mark Establishes That There Is A Likelihood Of Confusion.

Famous marks receive more protection than weak marks because they are more likely to be remembered by and have a source association to the public. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369, 1374 (Fed. Cir. 2005); Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 1371 (Fed. Cir. 2002); Recot, Inc. v. Becton, 214 F.3d 1322, 1327 (Fed. Cir. 2000); Kenner Parker Toys, 963 F.2d at 352. When present, the fame of the mark is “a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods.” Recot, 214 F.3d at 1328; see Starbucks U.S. Brands, LLC v. Ruben, 78 U.S.P.Q.2d 1741, 1750 (T.T.A.B. 2006) (“As the fame of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines.”).

A mark is famous when it is viewed by relevant purchasers as a famous mark; however, direct evidence of consumer recognition of a mark is not necessary. The “fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” Bose, 293 F.3d at 1371 (finding that evidence of extensive sales and advertising expenses established the fame of marks); Tiffany & Broadway, Inc. v. Commissioner, 167 F. Supp. 2d 949, 953 (S.D. Tex. 2001) (the fame of registered marks was a significant factor in finding a likelihood of confusion; the record included excerpts from 18 news articles where the registrant was identified as a famous business, citations to three published decisions in which the fame of the TIFFANY mark had been judicially recognized, and evidence



that the registrant's goods were sold at over 60 Tiffany locations worldwide, including 34 in the United States, and through independently owned retail stores and mail order outlets); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1569-70 (Fed. Cir. 1983) (the mark GIANT FOOD was famous based on 45 years of use, sales in excess of \$1 billion per year, extensive media exposure and prominent display on the facade of supermarkets).

MOTOWN has been recognized as famous by the Board and other legal decisions. O'Rourke at 1048, 1049 ("Opposer's mark is famous for musical recordings and performances"); see Three Boys Music Corp. v. Bolton, 212 F.3d 477, 481 (9th Cir. 2000) ("The Isley Brothers received a copyright for 'Love is a Wonderful Thing' from the Register of Copyrights on February 6, 1964. The following year, they switched to the famous Motown label and had three top-100 hits including 'This Old Heart of Mine.'"); Gordy Co. v. Mary Jane Girls, Inc., Nos. 86 CIV. 6814 (RWS), 1989 WL 149290, \*1 (S.D.N.Y. Dec. 6, 1989) ("Motown, a Michigan corporation with its principal place of business in Los Angeles, California, was engaged in the business of manufacturing, promoting, distributing, and selling musical recordings until June 28, 1988, when it sold substantially all of its then existing phonograph record business assets to the Gordy Company, Inc. The privately held Motown was the most successful black-owned record company in the United States, bringing to public prominence such renowned recording artists as Michael Jackson, Stevie Wonder, Marvin Gaye, Diana Ross, The Four Tops, The Temptations, and Lionel Richie."); Chic Org., Ltd. v. Motown Record Corp., 582 F. Supp. 812 (S.D.N.Y. 1984) ("Stripped of its famous names and glamorous subject matter, the instant dispute involves a rudimentary question of contractual interpretation.... Contrary to both parties' obvious expectations, [Diana] Ross refused, following the "Diana" album, to continue to record for Motown.")

MOTOWN has been used nationwide by Opposer and its predecessors for over fifty years; is associated with a total sales volume of [REDACTED] of dollars (including more than [REDACTED] during a recent five-year period); has been used in connection with [REDACTED] of advertising expenditures during this five-year period; has been used on and licensed for a variety of goods and services; and has been referenced in hundreds of publications entered in this proceeding. (Froeling Decl., ¶¶ 4-5 & Exs. 14, 16 **confidential**; UMG's Notice of Reliance Re: Printed Publications; Trial Declaration of Mario Ortiz, attached as Exhibit B to Notice of Reliance re: Evidence Filed in UMG Recordings, Inc v. O'Rourke ("Ortiz Decl."); Applicant's Notices of Reliance Re: Printed Publications, vols. 1 through 7.) MOTOWN is entitled to the broadest range of protection. See Kenner Parker Toys, 22 U.S.P.Q.2d at 1456 ("[T]he Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls...."); Recot at 1897 ("[T]he fame of the mark must always be accorded full weight when determining the likelihood of confusion."); Starbucks, at 1751 (finding STARBUCKS to be a "famous" mark, resulting in a likelihood of confusion with the LESS BUCKS mark); Interlego AG v. Abrams/Gentile Entm't Inc., 63 U.S.P.Q.2d 1862, 1864 (T.T.A.B. 2002) (LEGO mark accorded "a very broad scope of protection" and finding a likelihood of confusion with respect to MEGO mark for toys); see also Tiffany & Broadway, 167 F. Supp. 2d at 953; Playboy Enter. Int'l, Inc. v. Worobec, 2008 WL 906635, \*2-3 (T.T.A.B 2008); Nautica Apparel, Inc v. Carlucci, 2007 WL 4616268 (T.T.A.B. 2007).

2. The Similarity of MOTOWN and MOTOWN METAL Establishes That There Is A Likelihood Of Confusion.

This DuPont factor requires examination of "the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression." 476 F.2d at

1361. Both Applicant's and Opposer's marks contain the identical, dominant element "motown."<sup>9</sup> As noted by Opposer's expert,

"[T]he Motown trademark and Motown Metal are, from a consumer standpoint, identical. The reasons for this are multiple: first, the word 'Motown' is the most dominant aspect of 'Motown Metal'; it comes first, and it modifies the word 'metal.' Second, the word 'metal' is not part of the 'brand' but is merely descriptive of the metal composition of the toy and would be ignored by consumers as a source of origin. Third, the typeface of the Motown trademark and 'Motown Metal' is the same plain typeface."

(Caparis Decl., ¶ 12).

The insertion in Applicant's MOTOWN METAL mark of the word "metal" is irrelevant:

"It is appropriate in determining the question of likelihood of confusion to give greater weight to the important or 'dominant' parts of a composite mark, for it is that which may make the greatest impression on the ordinary buyer. Thus, as a preliminary to a final comparison of the conflicting marks as a whole, it is not a violation of the anti-dissection rule to look at the parts of the composites to determine which parts are likely to make a greater or lesser impact on the ordinary buyer. While the basic rule is that marks must be compared in their entireties and not dissected, 'in, articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.' ... ***Thus, as a preliminary to comparing marks in their entireties, it is not improper to discount the similarity of descriptive or generic parts of conflicting marks.***"

McCarthy, § 23:42 (emphasis added). "A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark. Thus, a mark is merely descriptive if it immediately conveys knowledge of a quality or characteristic of the product. A mark may be merely descriptive even if it does not

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<sup>9</sup> Beyond being identical, in the second year of its use, Mattel even increased the size and prominence of "Motown Metal" on its packaging. (Caparis Decl., ¶ 12 & Ex. 17.)

describe the ‘full scope and extent’ of the applicant’s goods or services.” In re Oppedahl & Larson LLP, 373 F.3d 1171, 1173 (Fed. Cir. 2004).

Applicant’s Hot Wheels toys are composed of metal. (Heininger Depo. at 19:14-19, attached as Exhibit A to Notice of Reliance re: Discovery Depositions (“Heininger Depo.”); Bouman Depo. at 5:11-16.) Thus, the “metal” portion of Applicant’s MOTOWN METAL mark is descriptive, and should be discounted. See O’Rourke, 92 U.S.P.Q.2d at 1048 (use of word “clothing” would not be viewed as distinctive or an indicator of source); see also In re Chatam Int’l. Inc., 380 F.3d 1340, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004) (discounting the term ALE as it was descriptive or generic). The remaining portions of the marks – “motown” – are dominant and identical. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 U.S.P.Q.2d 1842 (Fed. Cir. 2000) (the dominant part of the conflicting marks for golf clubs, LASER versus LASERSWING, is LASER, leading to a conclusion of likely confusion between the marks as a whole).

In sustaining the opposition in O’Rourke, the Board found the marks MTOWN CLOTHING and MOTOWN to be similar in appearance, stating that “even though the involved marks have some differences in appearance, they also have similarities;” to be similar in sound, stating that “[a]s with the appearance of the marks, the sounds of the marks have some differences but also significant similarities;” and to be similar in connotation, stating that “for those who know the history of ‘Motown’ records and performers, and the record is substantial that the ‘Motown’ legacy and contributions in the music industry are well-known, the connotation of opposer’s marks will mirror that history and legacy.” 92 U.S.P.Q.2d at 1048. If anything, these factors more strongly favor Opposer here.

3. The Similarity of The Parties' Goods Establishes That There Is A Likelihood Of Confusion.

The parties' goods are identical: both are toys, games, or playthings. Specifically, the goods in connection with which Applicant seeks to register MOTOWN METAL are "toys, games and playthings, namely, toy vehicles and accessories therefor." The goods sold by Opposer's licensees also are toys, games, and playthings, namely stuffed animals, novelty pens, pencils, and balls, toy mood lights, miniature harmonicas, karaoke products, board games, video games, and musical playthings for children. See Section IV(A)(2), supra. Both parties' products are leisure goods, nonessential, and collectible.<sup>10</sup> (Caparis Decl., ¶ 13.) "When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of Am., 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992) (citations omitted). Here, Applicant has applied to register MOTOWN METAL in connection with the same categories of products sold by Opposer through its licensees under the MOTOWN Mark.

Although Opposer does not sell die-cast toy cars, the parties' goods are competitive. "Competitive" goods are those that are "reasonably interchangeable by buyers for the same purposes." McCarthy, § 24:23, see e.g., U.S. v. Continental Can Co., 378 U.S. 441, 12 L. Ed. 2d 953, 84 S. Ct. 1738 (1956) (glass containers and metal containers are competitive although used primarily for different foodstuffs). When the parties' goods are directly competitive, the degree of similarity of marks needed to cause likely confusion is less than in the case of dissimilar goods. Jules Berman & Assocs, Inc. v. Consol. Distilled Prods., Inc., 202 U.S.P.Q. 67, 71 (T.T.A.B. 1979). Moreover, since both parties' marks contain the identical dominant term

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<sup>10</sup> Indeed, "Forever Collectibles," one of the licensees of the Motown Mark, is one of the largest manufacturers of collectible playthings. (Caparis Decl., ¶ 13.)

“motown,” it is “only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion.” In re Concordia Int’l Forwarding Corp., 222 U.S.P.Q. 355, 356 (T.T.A.B. 1983) (refusing registration when both marks were dominated by the element CONCORDIA and both parties were in the business of moving the goods of others from one location to another).<sup>11</sup>

In any event, even if (contrary to the evidence) Opposer did not sell toys, games, and playthings, Applicant’s products would be sufficiently related to Opposer’s music-related goods and services to likely cause confusion. The Board has long recognized that “it is a matter of common knowledge that famous marks are frequently used on certain types of items, such as clothing, glassware, trash cans, pillows, etc., which are unrelated in nature to those goods on which the marks are normally used; such use has become a part of everyday life which we cannot ignore.” General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc., 204 U.S.P.Q. 396, 400 & n.5 (T.T.A.B. 1979) (sustaining opposition to use of MONOPOLY mark on clothing based on Opposer’s rights in mark for board games), aff’d 209 U.S.P.Q. 986 (C.C.P.A. 1981); see Turner Entm’t Co. v. Nelson, 38 U.S.P.Q.2d 1942 (T.T.A.B. 1996) (citing numerous cases and other authorities for the above proposition); see also TBMP § 704.12(a) at n.245. Thus, consumers would expect to see a famous mark such as MOTOWN applied to goods such as toys, games, and playthings, especially since these types of goods frequently are sold (and are

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<sup>11</sup> The converse is true here as well: “[A]s the degree of similarity of the goods of the parties increases, ‘the degree of similarity [of the marks] necessarily to support a conclusion of likely confusion declines.’” Fossil Inc., 49 U.S.P.Q.2d 1451, quoting Century 21 Real Estate, 23 U.S.P.Q.2d at 1700. See also Hard Rock Cafe Int’l (USA), Inc. v. Elsea, 56 U.S.P.Q.2d 1504, 2000 WL 1279457 (T.T.A.B. 2000) (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support of conclusion of likely confusion declines.”); Centraz Indus., Inc. v. Spartan Chem. Co., Inc., 77 U.S.P.Q.2d 1698, 2006 WL 236413 (T.T.A.B. 2006) (same).

widely know to be sold) in relation to entertainment industry products and services, including by record companies. As the Board noted in O'Rourke:

“Opposer’s mark is famous for musical recordings and performances, and opposer has demonstrated that such fame has been exploited by its use of the mark on collateral products, such as clothing.... As a result, consumers familiar with opposer’s famous music industry marks, including the various MOTOWN and M MOTOWN marks, when subsequently confronted with clothing items adorned with applicant’s mark would likely conclude it was another variation on the marks used by or authorized by opposer for such goods.”

92 U.S.P.Q.2d at 1049-50.

4. The Similarity of Channels of Trade Establishes That There Is A Likelihood Of Confusion.

This DuPont factor concerns the similarity of the parties’ established, likely-to-continue trade channels -- that is, where and how the parties’ goods are sold. Majestic Distilling Co., 315 F.3d at 1311 (finding malt liquor and tequila sold in the same trade channels). Because Applicant’s Application contains no limitations on channels of trade or target consumers, its goods are presumed to “move through ‘all the ordinary and usual channels of trade for such goods to all the usual customers for these products.’” McCarthy, § 20:15 quoting Saab-Scania Aktibolag v. Sparkomatic Corp., 26 U.S.P.Q. 2d 1709, 1711 (T.T.A.B. 1993); see Packard Press, Inc. v. Hewlett-Packard Co., 56 U.S.P.Q.2d 1351, 1357 (Fed. Cir. 2000) (“When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade.”). Thus, the trade channels of Applicant’s MOTOWN METAL toys, games, and playthings are presumed to overlap with Opposer’s trade channels for its toys, games, and playthings under the MOTOWN Mark. See O'Rourke, 92 U.S.P.Q.2d at 1049.

Moreover, the parties' goods are *in fact* offered in identical channels of trade. Not only are Opposer's licensed MOTOWN toys, games and playthings, recordings, and other products sold in the same *type* of outlets as MOTOWN METAL toys, they are sold in *precisely* the same outlets, including in major retail stores and on the Internet. (Caparis Decl., ¶ 13 & Ex. 18.) By way of example, both Applicant's MOTOWN METAL toys and Opposer's MOTOWN products have been sold by K-Mart stores, Wal-Mart stores, Target stores, and Toys "R" Us. (Caparis Decl., ¶ 13 & Ex. 16; Adler Depo. at 100:4-101:2.) See, e.g., Piccolo Sportswear, Inc. v. Mast Indus., Inc., 227 U.S.P.Q. 710, 711-12 (T.T.A.B. 1985) (finding same channels of trade for ladies' and childrens' clothing sold in same department stores). In addition to physical outlets, evidence that owners of both marks utilize the Internet as a marketing and advertising tool may increase the likelihood of confusion. Both MOTOWN METAL toys and Opposer's MOTOWN products currently are sold on the popular websites Amazon.com and eBay.com. (Caparis Decl., ¶ 13 & Ex. 18.) Brookfield Commc'ns, Inc. v. West Coast Entm't Corp., 174 F.3d 1036, 1057 (9th Cir. 1999) ("[the parties] both utilize the Web as a marketing and advertising facility, a factor that courts have consistently recognized as exacerbating the likelihood of confusion"). Because the parties not only sell their goods in the same general manner, but also in overlapping retail and internet outlets, their channels of trade are similar and a likelihood of confusion exists.

5. The Conditions Under Which And Buyers To Whom Sales Are Made Establish That There Is A Likelihood of Confusion.

This DuPont factor focuses on the individual purchasers of the goods at issue.

a) Standard of Care.

Both Applicant's and Opposer's products are "impulse purchases." See Kenner Parker, 963 F.2d at 355 (PLAY-DOH and FUNDOUGH marks on toy modeling clay and accessories were both "on inexpensive products purchased by diverse buyers without exercising much



care”). Unlike purchasers of expensive goods, such as real cars or computers, impulse purchasers “are held to a lesser standard of purchasing care and, thus, are more likely to be confused as to the source of the goods.” Wet Seal, Inc. v. FD Mgmt., Inc., 82 U.S.P.Q.2d 1629, 1641 (T.T.A.B. 2007) (citing Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 223 U.S.P.Q. 1281, 1282 (Fed. Cir. 1984); see Recot, 214 F.3d at 1329 (“When products are relatively low priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.”); In re Toy Concepts, 2006 WL 478990, \*1 (T.T.A.B. 2006) (“such purchasers, particularly considering the inexpensive nature of these toys, would not be expected to exercise a high degree of care and thus would be more prone to confusion”); In re Craft House Corp., 2001 WL 862284, \*3 (T.T.A.B. 2001) (“Moreover, both applicant’s and registrant’s toys are relatively inexpensive and are therefore likely to be purchased casually and on impulse, thus increasing the risk of confusion.”).

Applicant’s toy cars are prototypical impulse purchases. **First**, the MOTOWN METAL cars are interchangeable with hundreds of other of Applicant’s toy cars and the specific models (and their names) are replaced often; therefore, any particular toy car (and any MOTOWN METAL car) likely is bought on impulse, not by prior design or plan. (Caparis Decl., ¶ 15.) **Second**, the fact that Applicant does not separately advertise MOTOWN METAL cars (and retailers cannot even buy them individually but only in random groups of toy cars which may or may not include the MOTOWN METAL cars) evidences that buyers do not specifically target MOTOWN METAL cars for purchase but rather that their purchase is impulsive. (Caparis Decl., ¶ 15; Mattel’s Supplemental Response to UMG Interrogatory No. 18, in Ex. C to UMG’s Notice of Reliance Re: Written Discovery Responses; Adler Depo. at 98:15-99:2.) **Third**, as

Applicant has testified, it is color that attracts children to a particular toy car – another sign that they are purchased on impulse. (Caparis Decl., ¶ 15; Adler Depo. at 115:5-8.) **Fourth**, most purchasers of MOTOWN METAL cars are either children or adults purchasing the basic car for children. In either event, they are not sophisticated (nor need they be) in purchasing the inexpensive toy products involved. (Caparis Decl., ¶ 15.) **Finally**, and most important, both parties’ toys, games, and playthings are low-priced (the suggested retail price of a single one of Applicant’s MOTOWN METAL “basic” cars is 99 cents and about \$5.00 for the set of five. The toys, games, and playthings of Opposer’s licensees generally range approximately from \$3.99 to \$25.00).<sup>12</sup> (Caparis Decl., ¶ 15; Mattel’s Supplemental Response to UMG Interrogatory No. 16; Czapla Decl., ¶ 7; Cote Decl., ¶¶ 4-5; Handal Decl., ¶ 5; Schulte Decl., ¶ 5.)

b) Purchasers.

Recordings on the MOTOWN record label and MOTOWN METAL cars (the models for which are circa 1970) evoke the same general era of approximately 40 to 50 years ago. (Caparis Decl., ¶ 15.) Motown had a widely publicized 40th Anniversary campaign (which included a hit television special), and Mattel released a “40th Anniversary Motown Metal” two-car collector set. (Caparis Decl., ¶¶ 5, 14 & Exs. 9, 20.) The consumer group for Applicant’s MOTOWN METAL product and Opposer’s MOTOWN branded products are the same or at the very least significantly overlap. As noted, MOTOWN METAL cars are targeted at children and also adults who may purchase them for children.

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<sup>12</sup> Opposer’s recordings are similarly inexpensive, retailing for approximately 99 cents for a downloadable single. Applicant also has sold a collector’s version of Motown Metal cars to adult collectors for \$19.99, whereas Opposer’s CDs are sold for a comparable price of approximately 10 to 15 dollars each. (Caparis Decl., ¶ 15 & Ex. 18 at pp. 144, 171, Ex. 21 at p. 178; Mattel’s Supplemental Response to UMG Interrogatory No. 16.)

Similarly, Opposer's internal marketing materials highlight the brand's "inclusive" and "generational" appeal. The MOTOWN-licensed toys and playthings (and many other MOTOWN licensed items) are for children. Children (or teenagers) who are among the largest group of purchasers of recordings, will be very familiar with the MOTOWN name. (Caparis Decl., ¶ 14.) Opposer even has sold recordings especially geared to children, for example, "Motown for Kids" in 2008, "A Flintstones Motown Christmas," and, in addition to licensing other toys and games, has licensed videogames based on its recordings. (Caparis Decl., ¶ 14 & Ex. 21; Froeling Decl., Ex. 24 at p. 11.) Opposer's products (like Applicant's toy cars) also will be purchased by adults with children. In re Craft House Corp., 2001 WL 862284, \*3 (T.T.A.B. 2001) ("While purchasers may care about the toys they are purchasing for use by their children and therefore exercise a certain degree of care in selecting such products, they are not necessarily sophisticated purchasers or likely to exercise a high degree of care in terms of examining the trademarks"). These purchasers grew up in the 60's, 70's and 80's and are very familiar with the MOTOWN Mark. (Caparis Decl., ¶ 14.) Together, both Opposer's and Applicant's purchasers cover a large and overlapping age range.

6. The Variety of Goods on Which The MOTOWN Mark Is Used Establishes A Likelihood of Confusion.

This DuPont factor examines the scope of products on which the mark is used – that is, whether it is a "house mark." The Sports Authority Michigan, Inc. v. The PC Authority, Inc., 2002 WL 575718 (T.T.A.B. 2002). Where the senior user uses the mark in connection with a wider range of goods, it is given a wider scope of protection. Virgin Enter. Ltd. v. Albion Motors Ford Mercury, Inc., 2007 WL 2344691 at \*22 (T.T.A.B 2007). Opposer uses MOTOWN in connection not only with musical recordings but also with goods and services as diverse as music and videos; concerts; games, toys, and playthings; restaurant services; T-shirts,

hats, and other clothing; and magnets, pins, wristbands, totebags, glassware, and coasters. See supra, Sections IV(A)(2) and IV(A)(4). In addition to being famous, Opposer's wide variety of uses entitles it to broad protection.

7. The Intent of The Applicant Establishes That There Is A Likelihood Of Confusion.

Intent of a party in adopting a mark may be taken into consideration in an analysis of likelihood of confusion. Academy of Motion Picture Arts & Sciences v. Creative House Promotions, Inc., 944 F. 2d 1444, 1456 (9th Cir. 1991) citing Fleischmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149, 158 (9th Cir. 1963) ("...when the evidence does show or require the inference that another's name was adopted deliberately with a view to obtain some advantage from the good will, good name and good trade which another has built up, the inference of likelihood of confusion is readily drawn, for the very act of the adopter has indicated that he expects confusion and resultant profit."). Here, there are at least four pieces of evidence that Applicant intended to trade on Opposer's goodwill in the MOTOWN Mark in adopting and using MOTOWN METAL. **First**, the creator of MOTOWN METAL testified to his longstanding familiarity with Applicant's products, including acknowledging that he was aware of the affiliation of various famous musical artists with MOTOWN. (Heining Depo. at 31:9-10; 52:15-53:20; 61:11-24; 62:10-16.) **Second**, Applicant deliberately strengthened its association with Opposer by choosing to prominently include an "M" design mark in conjunction with MOTOWN METAL. (Adler Depo. at 75:9-23 & Ex. 5.) Of course, this is a juxtaposition frequently used by Opposer in its previously registered marks. See supra at Sections IV(A)(2), (4); see also O'Rourke, 92 U.S.P.Q.2d at 1048 ("[T]he entire record shows use by opposer of various M MOTOWN marks that similarly stress a large M."). **Third**, Applicant increased the font size of MOTOWN METAL in the second year of packaging. (Caparis ¶ 12 & Ex. 17.)

*Fourth*, Applicant's use of "Motown" was not necessary. Its use was minimal, and Applicant ceased using MOTOWN METAL in connection with new cars in 2007. (Adler Depo. at 35:21-36:4; 60:19-61:14; 63:12-18; Bouman Depo. at 30:4-10; Mattel's Responses to UMG's Interrogatory Nos. 1, 10; Mattel's Supplemental Response to UMG's Interrogatory Nos. 11, 13.) In fact, Applicant initially referred to the MOTOWN METAL toys as the MUSCLE CARS SERIES, which more accurately describes them, and has now returned to that designation in place of MOTOWN METAL. (Caparis Decl., ¶ 11 & Ex. 15; Adler Depo. at 60:19-61:14; 63:12-18.) These facts tend to show Applicant's intent in using the identical mark as Opposer.<sup>13</sup>

**D. Applicant's Use of MOTOWN METAL Will Dilute Opposer's Rights in MOTOWN.**

The Lanham Act provides:

"Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury."

15 U.S.C. § 1125(c). The Lanham Act defines "dilution by blurring" as "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." 15 U.S.C. § 1125(c)(2)(B). Factors to be considered in a dilution analysis are: (1) whether the opposer's mark is a famous mark; (2) whether the applicant is making a commercial use of the mark; (3) whether the opposer's mark became famous prior to

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<sup>13</sup> Applicant was also well-aware of the need to obtain consent to use famous marks on its MOTOWN METAL cars, as Applicant's own marketing materials include a lengthy list of trademarks for which it claims to have obtained licenses. See Applicant's Notice of Reliance re: Produced Evidence Vol. 2, Ex. A, at 111-112. Notably absent is any indication that MOTOWN is Opposer's trademark.

the filing date of Applicant's trademark application; and, (4) whether the applicant's mark is likely to cause dilution by diminishing the capacity of the opposer's mark to identify and distinguish its goods and services. 15 U.S.C. §1125(c); see Panavision Int'l L.P. v. Toeppen, 141 F.3d 1316, 1324 (9th Cir. 1998). Likelihood of confusion is not a requirement for dilution. Mattel, 296 F.3d at 903 ("By contrast to trademark infringement, the injury from dilution usually occurs when consumers *aren't* confused about the source of a product") (emphasis in original); Nabisco, Inc. v. PF Brands, Inc., 191 F. 3d 208, 219-221 (1999) (recognizing that likelihood of confusion is not necessary to sustain an action for dilution).

1. MOTOWN is a famous mark

In connection with a dilution analysis, "a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." 15 U.S.C. §1125(c)(2)(A). The Lanham Act permits consideration of "all relevant factors" to analyze whether a mark is famous, including: (1) the duration, extent, and geographic reach of advertising and publicity of the mark; (2) the amount, volume, and geographic extent of sales of goods or services offered under the mark; (3) the extent of actual recognition of the mark; and (4) whether the mark was registered. *Id.* As set forth above, all of these factors are present here. Among other things, Opposer has used MOTOWN for over fifty years nationwide (Juste Decl., ¶¶ 4-11); has sold [REDACTED] of dollars worth of products in connection with MOTOWN (Froeling Decl., ¶ 4 & Ex. 14 **confidential**); the mark is widely recognized (discussed in hundreds if not many thousands of publications, and per The New York Times, "synonymous with the musical, social and cultural fabric of America" (Caparis Decl., Ex. 5)); and it has been the subject of numerous trademark registrations. See Section IV(A)(4), supra. In addition, Applicant even admitted to its close familiarity with Opposer's mark. (Heininger Depo. at 31:9-10; 52:15-53:20; 61:11-24; 62:10-16.)

2. Applicant Has Made A Commercial Use of MOTOWN METAL.

Applicant admits that it began using MOTOWN METAL in commerce in or about the second quarter of 2006. (Mattel's Response to UMG's Interrogatory No. 10.)

3. MOTOWN became famous prior to the filing date of Applicant's trademark application.

"In the case of an intent to use application, the owner of the famous mark must prove that its mark became famous prior to the filing date of the applicant's application." Virgin Enter., 2007 WL 2344691 at \*15. Applicant filed its application on November 10, 2005, decades after Opposer created and began using the MOTOWN Mark and decades after virtually all of Opposer's registrations. (See supra, Sections IV(A)(4), (B).)

4. Applicant's mark is likely to cause dilution by blurring of the distinctiveness of the Opposer's mark.

"Dilution diminishes the selling power that a distinctive mark or name with favorable associations has engendered for a product in the mind of the consuming public. Dilution by blurring occurs when a substantial percentage of consumers, upon seeing the junior party's use of a mark on its goods, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark's owner." McCarthy, §24:100, n. 21; see NASDAQ Stock Market Inc. v. Antarctica S.r.l., 69 U.S.P.Q.2d 1718 (T.T.A.B 2003).

The Board may look to all relevant facts in determining whether Applicant's trademark will blur the distinctiveness of Opposer's mark, (id.), including the guidance of the Lanham Act.

In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark.

- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. §1125. After identifying all relevant factors, the Board will balance them. See, e.g., Perfumebay.com, Inc. v. Ebay, Inc., 506 F.3d 1165, 1180-81 (9th Cir. 2007).

- a) The degree of similarity between the mark or trade name and the famous mark.

For purposes of dilution, “the marks must be similar enough that a significant segment of the target group sees the two marks as essentially the same.” Perfumebay.com, 506 F.3d at 1180. Applicant’s MOTOWN METAL is very substantially similar, in fact identical, to Opposer’s coined MOTOWN Mark.

- b) The degree of inherent or acquired distinctiveness of the famous mark.

This factor

“...requires consideration of the traditional trademark law definition of ‘distinctiveness.’ This focuses attention on the traditional two prongs of distinctiveness: the conceptual strength and commercial strength of the mark. ‘Conceptual strength’ is the placement of the mark on the spectrum of marks and ‘commercial strength’ is the marketplace recognition value of the mark. The unspoken assumption of this factor is that the greater the ‘distinctiveness’ or strength of the famous mark, the greater is the scope of protection against blurring. Thus, while a non-inherently distinctive mark with secondary meaning is now clearly not automatically disabled from dilution protection under federal law, it may well be entitled to a lesser scope of protection than an inherently distinctive mark such as a coined mark.”



McCarthy, § 24:119. Here, Opposer's MOTOWN mark is both conceptually strong, as a coined mark, Polaroid Corp. v. Polaroid Inc., 319 F.2d 830, 831 (7th Cir. 1963), and commercially strong, as a famous mark with enormous marketplace recognition for over 50 years.

- c) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

Opposer is engaged in substantially exclusive use of the MOTOWN Mark. Upon occasion, third parties attempt to infringe upon Opposer's rights, but in those cases Opposer enforces its rights. (Waddell Decl., ¶ 13 & Ex. W.) See generally O'Rourke. Opposer's mark is unusual and exceptional, and not "merely one of several identical or very similar marks."

McCarthy, § 24:119.

- d) The degree of recognition of the famous mark.

"The more famous a mark, the more likely it is the required 'association' will take place in the minds of the viewers when they encounter the accused mark... [o]nce the mark is determined to be famous, there is a sliding scale to determine just how famous the mark is" and to determine the extent of that protection. McCarthy, 24:119. As set forth above, the MOTOWN Mark is almost uniquely famous. The evidence cited by Opposer establishes that MOTOWN is on the high end of the sliding scale of fame. See, e.g., The New York Times, "Motown Turns Fifty, But the Party's Far from Over," September 5, 2009, attached to Caparis Decl. as Ex. 5, p. 57 ("Motown Records Corp. and its stable of largely African-American artists have become synonymous with the musical, social and cultural fabric of America."); Vanity Fair, "It Happened In Hitsville," December 2008, (id., p. 41) (citing "several shelves of books about the revolutionary music label"); Michigan historic preservation web site, attached as Ex. 13 to Caparis Decl. (Motown Historical Museum "established [in 1980] at Hitsville U.S.A. ... to memorialize Motown's distinctive heritage and its global impact").

- e) Whether the user of the mark or trade name intended to create an association with the famous mark.

“The junior user's intent to create an association with the famous mark could be evidence probative of the fact that such an association does take place in the minds of the buying public. This is similar to the traditional rule that evidence of the junior user's intent to cause confusion is probative of the critical fact that there is a likely of confusion of buyers.” McCarthy, § 24:119. As set forth above in Section V(C)(7), there is evidence of such an intent by Applicant, including by gratuitously choosing to use “motown” in the first place, by incorporating the “M” design element into the packaging, and by increasing the font size of MOTOWN METAL in the second year of packaging. (See Caparis ¶ 12 & Ex. 17; Adler Depo. at 60:19-61:4; 63:12-18; 75:9-23 & Ex. 5.)

- f) Any actual association between the mark or trade name and the famous mark.

All of the evidence discussed above -- including Opposer's lengthy uninterrupted nationwide use, high volume of sales, significant promotion and advertising, use on a variety of goods and services, mentions of Opposer's mark in dictionaries, encyclopedias, and in newspapers and periodicals -- also supports the conclusion that a significant number of ordinary consumers will make a mental association between MOTOWN METAL and Opposer's famous MOTOWN Mark. See supra at Sections IV(A); V(A), (C)(1), (D)(1), (D)(3); see also McCarthy, § 24:119; Hormel Foods Corp. & Hormel Foods, LLC v. Spam Arrest, LLC, 2007 WL 4287254 (T.T.A.B. 2007) (“At that point, petitioner had used the mark for such goods for over 60 years; had achieved an extremely large volume of sales that were still very high even in the period shortly before respondent's adoption of its mark; and had engaged in significant promotion and advertising of its mark throughout the entire period of its use. In addition, the various uses or mentions of petitioner's mark and its meat product, e.g., in the Smithsonian Museum, in a

Library of Congress display, on numerous television programs, all demonstrate that the mark and product are recognized by the public.”); NASDAQ, 69 U.S.P.Q.2d at 1737 (“The dictionary references, newspaper and magazine articles, and daily reports on opposer’s stock market in print and broadcast media evidence very widespread recognition, beyond just investors, and a great deal of this evidence is prior to applicant’s priority filing date”).

## **VI. APPLICANT’S AFFIRMATIVE DEFENSES ARE NOT VALID**

In addition to unavailing defenses discussed of above, Applicant asserts two other affirmative defenses that may be disposed of in short order: (1) unclean hands and (2) use by third parties.

### **A. Unclean Hands**

An equitable defense of “unclean hands” is available to an applicant when, for example, an opposer has filed a false affidavit of use in securing its senior registration. Duffy-Mott Co. v. Cumberland Packing Co., 424 F.2d 1095, 165 U.S.P.Q. 422 (C.C.P.A. 1970). Here, however, Applicant’s affirmative defense appears to be based on a theory that Opposer does not enforce its rights against third parties using MOTOWN marks and that, by filing this Opposition, Opposer is expressing a “grudge” against Applicant. This novel theory is unavailing for two reasons. *First*, Opposer does in fact enforce its trademark rights against third parties. (See Waddell Decl., ¶ 13 & Ex. W.) *Second*, simply protecting one’s trademark rights cannot give rise to an unclean hands defense. Time Warner Entm’t. Co. v. Jones, 65 U.S.P.Q.2d 1650, n.4 (T.T.A.B. 2002) (“To the extent that this defense is intended as an equitable ‘unclean hands’ defense based on Opposer’s allegedly overzealous enforcement of its trademark rights, we find that applicant has failed to make out the defense. As the Board has noted in previous cases wherein such defense was asserted, ‘[t]here is nothing in the record to suggest that [opposer] has done anything other than seek to protect its rights in its registered marks, and preclude the registration of what it

believes to be a confusingly similar mark, a right which every trademark owner possesses under the Lanham Act.”).

**B. Use By Third Parties.**

Applicant’s “use by third parties” affirmative defense appears to be a reiteration of the sixth DuPont factor, the number and nature of similar marks in use on similar goods. As such, it is not a legitimate affirmative defense and, in any event, would be unavailing. adidas America, Inc. v. Payless Shoesource, Inc., 529 F.Supp. 2d 1215, 1229 (D.Or. 2007) (“In any event, Payless’ claim that adidas has abandoned its ability to enforce its mark against two or four stripes by permitting third parties to use those designs is not a cognizable defense or counterclaim....To the extent that Payless alleges adidas’ rights have been weakened or diluted by third-party uses...this is not an affirmative defense, but rather a part of the likelihood of confusion analysis.”)

**CONCLUSION**

Applicant’s trademark application for MOTOWN METAL is doubly improper: the marks of Opposer and of Applicant are likely to cause confusion; and Applicant’s use of MOTOWN METAL dilutes Opposer’s rights in its famous MOTOWN Mark. Opposer respectfully requests that the Board sustain the Opposition.

Dated: January 12, 2010

RUSSELL J. FRACKMAN  
ALEXA L. LEWIS  
MITCHELL SILBERBERG & KNUPP LLP

By: Alexa Lewis  
Alexa L. Lewis  
Attorneys for Opposer

**CERTIFICATE OF MAILING**

Date of Deposit: January 12, 2010

"Express Mail" mailing label number: EB 519288534 US

I hereby certify that this paper or fee, **TRIAL BRIEF OF OPPOSER UMG RECORDINGS, INC., IN SUPPORT OF NOTICE OF OPPOSITION**, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" on the date indicated above and is addressed to: UNITED STATES PATENT AND TRADEMARK OFFICE, Trademark Trial and Appeal Board , P.O. Box 1451, Alexandria, Virginia 22313-1451.

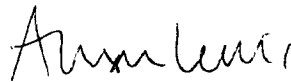


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Alexa L. Lewis

**CERTIFICATE OF SERVICE**

I hereby certify that on this 12th day of January, 2010, a true and correct copy of the foregoing **TRIAL BRIEF OF OPPOSER UMG RECORDINGS, INC., IN SUPPORT OF NOTICE OF OPPOSITION**, was served upon Opposer's counsel of record by hand delivery, to the following address: Lawrence Y. Iser, Patricia A. Millett, Chad R. Fitzgerald, Kinsella, Weitzman, Iser, Kump & Aldisert LLP, 808 Wilshire Boulevard, 3rd Floor, Santa Monica, CA 90401.



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Alexa L. Lewis

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 78/751,105  
Published for Opposition in the OFFICIAL GAZETTE on December 12, 2006

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UMG RECORDINGS, INC.

Opposition No.: 91176791

Opposer

v.

MATTEL, INC.,

Applicant

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**OPPOSER UMG RECORDINGS, INC.'S EVIDENTIARY OBJECTIONS TO**  
**EVIDENCE OF APPLICANT MATTEL, INC.**

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Opposer UMG Recordings, Inc. ("Opposer") submits the following evidentiary objections to the evidence submitted by Applicant Mattel, Inc. ("Applicant").

**I. APPLICANT'S NOTICE OF RELIANCE RE: PRINTED PUBLICATIONS**

Opposer objects to the documents listed as Nos. 1-11 to Applicant's Notice of Reliance filed June 16, 2009, which consist of third party trademark registrations or applications. Allegations of use in such documents do not constitute evidence that the marks shown therein have actually been used. See Alpha Industries, Inc. v. Alpha Microsystems, 223 U.S.P.Q. 96, 96 (T.T.A.B. 1984) (Board will not take judicial notice of statements made in third-party applications regarding use; "the Board believes that the registrations are entitled to little weight"); Economics Laboratory, Inc. v. Scott's Liquid Gold, Inc., 224 U.S.P.Q. 512, 514 (T.T.A.B. 1984) ("the Board and the courts have on more than one occasion stated that third party registrations are to be given little or no weight in a proceeding such as this because they do not establish that the marks shown therein have been used, that they have been advertised or promoted, or that products have been sold thereunder and that they have some significance to the purchasing public"); Allied Mills, Inc. v. Kal Kan Foods, Inc., 203 U.S.P.Q. 390, 397 n.11 (T.T.A.B. 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with Section 8 affidavits are in use today or that such specimens have ever been used to the extent that they have made an impression on the public).

## II. APPLICANT'S TRIAL DECLARATIONS

Applicant has submitted Declarations of Jan Heininger (the "Heininger Declaration"), Raymond Adler (the "Adler Declaration"), Christopher Bouman (the "Bouman Declaration") and Lawrence Ferrara (the "Ferrara Declaration") (collectively, the "Declarations"). Opposer objects thereto as follows.

### A. General Objections

#### 1. Relevance

Federal Rule of Civil Procedure 402 states: "Evidence which is not relevant is not admissible." "Relevant evidence" is defined by Federal Rule of Civil Procedure 401<SoftRt> as "evidence having any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence." Irrelevant evidence may be disregarded. U.S. v. Crenshaw, 698 F.2d 1060, 1065 (9th Cir. 1983) (excluding affidavit as irrelevant); Thomas v. Baca, 514 F. Supp. 2d 1201, 1210-11 (C.D.Cal. 2007) (granting motion to strike irrelevant portions of declarations). Thus, the Board should strike and disregard those portions of the Declarations set forth below.

#### 2. Lack of Foundation/Personal Knowledge

Federal Rule of Evidence 602 states that "a witness may not testify to a matter unless evidence is introduced sufficient to support a finding that he has personal knowledge of the matter . . . ." Fed. R. Evid. 602. Accordingly, declarations which are not based on personal knowledge are entitled to no weight. Bank Melli Iran v. Pahlavi,

58 F.3d 1406, 1412 (9th Cir. 1995) (“declaration . . . entitled to no weight because the declarant did not have personal knowledge.”) To the extent that the Declarations fail to provide a sufficient foundation for the statements declared to and simply make blind representations without laying a proper foundation, the Board should strike and disregard those portions of the Declarations set forth below.

### 3. Improper Legal Conclusions

Portions of the Declarations should be stricken to the extent they improperly purport to offer legal conclusions and interpret documents. See Fed. R. Evid. 701. Thus, the Board should strike and disregard those portions of the Declarations set forth below which purport to offer legal conclusions and interpret documents.

### 4. Hearsay

Federal Rule of Evidence 802 provides that “hearsay is not admissible except as provided by these rules or by other rules prescribed by the Supreme Court pursuant to statutory authority or by Act of Congress.”<sup>1</sup> Thus, unless one of the enumerated hearsay exceptions is satisfied, it is error to admit an out-of-court statement offered to prove the truth of the matter asserted. See United States v. Tafollo-Cardenas, 897 F.2d 976, 979 (9th Cir. 1990) (testifying witness’ prior out-of-court statements were inadmissible hearsay and should have been excluded absent instruction limiting their use to impeachment). Hearsay statements must be stricken from the Declarations.

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<sup>1</sup> FRE 801(c) defines hearsay as “a statement, other than one made by the declarant while testifying at the trial or hearing, offered in evidence to prove the truth of the matter asserted.”

5. Best Evidence Rule

Federal Rule of Evidence 1002, commonly known as the “Best Evidence Rule,” requires that “to prove the content of a writing, recording, or photograph, the original writing, recording, or photograph is required, except as otherwise provided . . .” “When the contents of a writing are at issue, oral testimony as to the terms of the writing is subject to a greater risk of error than oral testimony as to events or other situations.”

Seiler v. Lucasfilm, Ltd., 808 F.2d 1316, 1318 (9th Cir. 1986). Thus, where the contents of a writing are sought to be proven, the proponent must submit the original document.

In re Mullins, 125 B.R. 808, 811 (Br. E.D. Cal. 1990); see also Seiler, 808 F.2d at 1319.

The Declarations violates this rule to the extent that they attempts to testify to the contents of documents. The documents “speak for themselves” and are the best evidence of their contents. Statements concerning the contents of documents evade the very protections that the Best Evidence Rule seeks to establish. See Seiler, 808 F.2d at 1319. Therefore, the Board should disregard the testimony as to the contents of the writings and exclude such testimony from evidence.

B. Specific Objections

1. Heining Declaration

STATEMENT	OBJECTIONS
3. Mattel's general process for naming products is as follows. Mattel's marketing and/or product design departments inform me about a new product line and will then	FRE 402 (not relevant); FRE 1002 (best evidence).

STATEMENT	OBJECTIONS
<p>ask me to create a name for the product line. I will then generate ideas for proposed names and submit the proposed names to the marketing department for approval. When the marketing department agrees on a proposed name, I will fill out a trademark search request form and email the request form to Mattel's legal department. Mattel's legal department will then implement a trademark search and notify me whether my proposed name has cleared the trademark search. If the mark clears the trademark search, I will then instruct Mattel's graphic designers to place the mark on the product's packaging.</p>	
<p>4. In approximately the fall of 2005, Mattel's marketing department assigned me the task of creating a name for a series of HOT WHEELS die-cast toy cars modeled on famous American "muscle cars"</p>	<p>FRE 402 (not relevant); FRE 602 (lack of personal knowledge); FRE 701 (opinion testimony by lay witness); FRE 802 (hearsay).</p>

STATEMENT	OBJECTIONS
<p>produced by the "Big Three" Detroit automakers (<i>i.e.</i> General Motors, Ford, and Chrysler) in the late 1960s and early 1970s. The term "muscle car" refers to a fast, high-performance, "hot rod" type car with a large, powerful V8 engine. Classic Detroit muscle cars include the Chevrolet Camaro, the Pontiac GTO, and the Plymouth Road Runner.</p>	
<p>5. As a native of Michigan and a car enthusiast, I was familiar with muscle cars in general and with the cars that Mattel's marketing and product design departments were planning to use for their series of muscle car HOT WHEELS. The series of muscle car toys I was responsible for naming was part of HOT WHEELS' Collector Group — a line of HOT WHEELS cars targeted at adult collectors.</p>	<p>FRE 402 (not relevant); FRE 701 (opinion testimony by lay witness).</p>

STATEMENT	OBJECTIONS
<p>6. I came up with the name "Motown Metal" for this line of HOT WHEELS toy cars. I chose "Motown Metal" because of</p> <p>(a) the word <i>metal's</i> association with cars, manufacturing, strength, and toughness;</p> <p>(b) the word <i>motown's</i> reference to and association with the city of Detroit, Michigan, where the Big Three automakers are headquartered and where these cars were originally produced; and (c) the alliteration and number of syllables of the words <i>motown</i> and <i>metal</i>. I relied on my knowledge and experience of American car culture, as well my experience with the HOT WHEELS lines of toy cars, in creating the name "Motown Metal." I felt that I chose a very good name for the line that accurately captured the spirit of these classic Detroit muscle cars.</p>	<p>FRE 402 (not relevant); RE 701 (opinion testimony by lay witness); FRE 1002 (best evidence).</p>
<p>7. I was and am aware that "Motown"</p>	<p>FRE 402 (not relevant); FRE 602 (lack of</p>

STATEMENT	OBJECTIONS
<p>is a nickname for the city of Detroit, Michigan. I was born and raised in Michigan and spent several years living in a suburb of Detroit. I understand that "motown" is a contraction of "motor town," and I am aware that Detroit is often referred to by the nicknames "Motown," "Motor Town," and "Motor City." I have personally heard the city of Detroit referred to as "Motown" on television and in conversation, and I have seen the city of Detroit referred to as "Motown" in print and Internet media.</p>	<p>personal knowledge); FRE 701 (opinion testimony by lay witness); FRE 802 (hearsay); FRE 1002 (best evidence).</p>
<p>8. After I created the name "Motown Metal," I submitted it to Mattel's marketing and product design departments for their approval. They approved this name for this line of HOT WHEELS "muscle cars." I then filed a request for a trademark search for "Motown Metal." It is my</p>	<p>FRE 402 (not relevant); FRE 602 (lack of personal knowledge); FRE 802 (hearsay).</p>



STATEMENT	OBJECTIONS
understanding that the mark "Motown Metal" cleared the trademark search and was approved by Mattel for use in connection with a line of HOT WHEELS toy cars.	

2. Adler Declaration

STATEMENT	OBJECTIONS
3. Mattel began creating the Motown Metal line of HOT WHEELS products in 2005. The Motown Metal line was introduced in the marketplace in 2006 and was sold in 2006 and 2007. The "theme" of the Motown Metal line was "Detroit muscle cars" — fast, powerful cars produced by the "Big Three" Detroit automakers (General Motors, Ford, and Chrysler) in the late 1960s and early 1970s.	FRE 701 (opinion testimony by lay witness).
4. Mattel produced and sold a basic line of five Motown Metal HOT WHEELS toys: a 1970 Chevrolet Chevelle, a 1965	FRE 602 (lack of personal knowledge).

STATEMENT	OBJECTIONS
<p>Ford Mustang, a 1970 Plymouth Road Runner, a 1967 Chevrolet Camaro, and a 1969 Pontiac GTO. These basic cars had a suggested retail price of \$0.99 each. Mattel also produced and sold a collector's edition two-car set containing a 1970 Ford Mustang "Boss" 429 and a 1969 Chevrolet Camaro. The suggested retail price of the two-car collector pack was \$19.99. This collector's edition is discussed in detail in the Declaration of Christopher Bouman submitted concurrently herewith.</p>	
<p>5. As part of my duties in Mattel's HOT WHEELS Marketing Group, I reviewed the five toy cars in the "basic line" to ensure that they fit the criteria for the Motown Metal series in that they represented Detroit muscle cars from the 1960s and 1970s. I also reviewed and approved the layouts of the packaging materials associated with the Motown Metal toys, which included the individual</p>	<p>FRE 402 (not relevant); FRE 602 (lack of personal knowledge).</p>

STATEMENT	OBJECTIONS
<p>"blister packs" for each car (the package that hangs on a hook in a retail store, containing one car only).</p>	
<p>7. The "Motown Metal" cars are also included in a printed Collector's Guide. A true and correct copy of the 2006 Collector's Guide is attached hereto as Exhibit B. To my knowledge, the poster attached as Exhibit A and the Collector's Guide attached as <b>Exhibit B</b> are the only marketing materials produced by Mattel that show the Motown Metal series of toy cars. The Motown Metal series was never advertised on television, radio, print, or Internet media separate or apart from the HOT WHEELS brand generally.</p>	<p>FRE 402 (not relevant).</p>
<p>8. The basic line of the Motown Metal toy cars were marketed primarily to boys ages three through six, as are all basic HOT WHEELS toys. The Motown Metal collector's edition two-pack was marketed primarily to the adult male collector market</p>	<p>FRE 602 (lack of personal knowledge); FRE 701 (opinion testimony by lay witness); FRE 1002 (best evidence).</p>

STATEMENT	OBJECTIONS
(males age 18 to 42).	
<p>10. Mattel generally sells HOT WHEELS toy cars directly to retail stores that typically sell Mattel products (e.g. Wal-Mart, Toys "R" Us, Kmart, KB Toys, certain individual drug and grocery stores) and in its own store located in Mattel's corporate offices in El Segundo, California. Retailers can only order HOT WHEELS cars in general assortments of between 18 and 144 individual cars. Retailers cannot select specific lines of HOT WHEELS to order, and they will not know what individual cars will be in an assortment until the shipment arrives. Mattel determines which HOT WHEELS toy cars will go into a given assortment based on a number of factors including market research, cost, and inventory. No retailer was ever able to order Motown Metal HOT WHEELS (or any distinct line of HOT WHEELS) specifically.</p>	FRE 402 (not relevant).

STATEMENT	OBJECTIONS
<p>11. To my knowledge, Mattel entered into no licenses or other agreements with third parties for use of the Motown Metal trademark.</p>	<p>FRE 402 (not relevant).</p>
<p>12. Mattel conducts consumer research regarding the HOT WHEELS brand. To my knowledge, Mattel never conducted consumer research on the Motown Metal line specifically, as opposed to HOT WHEELS in general. Mattel's consumer research suggests that boys ages three through six (the target demographic for the basic car lines) choose HOT WHEELS based first on their shape and styling, and then based on their color. Adult HOT WHEELS collectors are choosier and tend to research their purchases, ultimately deciding on an individual toy car because of the level of detailing in a collector model, because the original car on which the toy is modeled appeals to them, or to round out or complete a collection.</p>	<p>FRE 402 (not relevant); FRE 602 (lack of personal knowledge); FRE 701 (opinion testimony by lay witness); FRE 802 (hearsay); FRE 1002 (best evidence).</p>

3. Bouman Declaration

STATEMENT	OBJECTIONS
<p>3. Mattel produces a line of two-car collector packs called "Hot Wheels 100%." I oversee marketing for the Hot Wheels 100% line of products. Hot Wheels 100% products are sold as two toy cars in a clear plastic case. The toy cars in the Hot Wheels 100% line are highly detailed and feature opening hoods and doors, rubber tires, and detailed paint. They are intended to be very precise 1:64 ratio replicas of the cars they model. The Hot Wheels 100% line is marketed to the adult collector market, typically males aged 18 to 42. The suggested retail price for a Hot Wheels 100% two-pack is \$19.99.</p>	<p>FRE 402 (not relevant).</p>
<p>4. In 2007, in addition to a basic line of five Motown Metal HOT WHEELS toys (discussed in the Declaration of Raymond</p>	<p>FRE 602 (lack of personal knowledge); FRE 701 (opinion testimony by lay</p>

STATEMENT	OBJECTIONS
<p>Adler submitted concurrently herewith),</p> <p>Mattel produced a series of cars within the</p> <p>Hot Wheels 100% line called "Motown</p> <p>Metal." The two toy cars in the Motown</p> <p>Metal series were a 1970 Ford Mustang</p> <p>Boss 429 and a 1969 Chevrolet Camaro.</p> <p>These two cars are commonly referred to as</p> <p>"muscle cars" in the car fan and HOT</p> <p>WHEELS collector communities. The</p> <p>Motown Metal series of Hot Wheels 100%</p> <p>was sold in 2007 exclusively at Kmart</p> <p>stores and at Mattel's toy store located in its</p> <p>corporate headquarters in El Segundo,</p> <p>California.</p>	<p>witness).</p>
<p>5. As part of my duties at Mattel, I</p> <p>have attended both car shows and HOT</p> <p>WHEELS collectors' conventions and have</p> <p>interacted with both car enthusiasts and</p> <p>adult HOT WHEELS collectors.</p> <p>Furthermore, Mattel conducts marketing</p> <p>studies and consumer research into the</p>	<p>FRE 402 (not relevant); FRE 602 (lack of</p> <p>personal knowledge); FRE 701 (opinion</p> <p>testimony by lay witness).</p>

STATEMENT	OBJECTIONS
<p>buying habits of HOT WHEELS collectors.</p> <p>The adults who buy Hot Wheels 100% products are typically car "fanatics" and, as such, are very knowledgeable about cars and automotive history. From my personal experience talking with car fans and HOT WHEELS adult collectors, "Motown" is used synonymously with the city of Detroit, Michigan. Such collectors are aware that the muscle cars depicted in the Motown Metal series, and muscle cars in general, were manufactured by the "Big Three" American automakers (General Motors, Ford, and Chrysler). In fact, Ford produced the 1970 Mustang Boss 429 that is the model for one of the HOT WHEELS toy cars contained in the Hot Wheels 100% Motown Metal product, and Chevrolet is a brand owned by General Motors, which produced the 1969 Camaro that is the model for the other HOT WHEELS toy car contained in the Hot Wheels 100%</p>	



STATEMENT	OBJECTIONS
Motown Metal product.	
<p>6. Car fans, including adult HOT WHEELS collectors, know the Big Three Detroit automakers and know Detroit muscle cars. Adult HOT WHEELS collectors tend to be choosy about their purchases of HOT WHEELS. They tend to research their purchases, ultimately deciding on an individual toy car because of the level of detailing in a collector model, because the original car on which the toy is modeled appeals to them, or to round out or complete a collection. Such adult collectors, who are the target demographic for the Hot Wheels 100% products, would associate "Motown Metal" with the city of Detroit and its identity as the center of American car manufacturing.</p>	<p>FRE 402 (not relevant); FRE 602 (lack of personal knowledge); FRE 701 (opinion testimony by lay witness).</p>

4. Ferrara Declaration

<u>EVIDENCE</u>	<u>OBJECTION</u>
<p>2. On the basis of my musicological research it is my opinion that the term “Motown” refers both to a record company and more broadly is used as a descriptive term for a musical style or genre that extends beyond the Motown record company. In addition, numerous recording artists and performers are associated with the Motown style but did not record on the Motown Record label. My research findings are consistent with the “Motown” entry in <i>The New Grove Dictionary of Music and Musicians</i>. Therein, the first sentence bifurcates reference to the record company from the musical style:</p> <p><b>Motown.</b> American record company specializing in black soul music; the name is the registered trademark of the company but has also come to be used as a descriptive term for the associated musical style. (Volume 17, p. 229, ©2001. The entire entry is attached as <b>Exhibit B.</b>)</p>	<p>FRE 402 (not relevant); FRE 602 (lack of personal knowledge); vague and ambiguous.</p>
<p>3. There are countless uses of the term</p>	<p>FRE 402 (not relevant); FRE 602 (lack of</p>

<u><b>EVIDENCE</b></u>	<u><b>OBJECTION</b></u>
<p>“Motown” in which it is associated with a musical style or genre. In order to facilitate the reading of this section of my Declaration, the following citations are correlated with their sources by identifying the exhibit in which the source is attached.</p>	<p>personal knowledge); vague and ambiguous.</p>
<p>4. <b>Exhibit C.</b> In the book <i>Popular Music and the Underground</i>, “Motown” is used as a musical style or genre along with Rock and R&amp;B as follows:</p> <p>Rock, Motown, and R&amp;B might have dominated the charts and the airwaves but there was always room for Sinatra to hit with “Strangers in the Night” or “Something Stupid” and Dean Martin to score with “Memories Are Made of This” or “Julie Do You Love Me.” (p. 331, © 1996)</p>	<p>FRE 402 (not relevant); FRE 1002 (best evidence); vague and ambiguous.</p>
<p>5. <b>Exhibit D.</b> In an article in the scholarly journal <i>American Sociological Review</i>, “Motown” is listed with multiple other musical styles or genres as follows:</p> <p>Possible examples of innovation include rave, techno, acid jazz, grunge, rap, house, New Age, disco, funk, punk, acid rock, Motown, big beat, folk-rock, soul,</p>	<p>FRE 402 (not relevant); FRE 1002 (best evidence); vague and ambiguous.</p>

<u>EVIDENCE</u>	<u>OBJECTION</u>
rockabilly, do-wop, bop, torch, swing, etc. (p. 176, © 1996)	
<p>6. <b>Exhibit E.</b> In an article in the scholarly journal <i>Black Music Research Journal</i>, “Motown” is listed with funk as a musical style as follows:</p> <p>This model – highly produced instrumental music based upon 1970[‘]s black popular styles like Motown and funk – became the standard for many of CTI’s subsequent recordings, and it would continue to develop alongside those genres. (p. 6, © 2008)</p>	FRE 402 (not relevant); FRE 1002 (best evidence); vague and ambiguous.
<p>7. <b>Exhibit F.</b> In a review in the <i>Star Tribune</i>, a Minneapolis newspaper, “Motown” is listed with multiple other musical styles or genres as follows:</p> <p>Musical director Andrew Cooke brings to life composer Jeanine Tesori’s gorgeous music, a gumbo of gospel and classical, klezmer, Motown and R&amp;B. (p. 2, © 2009)</p>	FRE 402 (not relevant); FRE 1002 (best evidence); vague and ambiguous.
<p>8. <b>Exhibit G.</b> In a review in the <i>New York Amsterdam News</i>, “Motown” is used interchangeably with “rhythm and blues” as follows:</p> <p>Joe Cuba’s Sextet became popular in the</p>	FRE 402 (not relevant); FRE 1002 (best evidence); vague and ambiguous.

<u><b>EVIDENCE</b></u>	<u><b>OBJECTION</b></u>
New York Latino community precisely because it fused a bilingual mix of AfroCaribbean genres blended with the popular urban rhythm and blues of its time, creating a musical marriage between the Fania and Motown sound. (p. 1, 2009)	
<p>9. <b>Exhibit H.</b> In the “Coolsoundz” mobile disco website, “Motown” is listed with multiple other musical styles or genres as follows:</p> <p>We play the best in R’n’B, Pop, Rock, Dance, Funk, Salsa, Soca, Reggae, Dancehall, Bhangra, Hip-Hop, Bollywood, Zouk, Highlife, Kizomba, Reggaeton, Makossa, Afro beats, Motown, and much more. (p. 1, © 2009)</p>	FRE 402 (not relevant); FRE 1002 (best evidence); vague and ambiguous.
<p>10. <b>Exhibit I.</b> In the “Samhillbands.com” website under “Book or Hire a Band,” “Motown” is listed with other musical styles or genres as follows:</p> <p>Motown, Soul, Oldies, Beach, Variety (p. 1, © 2003-2007)</p>	FRE 402 (not relevant); FRE 1002 (best evidence); vague and ambiguous.
<p>11. <b>Exhibit J.</b> In a <i>Billboard</i> magazine review of a CD release by Ben Harper, “Motown” is used as a musical style or genre as follows:</p>	FRE 402 (not relevant); FRE 1002 (best evidence); vague and ambiguous.

<u>EVIDENCE</u>	<u>OBJECTION</u>
<p>The Eastern-flavored, feel-good single “Better Way” opens disc one, which mixes Motown funk with orchestra (“Black Rain,” a reaction to Hurricane Katrina), a demo-ish Rolling Stones parody (“Please Don’t Talk About Murder While I’m Eating”) and smoky bar swing (“The Way You Found Me”). (p. 1, © 2006)</p>	
<p>12. <b>Exhibit K.</b> The title of a biography of Aretha Franklin is <i>Aretha Franklin: Motown Superstar</i>. (© 1996) However, Aretha Franklin was never signed to the Motown Record label. She was signed to Columbia, Atlantic, and Arista.</p>	<p>FRE 402 (not relevant); FRE 602 (lack of personal knowledge); FRE 1002 (best evidence); vague and ambiguous.</p>
<p>13. <b>Exhibit L.</b> In a review in the <i>Birmingham Mail</i> (United Kingdom), Tina Turner is refereed to as a “Motown legend.” Tina Turner was never signed to Motown Records. She was signed to Capitol, EMI, Parlophone, and Virgin.</p> <p>Surrounded by four scantily-clad dancers, she’d managed to bring the arena’s crowd to its feet and the party was in full swing by the time the Motown legend moved onto the soul spectacular River Deep. (p. 1, 2009)</p>	<p>FRE 402 (not relevant); FRE 602 (lack of personal knowledge); FRE 1002 (best evidence); vague and ambiguous.</p>
<p>14. <b>Exhibit M.</b> In a news release in <i>The</i></p>	<p>FRE 402 (not relevant); FRE 602 (lack of</p>

<u><b>EVIDENCE</b></u>	<u><b>OBJECTION</b></u>
<p><i>Blade</i> from Toledo, Ohio about a concert series, Aretha Franklin is listed as a Motown artist but as noted above, she was never signed to Motown Records. In addition, “Motown” is used as a musical style in the news release as follows:</p> <p>The early Motown music of Stevie Wonder, Aretha Franklin, Marvin Gaye and Smokey Robinson will be featured, and the three emerging artists will share stories and talk about the influence Motown had on their work. (p.1, © 2009)</p>	<p>personal knowledge); FRE 1002 (best evidence); vague and ambiguous.</p>
<p>15. <b>Exhibit N.</b> In a review of the musical <i>Little Shop of Horrors</i> (in the <i>Orange County Register</i> in Santa Ana, California), the reviewer ascribes the Motown genre or style to original songs written for the musical. However, the original songs were not recorded on Motown records and were not written by a Motown record company composer. The songs in <i>Little Shop of Horrors</i> were composed by Alan Menken (with lyrics by</p>	<p>FRE 402 (not relevant); FRE 602 (lack of personal knowledge); FRE 1002 (best evidence); vague and ambiguous.</p>

<u>EVIDENCE</u>	<u>OBJECTION</u>
Howard Ashman).  Ashman and Menken retained that tone and added early '60s doowop and Motown music of their own.... (p. 1, © 2008)	
16. While Motown is known as a record company, from a musicological perspective it is also widely known and regarded as a descriptive term for a musical style or genre that extends beyond the Motown record company.	FRE 402 (not relevant); FRE 602 (lack of personal knowledge); vague and ambiguous.

January 12, 2010

Respectfully submitted,



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Attorneys for Opposer



**CERTIFICATE OF MAILING**

Date of Deposit: January 12, 2010

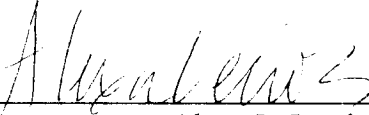
"Express Mail" mailing label number: EB 519288534 US

I hereby certify that this paper or fee, **TRIAL BRIEF OF OPPOSER UMG RECORDINGS, INC., IN SUPPORT OF NOTICE OF OPPOSITION**, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" on the date indicated above and is addressed to: UNITED STATES PATENT AND TRADEMARK OFFICE, Trademark Trial and Appeal Board , P.O. Box 1451, Alexandria, Virginia 22313-1451.

  
\_\_\_\_\_  
Alexa L. Lewis

**CERTIFICATE OF SERVICE**

I hereby certify that on this 12th day of January, 2010, a true and correct copy of the foregoing **TRIAL BRIEF OF OPPOSER UMG RECORDINGS, INC., IN SUPPORT OF NOTICE OF OPPOSITION**, was served upon Opposer's counsel of record by hand delivery, to the following address: Lawrence Y. Iser, Patricia A. Millett, Chad R. Fitzgerald, Kinsella, Weitzman, Iser, Kump & Aldisert LLP, 808 Wilshire Boulevard, 3rd Floor, Santa Monica, CA 90401.

  
\_\_\_\_\_  
Alexa L. Lewis

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 78/751,105  
Published for Opposition in the OFFICIAL GAZETTE on December 12, 2006

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UMG RECORDINGS, INC.

Opposition No.: 91176791

Opposer

v.

MATTEL, INC.,

Applicant

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**APPENDIX OF CASES TO TRIAL BRIEF OF OPPOSER**  
**UMG RECORDINGS, INC., PURSUANT TO**  
**OFFICIAL GAZETTE NOTICE OF 23 JANUARY 2007**

Pursuant to Official Gazette Notice No. 11 published January 23, 2007, Opposer UMG Recordings, Inc. hereby submits true and correct copies of the following decisions in connection with its Trial Brief in support of its Notice of Opposition.


- (1) In re Craft House Corp., 2001 WL 862284 (T.T.A.B. 2001).
- (2) The Sports Authority Michigan, Inc. v. The PC Authority, Inc., 2002 WL 575718 (T.T.A.B. 2002).

In addition, for the Board's convenience, attached are true and correct copies of the following decisions available on Westlaw:

- (3) Hormel Foods Corp. & Hormel Foods, LLC v. Spam Arrest, LLC, 2007 WL 4287254 (T.T.A.B. 2007).
- (4) In re Toy Concepts, 2006 WL 478990 (T.T.A.B. 2006).
- (5) Nautica Apparel, Inc v. Carlucci, 2007 WL 4616268 (T.T.A.B. 2007).
- (6) Playboy Enter. Int'l, Inc. v. Worobec, 2008 WL 906635 (T.T.A.B. 2008).
- (7) Scheder v. Touristik Arbeitsgemeinschaft Romantische Strabe GBR, 2007 WL 1849136 (T.T.A.B. 2007).
- (8) Virgin Enter. Ltd. v. Albion Motors Ford Mercury, Inc., 2007 WL 2344691 (T.T.A.B. 2007).

Respectfully submitted,

Date: January 12, 2010

  
\_\_\_\_\_  
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# **EXHIBIT 1**

# **EXHIBIT 1**

2001 WL 862284 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

IN RE CRAFT HOUSE CORPORATION

Serial No. 75/573,277

July 30, 2001

Richard G. Martin of MacMillan, Sobanski & Todd, LLC for Craft House Corporation.

Leslie L. Richards, Trademark Examining Attorney  
Law Office 106  
(Mary I. Sparrow, Managing Attorney).

Before Hohein, Bottorff and Holtzman  
Administrative Trademark Judges.  
Opinion by Holtzman  
Administrative Trademark Judge:

An application has been filed by Craft House Corporation to register the mark BUILD N' PLAY for "toy model hobbycraft kits."<sup>[FN1]</sup>

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles the previously registered mark BUILD 'N PLAY for "toy tables, trays and chairs, and geometric shapes, namely, blocks, numbers and letters usable therewith" as to be likely to cause confusion.<sup>[FN2]</sup>

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs. Although applicant had requested an oral hearing, that request was subsequently withdrawn.

In any likelihood of confusion analysis, we look to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand and the evidence of record, including the similarity of the marks and the relatedness of the goods or services.

The marks in this case are essentially identical. The one, barely perceptible difference in the marks is the placement of the apostrophe to the right of the "N" in applicant's mark and to the left of the "N" in registrant's mark. The marks are otherwise identical in sound, appearance and meaning. Applicant does not dispute the identity of the marks but argues instead that registrant's mark BUILD 'N PLAY is not "highly distinctive." Applicant reasons that although

the mark “is arbitrary in relation to the identified goods,” the individual words “build and “play” are “relatively common words” and therefore entitled to only a narrow scope of protection.

The question is not simply whether, in the abstract, the mark is composed of common words but rather whether those words have a meaning in relation to the identified goods, or whether the mark is commonly used on the related goods and services of different companies. See, e.g., National Cable Television Association, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 19 USPQ 1424 (Fed. Cir. 1991) [“Cable’s [plaintiff-appellant’s] argument that it can use ACE because ACE is a ‘weak’ mark, as an abstract proposition, is not only unpersuasive but essentially meaningless.”]. We note that the factor to be considered in determining likelihood of confusion, and specifically the strength of a mark, under *du Pont* is the “number and nature of similar marks in use on similar goods.” See *In re E. I. du Pont de Nemours & Co.*, supra at 567.

\*2 In this case, there is no evidence that BUILD ‘N PLAY is highly suggestive of the identified goods or that the mark is commonly used by others in related fields. Applicant has introduced no evidence of third-party registrations or uses of similar marks in the relevant market or any other evidence to support its claim that registrant’s mark is entitled to only a narrow scope of protection.<sup>[FN3]</sup>

We turn then to a consideration of the respective goods. The Examining Attorney argues that applicant’s toy model hobbycraft kits and registrant’s toy tables, trays and chairs, and geometric shapes, namely, blocks, numbers and letters usable therewith, are related in that they are both primarily “toys” and have some similar properties, and that the purchasers and channels of trade for the respective goods are the same. The Examining Attorney has made of record several third-party registrations which she claims illustrate that goods of the type herein may emanate from the same source.<sup>[FN4]</sup>

Applicant, on the other hand, argues that merely because the word “toy” appears in both identifications of goods and that the respective goods co-exist in the same broad industry does not mean they are related goods. It is applicant’s position that its model hobbycraft kits “are distinct” from registrant’s “tables, trays and chairs, and blocks, numbers and letters usable therewith” in that, unlike registrant’s goods, applicant’s kits will require a certain level of skill to assemble “into finished models which are collected and developed into a series.” Applicant maintains that assembly “is not a key feature of [registrant’s] goods” and that those goods are intended for use by inexperienced and unskilled young children. Applicant further argues that the customers for applicant’s goods are adults and older children whereas the customers for registrant’s goods are adults who purchase the goods for use by toddlers and young children; that applicant’s goods would not be sold in the same sections of stores alongside other goods designed for toddlers and young children, but instead grouped together in model or hobbycraft sections of the stores; and that purchasers of toddler play furniture and toys are likely to exercise considerable care in their purchasing decisions.

Where the marks are essentially identical, as in this case, it is only necessary that there be a viable relationship between the goods in order to support a holding of likelihood of confusion. In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

It is true that there are specific differences in the respective products and they are not competitive. However, the question is not whether purchasers can differentiate the goods themselves but rather whether purchasers are likely to confuse the source of the goods. See Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989). Thus, it is not necessary that the goods of the applicant and registrant be similar or even competitive to support a finding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

**\*3** Notwithstanding applicant's arguments, we find that there is at least a viable relationship between these goods. Admittedly, the goods are essentially different and are directed to different age groups. Registrant's goods, in this regard, consist of toy furniture and geometric shapes, namely blocks, numbers and letters usable therewith, and are undoubtedly intended for use by toddlers or young children.<sup>[FN5]</sup> Applicant's goods, on the other hand, are toy model hobbycraft kits and it is reasonable to assume that those kits are used by older children. Nevertheless the respective goods are related to the extent that registrant's blocks, numbers and letters, and applicant's toy model kits are both activity toys, with both requiring age-appropriate levels of cognitive and manual skills and having what the Examining Attorney describes as building or construction properties. These are meaningful similarities when we consider that such goods are sold under identical marks to the very same purchasers in the very same stores. Although the intended users of the respective toys may be different, the primary purchasers thereof, that is the adults who would actually buy the toys, are the same. Moreover, both toys can typically be found in such retail outlets as toy stores and toy departments of other stores. We have no evidence that applicant's and registrant's toys typically would be displayed in different aisles or sections of a toy department nor do we find that to be an important consideration since these products may not even be purchased at the same time. The typical purchasers for these goods, for example, parents who had previously purchased registrant's BUILD 'N PLAY furniture and blocks for their younger child, upon encountering applicant's toy model kits under the identical BUILD N' PLAY mark for their older child, regardless of where or even when they found it in the store, are likely to assume that that registrant has a line of activity toys under the mark BUILD 'N PLAY which appeal to different age groups or that the goods are associated with or sponsored by the same company.

We note, in this regard, that the third-party registrations made of record by the Examining Attorney show that at least one company has registered the same mark for both building blocks and hobby kits and that two other companies have registered their marks for hobby kits as well as toys which would be used by toddlers or young children. Although these registrations are not evidence of use of the marks in commerce, they have probative value to the extent that they suggest that, despite the differences in the identified goods, they are of a type which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, *supra* at 1785-1786; and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988).

Moreover, both applicant's and registrant's toys are relatively inexpensive and are therefore likely to be purchased casually and on impulse, thus increasing the risk of confusion. *Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.*, 774 F.2d 1144, 1146, 227 USPQ 541, 542 (Fed. Cir. 1985). While purchasers may care about the toys they are purchasing for use by their children and therefore exercise a certain degree of care in selecting such products, they are not necessarily sophisticated purchasers or likely to exercise a high degree of care in terms of examining the trademarks.

**\*4** Finally, to the extent that there is any doubt on the issue of likelihood of confusion, it is settled that such doubt must be resolved in favor of the prior registrant. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

**Decision:** The refusal to register is affirmed.

FN1. Application Serial No. 75/573,277; filed October 19, 1998; alleging a bona fide intention to use the mark in commerce.

FN2. Registration No. 2,077,030; issued July 8, 1997.

FN3. There is no evidence in the record to support applicant's claims that "[f]rom a trademark perspective, the field [of children's toys] is very crowded" and that "[t]he same or similar marks are able to co-exist in the toy industry." (Brief, p. 3).

FN4. The Examining Attorney has attached additional third-party registrations to her appeal brief. Since this evi-

dence is untimely, it has not been considered. See Trademark Rule 2.142(d).

FN5. However, we disagree with applicant's characterization of registrant's furniture as "miniature" as that word suggests doll-size furniture rather than child-size furniture.

2001 WL 862284 (Trademark Tr. & App. Bd.)  
END OF DOCUMENT



# **EXHIBIT 2**

# **EXHIBIT 2**

2002 WL 745589 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

THE SPORTS AUTHORITY MICHIGAN, INC.

v.

THE PC AUTHORITY, INC.

April 16, 2002  
Hearing: June 6, 2001

Opposition No. 113,785 to application Serial Nos. 75/289,273, filed May 9, 1997, and 75/313,524, filed June 23, 1997

R. Terrance Rader, Glenn E. Forbis and Kristin L. Murphy of Rader, Fishman & Grauer PLLC for The Sports Authority Michigan, Inc.

Thomas J. Donovan, Sarah B. Knowlton and Mark A. Wright of McLane, Graf, Raulerson & Middleton, P.A. for The PC Authority

Before Simms, Wendel and Rogers  
Administrative Trademark Judges  
Opinion by Rogers  
Administrative Trademark Judge

Applicant The PC Authority, Inc. [PCA] has applied to register the mark THE PERSONAL COMPUTER AUTHORITY and the mark set forth below, each for services identified as "retail stores featuring computer hardware and software, computer accessories, computer networking products and peripheral devices," in International Class 35, and "consultation and design for others in the field of computer hardware and software, computer accessories, computer networking products and peripheral devices," in International Class 42. Each application is based on an allegation of use of the applied-for mark in commerce, with June 30, 1995 asserted as the date of first use and first use in commerce. The applications include, respectively, disclaimers of "Personal Computer" and "PC."



THE PLEADINGS

Registration of these marks has been opposed by The Sports Authority Michigan, Inc. [TSAM], under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d). Opposer alleges there is a likelihood of confusion or mistake among consumers, or that they would be deceived, in view of opposer's (1) ownership of four incontestable registrations for AUTHORITY, THE SPORTS AUTHORITY, THE SPORTS AUTHORITY & design, and THE SKI AUTHORITY; (2) opposer's "prior adoption, use and registration of use [sic]" of THE SPORTS AUTHORITY as a trade name; (3) opposer's "prior adoption and use of a family of marks dominated by the word 'AUTHORITY'"; and (4) opposer's "numerous" registrations for marks "dominated by the word 'AUTHORITY'," 35 of which are set forth by mark, registration number and class of goods or services in a chart in the notice of opposition.<sup>[FN1]</sup> Opposer asserts that TSAM licenses its parent company, The Sports Authority, Inc. to use TSAM's marks and registrations on or in connection with approximately 200 retail sporting goods stores spread among 32 states. Opposer also asserts that it is the largest full-line sporting goods retailer in the United States, marketing "hardline" items, "softline" items, and various services, both at retail and on a wholesale basis for use or resale by other enterprises. The goods and services, according to the notice of opposition, "have met with great commercial success and widespread consumer recognition"; and the marks and trade name used on or in connection with these have been used continuously since adoption. Opposer asserts that its marks have been advertised and promoted in such a manner as to establish the marks as a family of marks; and that its registrations for individual marks are valid and subsisting.<sup>[FN2]</sup>

\*2 Applicant has admitted opposer's allegations that applicant "is engaged in the customized retail and wholesale of personal computers and in computer training"; that applicant's applications include disclaimers; and that opposer's registrations "issued." Applicant otherwise denies the salient allegations of the notice of opposition. In addition, applicant has asserted that the "use of the term 'AUTHORITY' cannot be distinctive or exclusive to the Opposer" in view of the number of registered marks including that term; that opposer "did not or could not oppose certain of these AUTHORITY-containing registrations/applications" and is "therefore barred by laches, acquiescence and estoppel" from contesting applicant's application; and that the respective customers of opposer and applicant "differ markedly" so that confusion is not likely.<sup>[FN3]</sup>

#### THE RECORD

The record consists of the pleadings; the files of the opposed applications; and a notice of reliance filed by each party.<sup>[FN4]</sup> Opposer's notice of reliance introduced the Fed. R. Civ. P. 30(b)(6) discovery deposition and exhibits of Paul M. LaRochelle, applicant's president; certified copies of 36 registrations for various marks of opposer, each of which includes the term "Authority"; applicant's responses to opposer's first set of requests for admissions; the trial testimony deposition of Michael A. Lisi, senior vice president of opposer TSAM, and exhibits; and the trial testimony deposition, with exhibits, of Robert Meyers, the manager of THE SPORTS AUTHORITY store in Manchester, New Hampshire, where applicant is located. Opposer also introduced, during rebuttal, additional testimony of Mr. Lisi, with one exhibit.

Applicant's notice of reliance introduced the discovery depositions of Michael Lisi and Robert Meyers; copies of 41 third-party registrations retrieved from the Office's electronic records, each of which includes the term "Authority"; opposer's response to applicant's first set of interrogatories; the trial testimony deposition of Paul LaRochelle, and exhibits; and the trial testimony deposition of Clifford Sewing, and exhibits.

Certain comments are in order in regard to the record, even before consideration of the parties' objections to particular items of evidence.

First, each party has submitted discovery deposition transcripts in toto, i.e., has made no apparent effort to identify and introduce only those portions that are relevant to our determination of the pleaded claims. While not improper, it is more effective to file only those portions that are relevant and explain their relevancy in the notice of reliance. See Wear-Guard Corp. v. Van Dyne-Crotty Inc., 18 USPQ2d 1804, 1805 n.1 (TTAB 1990) (petitioner introduced selected portions of discovery depositions of registrant's witnesses), and Marion Laboratories Inc. v. Biochemical/Diagnostics Inc., 6 USPQ2d 1215, 1217 n.9 (TTAB 1988) (opposer introduced only portions of discovery deposition of applicant's president); see also, 37 C.F.R. §2.120(j)(4) in regard to adverse party offering additional portions necessary to ensure fairness.

\*3 Second, not one of the deposition transcripts, including those from discovery and testimony, has been signed by the witness, yet only some of the transcripts include references to signature requirements having been waived by agreement of the

parties. There having been no objections, however, in this regard, to any of the transcripts, they all have been considered.

Third, the parties have not been precise in the handling and submission of apparently confidential testimony and documents. For example, whole transcripts of testimony depositions have been labeled as confidential when it is clear from reading the transcripts that only portions thereof were intended to be shielded from public view. Also, each party has failed, in some respect, to submit under seal material it obtained during discovery and which was marked as confidential at the time of production.<sup>[FN5]</sup> The parties are reminded that material should be designated as confidential, and as requiring handling as such, only when absolutely necessary. A stipulated protective agreement may not be used as a means of circumventing relevant provisions of 37 C.F.R. §2.27, which provide, in essence, that trademark application and registration files, and related TTAB proceeding files, generally should be available for public inspection.<sup>[FN6]</sup>

#### **OBJECTIONS TO EVIDENCE, BY OPPOSER:**

Opposer argues in its brief that “[d]espite TSAM’s discovery requests related to third-party uses and the evidence that Applicant anticipated introducing at trial, Applicant failed to timely produce the documents in LaRochelle exhibits 17-19.”<sup>[FN7]</sup> (TSAM brief p.35) Opposer has acknowledged that applicant did produce these documents, but only two weeks before the LaRochelle testimony deposition (LaRochelle test. p.70), and asserts that counsel for PCA “waited until after the discovery period closed to instruct” the witness to search for the documents and “waited until just before the testimony deposition” to produce them. (TSAM brief p.35)

PCA asserts that the production made before the deposition was not in response to discovery requests, because the documents did not exist during discovery and “were created in preparation for trial, and therefore, are covered by the work product doctrine.” (PCA brief p.36) PCA also argues that the produced documents are publicly available web sites and opposer could have gotten them on its own. (PCA brief pp.36-37) Finally, PCA asserts TSAM “relied” on the disputed material at pages 6-7 and 17-23 of the Lisi rebuttal testimony deposition. The former two pages of testimony clearly relate to applicant’s introduction of third-party registrations not web page evidence; but pages 17-23 do involve discussion of the probative value of the web material, insofar as the witness explains which purported uses he believes require opposer’s intervention, which do not, and which present the term “Authority” in a different sense from the way in which it is used by TSAM.

\*4 We note that TSAM’s real complaint appears to be that PCA did not indicate, when they were produced, that the documents “would be used at trial.” (LaRochelle test. p.73) It is well settled, however, that in a Board proceeding a party need not specify, prior to trial, the evidence or witnesses it intends to present. See authorities collected at TBMP §419(7). Moreover, even if a party could be expected to make such specification in response to a discovery request, TSAM has not provided any proof that it served a discovery request seeking such.

Insofar as the produced documents would be considered responsive to TSAM’s interrogatory no. 13, TSAM’s only complaint can be that there was a delay in production of the web material found by LaRochelle, for it is clear that PCA was under no obligation to search for third-party uses that would be responsive to the interrogatory. See authorities collected at TBMP §419(9). We see no evidence of undue delay. The record reveals that discovery closed November 30, 1999; LaRochelle was instructed by counsel, by memo dated December 27, 1999, to search the web for uses of the term “Authority”; LaRochelle did some searching in January 2000; the web pages were printed out in March and April 2000 with the printed documents promptly produced to TSAM; and the deposition was held on May 3, 2000. There is no evidence to support TSAM’s contention that printing of the documents was intentionally delayed, so as to delay production.

TSAM’s motion to strike LaRochelle exhibits 17-19 is denied. We note, however, that our denial of the motion only means that the material is part of the evidentiary record. The probative value of the material is a separate matter.

Opposer also objects to the entire testimony of Clifford Sewing as an “expert” who was not identified, i.e., an expert on the operation of BIG YELLOW, which is alleged to be an Internet search engine and “Bell Atlantic’s Yellow Pages on the internet.” (LaRochelle test. p.101) TSAM has not, however, provided a copy of any interrogatory or other discovery request that called for PCA to identify experts it would depose at trial. While it is clear that the identity of an expert witness to be called

at trial is discoverable, there is no automatic disclosure requirement in Board proceedings. Thus, in the absence of proof that TSAM requested PCA to identify its expert witnesses, we cannot say that PCA failed to do so. TSAM's argument that Sewing should have been identified in response to a discovery request calling for identification of "witnesses having knowledge relating to the opposition" (TSAM brief p. 36) fails for the same reason, i.e., we have not been provided with evidence of any such discovery request.

Finally, TSAM argues that the Sewing testimony is not relevant, since it does not cover issues related to likelihood of confusion and is limited to operation of BIG YELLOW. In this regard, PCA argues that the Sewing testimony is relevant because it authenticates and provides foundation for LaRochelle exhibits 18 and 19. (PCA brief p.38) PCA reasons that because the LaRochelle exhibits are relevant, so is the Sewing testimony "establishing the reliability of the [BIG YELLOW] listings." (PCA Brief p.39) We find the Sewing testimony relevant to the working of the search engine that was used by LaRochelle to produce LaRochelle exhibits 18 and 19, and deny TSAM's motion to strike the testimony.

#### **OBJECTIONS TO EVIDENCE, BY APPLICANT:**

\*5 Opposer pleaded ownership of 35 federal registrations, but attempted to introduce 36 into the record by its notice of reliance, and referenced 38 in its brief. Applicant, in its brief, objects to one of the pleaded 35 (Reg. No. 2,071,449) as not having been properly proved by the TSAM notice of reliance, and objects to one of the three unpleaded registrations (Reg. No. 2,274,172) referenced in the brief as not properly proved. (PCA brief p.35)

Applicant's objection to TSAM's reliance, in its brief, on Reg. No. 2,274,172 is sustained, since the registration was not pleaded and its status and title have not been proved. No consideration shall be given to that registration or to Reg. No. 2,282,414 which, likewise, was not pleaded or properly proved.

We also have disregarded Reg. No. 2,141,699 which, though pleaded, was not properly proved insofar as TSAM's notice of reliance includes only a plain copy thereof. In contrast, we have considered Reg. No. 2,249,780 which was not pleaded but which was properly proved by submission of a certified copy showing status and title and to which PCA has made no objection.

As to the objection to Reg. No. 2,071,449, we note that this registration is, as illustrated by the charts in TSAM's pleading and brief, for the mark THE SPORTS AUTHORITY. Attached to TSAM's notice of reliance, in an attempt to prove status and title of the registration, is a certification sheet from the Office that certifies that the registration is subsisting and owned by opposer. However, attached to the certification sheet is a photocopy not of Reg. No. 2,071,449 for THE SPORTS AUTHORITY, but a photocopy of Reg. No. 2,071,499 for the mark QUAKER MAID. TSAM, with its reply brief, submitted a substitute certified copy with the appropriate photocopy, and explained that the Office had attached the wrong photocopy to the certification sheet submitted with TSAM's notice of reliance. We overrule applicant's objection to the proof of Reg. No. 2,071,449, and have considered it.<sup>[FN8]</sup>

Applicant also objects to testimony of TSAM witness Lisi on state registrations, for which the only supporting evidence is a list introduced as Lisi exh. 32. PCA also argues that TSAM did not indicate its intent to rely on these registrations in its notice of reliance and, therefore, they are not properly of record. We overrule the objection to Lisi's testimony, and the accompanying exhibit. That official records, such as those which would prove the status and title of state registrations, may be made of record by notice of reliance does not render the Lisi testimony improper, though it has little, if any, probative value, especially since the exhibit is merely a list of these purported state registrations and we have not been provided with any copies of the individual registrations.

Applicant also objects to opposer's introduction in its brief of a "chart of its policing efforts," arguing that the exhibit cited as the source thereof does not exist and that the chart is different from both the chart produced in response to PCA's discovery requests and the chart discussed by TSAM witness Lisi. (PCA brief p.36) Opposer asserts that the chart in the brief is nothing more than a combination of (1) a chart produced to PCA during discovery and introduced into the record by PCA's notice of reliance on the Lisi discovery deposition, and (2) a chart discussed by Lisi during his testimony deposition. While we do not

approve of opposer's methods<sup>[FN9]</sup>, we overrule the objection insofar as we discern no prejudice to applicant by the reproduction in the brief of a chart combining other items properly made of record. To the extent the brief chart includes references to enforcement activities not reported in either of the other charts, such references have not been considered.

#### THE PARTIES AND THEIR ACTIVITIES

\*6 The record shows that opposer<sup>[FN10]</sup> was formed in 1987 and has expanded rapidly, especially during the mid-1990s. It has a chain of approximately 200 large retail stores spread throughout 32 states, offers goods via catalogue, and has a web site which originally was only a source of information on opposer's stores and goods, but now is an additional sales outlet. One of opposer's stores is located in Manchester, New Hampshire, where applicant's store is located, and another of opposer's stores is in Nashua, New Hampshire. These stores opened, respectively, on November 11, 1993 and August 12, 1994.

Each of opposer's stores features up to 40,000 or more goods, including footwear, clothing (both for athletic and casual wear), "hardline" sporting goods (such as bicycles, golf, tennis, and hockey equipment), outdoor goods such as camping and fishing gear, and electronic items used in outdoor activities (such as two-way radios, global positioning systems, depth/fish finders) and indoors (such as computer games and heart-rate monitors). In short, the testimony of TSAM witness Lisi, and exhibits thereto, demonstrate that opposer actually offers for sale the wide variety of items listed in the registrations referenced earlier in this decision.

Opposer advertises its stores in magazines and newspapers, on radio and television, on billboards, on other signs (such as on buses or at bus stops), via signs and sponsorship arrangements at numerous sporting events and venues where such events are held, and through cross-promotional advertising on various web sites other than opposer's own web site. Most of its advertising dollars are spent on print ads in the locations in which opposer operates stores. In its stores, opposer's core marks -- THE SPORTS AUTHORITY and THE SPORTS AUTHORITY logo -- are used in many ways, including on store signs, hang tags or stickers listing prices of merchandise, bags and boxes, business forms and receipts, and on employee apparel. Other marks in opposer's purported family, registered or unregistered, are used in varying degrees.<sup>[FN11]</sup> In addition, the record reveals regular and widespread use of "www.thesportsauthority.com" to direct prospective customers to its web site.

Opposer is the largest sporting goods retailer in the United States and one of the top 50-100 retailers of all types. Between 1987 and 1998, opposer's sales totaled more than \$7.7 billion, with annual sales over a billion dollars a year from 1995 on. Its advertising expenditures between 1988 and 1998 totaled nearly \$335 million; and expenditures in 1998 alone were nearly \$70 million. Opposer's sales were, however, down in the first three quarters of its 1999 fiscal year and it closed some underperforming stores.

Applicant is a small business with one store located in Manchester, New Hampshire. Applicant adopted its marks and opened its store in June 1995, and has used its marks in the operation of the store since that time. Applicant is the successor to a sole proprietorship begun by Paul LaRochelle under the name Soft-Co. Soft-Co originally was a business run out of LaRochelle's home in Manchester and, for a time, an office in Bedford, New Hampshire. LaRochelle set out to find a new name in 1995, to coincide with a planned move of the business to the Manchester retail store.

\*7 Applicant is a "value-added" retailer involved in the sale and servicing of desktop computers, components, software and related peripherals; and offers training classes. Eighty percent of applicant's business is providing sales, service and training to other businesses, generally smaller businesses. Applicant does not sell off-the-shelf computers and builds computers and networks to meet the specifications and needs of its customers. Walk-in business is a very small part of applicant's operation.

Applicant attends trade shows throughout the New England states, and considers the territory in which it does business to include New England, New York, Pennsylvania and sometimes other states. Its primary mechanisms for generating sales are the trade shows and direct sales efforts of its sales staff. Applicant sporadically places print advertising in a few newspapers in New Hampshire, primarily weeklies, but has placed ads in a daily also utilized by opposer, *The Union Leader* of Manchester, New Hampshire. At one point, applicant tried some cable television advertising. Bulk mailings are regularly used, employing lists developed by the sales staff or procured from elsewhere. At trade shows, applicant has given away promotional

items, including coffee mugs, shirts, private-label root beer and certain computer accessories, such as mouse pads, all with the store's PC AUTHORITY & design mark on them. Once, applicant gave away a computer, printer and Internet service through a contest promoted on radio. Applicant also purchases display space in various Yellow Pages books. Its ad expenses for 1995 totaled approximately \$20,000 and by 1999 its ad budget had grown to \$75,000.

Applicant registered the mark THE PERSONAL COMPUTER AUTHORITY with the Secretary of State's Office in New Hampshire on June 1, 1995, but almost immediately employees, or at least LaRochelle, shortened the name and began answering the phone as "PC Authority," which applicant considers an abbreviated version of the mark registered with the Secretary of State. Applicant's first trademark clearance searches for the two involved marks were conducted by counsel prior to filing of the involved applications. Applicant uses its marks on store signage, both inside and out, banners displayed at trade shows, on a delivery truck, on bags used to package purchases in applicant's store, in its advertising and on its web site. Whenever possible the marks are used together, but sometimes on hardware items, the only mark will be a one-inch-square sticker of the PC AUTHORITY logo.

### **TSAM's CORE MARKS**

As we have noted, opposer's claim under Section 2(d) of the Lanham Act alleges there is a likelihood of confusion or mistake among consumers, or that they would be deceived, in view of opposer's (1) ownership of four incontestable registrations for AUTHORITY, THE SPORTS AUTHORITY, THE SPORTS AUTHORITY & design [hereinafter, the TSA logo], and THE SKI AUTHORITY; (2) opposer's "prior adoption, use and registration of use [sic]" of THE SPORTS AUTHORITY as a trade name; (3) opposer's "prior adoption and use of a family of marks dominated by the word 'AUTHORITY'"; and (4) opposer's "numerous" registrations for marks "dominated by the word 'AUTHORITY'."

\*8 The record developed by TSAM, the arguments in its briefs, and the arguments presented at the oral hearing all have focused on TSAM's THE SPORTS AUTHORITY mark and the TSA logo, and its claim that it has a strong, growing family of marks.<sup>[FN12]</sup> (TSAM notice of opposition ¶9) Moreover, putting aside for the moment the family of marks argument, it is clear from the record that TSAM's strongest bases for its Section 2(d) claim are its prior use of THE SPORTS AUTHORITY as a trade name and its registration of both THE SPORTS AUTHORITY and of the TSA logo. Accordingly, we focus our initial analysis on these and consider the family of marks argument separately.

### Priority

The record clearly establishes opposer's prior use of THE SPORTS AUTHORITY as a trade name. More importantly, since THE SPORTS AUTHORITY and the TSA logo have been registered as marks, and copies of these registrations showing status and title were submitted with TSAM's notice of reliance, priority is not an issue here. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

### Likelihood of Confusion

The Court of Customs and Patent Appeals, the predecessor court of the Court of Appeals for the Federal Circuit, set out a non-exclusive list of thirteen factors to be considered when determining whether one mark is likely to cause confusion with another mark. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). While opposer asserts only six of these factors are relevant in this case (TSAM brief p.25), we consider all 13.

(1) *The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.*

Opposer has a registration for THE SPORTS AUTHORITY in typed form, so there is no restriction as to its method of display as, for example, in a particular font or color. It also has a registration for a logo, set forth below, and it is clear from the record that this is its most widely utilized form of presenting the words THE SPORTS AUTHORITY.



Applicant's mark THE PERSONAL COMPUTER AUTHORITY, like each of opposer's marks, begins with "The" and ends with "Authority." Applicant's PC AUTHORITY logo does not use the term "The." Each of opposer's registrations includes a disclaimer of the word "Sports"; applicant's respective applications include disclaimers of "Personal Computer" and "PC."

It is well settled that it is improper to dissect a mark, and that marks must be viewed in their entirety. *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). However, more or less weight may be given to a particular feature of a mark for rational reasons. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985). Opposer, because the involved registrations and applications all include disclaimers, focuses on the presence of "Authority" in each mark and argues that that is the dominant term in each mark. To be sure, in terms of the capacity of each mark to indicate source, "Authority" must be considered the dominant element. It need not automatically follow, however, that, merely because marks have the same dominant element, they are pronounced the same, look the same or present the same overall commercial impression.

\*9 Considered in their entirety, the involved marks would not be pronounced the same and do not look the same. The connotations of the respective marks are similar only insofar as each conveys the sense that opposer and applicant are "authorities" in their respective fields; but the respective marks, particularly the respective logos, present "Authority" in smaller type and emphasize the field within which each party considers itself an authority.<sup>[FN13]</sup> In addition, opposer's goods and services, and its myriad sponsorship arrangements and advertisements at public arenas are inextricably associated with sporting activities, while applicant's goods and advertising are inextricably associated with personal computing and the Internet. Thus, the specific commercial impressions created by the parties' respective marks are very different. Opposer is the authority in sports; applicant is the authority in personal computing.

In sum, though the marks share a significant element, they look different, sound different and create different specific commercial impressions.

This factor favors applicant.

(2) *The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.*

In considering this factor in the analysis of likelihood of confusion, we must compare the goods and services as described in the involved applications and registrations. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

Opposer's two core marks are registered for "retail store services featuring sporting equipment and clothing." THE SPORTS AUTHORITY is also registered for various items of apparel, for both men and women, for "computer services, namely interactive on-line publications in the fields of sporting goods and equipment, apparel, footwear, headgear and related goods and services" and for the following:

Scorebooks, instruction guides and books in the fields of sports, exercise, fitness and recreation; clip boards; printed forms; printed matter, namely art pictures, art prints, bags for merchandise packaging, calendars, gift certificates, illustrations, price tags, and magazines in the fields of sports, exercise, fitness and recreation; score cards; stationery (Cl. 16). Bags for travel and sports (Cl. 18). Towels (Cl. 24). Clothing, namely shirts, tops, pants and shorts; headwear; hosiery; sweat bands (Cl. 25). Shoe laces (Cl. 26). Advertising for others; import-export agency; marketing research; purchasing



agents; sales promotion for others; promoting sports teams, competitions and events for others (Cl. 35). Sponsoring sports teams, competitions and events for others (Cl. 36).

Applicant seeks registration of its marks for "retail stores featuring computer hardware and software, computer accessories, computer networking products and peripheral devices," and "consultation and design for others in the field of computer hardware and software, computer accessories, computer networking products and peripheral devices."

**\*10** There is no similarity or relatedness whatsoever between applicant's services and the various classes of goods for which THE SPORTS AUTHORITY has been registered. Nor is there any similarity between applicant's services and opposer's various class 35 and class 36 services. As for opposer's "computer services," these are restricted to "on-line publications" focusing on the types of goods opposer sells and services it provides; and neither the on-line publications nor the goods or services discussed therein are anything like the computer hardware, software, peripherals and accessories that applicant sells at its store and over the Internet, or anything like the business consultation services applicant provides in the computer field. There is certainly no rule that all computer products and services are related. See In re Quadram Corp., 228 USPQ 863, 865 (TTAB 1985) ("[W]e think that a per se rule relating to source confusion vis-à-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace"). See also Electronic Design and Sales Inc. v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (No confusion between battery chargers and power supplies and computer services).

Opposer presses its argument that its retail store services involve selling computer games and some items of sporting equipment that include computer chips or may be used in conjunction with computers, such as a global positioning system that can be used by hunters, hikers and others engaged in outdoor activities and that can exchange information with a computer. There is no evidence in the record, however, to establish that such goods typically emanate from entities that retail computer hardware and software and provide computer consulting services. See Hasbro Inc. v. Clue Computing Inc., 66 F. Supp.2d 117, 122, 52 USPQ2d 1402, 1406 (D.Mass. 1999), aff'd, 232 F.3d 1, 56 USPQ2d 1766 (1st Cir. 2000), wherein the court held that it would be "an extraordinary stretch to assert that Hasbro's technical support to game users is similar in any meaningful way to the 'computer consulting services' provided by Clue Computing." See also, Falk Corp. v. Toro Manufacturing Corp., 493 F.2d 1372, 1378, 181 USPQ 462, 467 (CCPA 1974) (Court reversed Board decision sustaining opposition, explaining that the opposer could not prevail merely on the ground that applicant's 'rubber element shaft couplings' might be contained in some of opposer's machines). Here, opposer cannot prevail merely because applicant sells computer parts and some computer parts may be contained in some of the electronic sporting goods and equipment sold by opposer.

**\*11** In sum, we find no similarity or relatedness between the parties' respective goods and services. To the extent that they both are engaged in retail activities and may employ similar channels of trade and have some overlap in customers, these issues are considered under other duPont factors, not under the factor focusing on the similarity or relatedness of the goods and services.

This factor favors applicant.

*(3) The similarity or dissimilarity of established, likely-to-continue trade channels.*

Opposer argues, in essence, that the parties utilize the same trade channels, insofar as each runs retail stores, each uses the Internet, and they both use direct mail and other similar forms of print advertising. Opposer also relies on the fact that both parties sell goods at retail to general consumers. (TSAM brief p.32)

On this latter point, i.e., the retailing of goods to general consumers, this, of course, is not an issue in relation to applicant's business consultation services. In regard to applicant's retail store services, however, opposer is correct in arguing that both parties make their store services available to the same class of consumers, i.e., any potential consumer of their respective goods and services. Applicant's witness LaRochelle testified at length about the vast majority of its sales being made to business customers and that its walk-in business is minimal. (LaRochelle disc. dep. pp.52-53 and 57-59; La Rochelle test. pp.25-27, 42 and 48) Nonetheless, we must consider channels of trade and classes of consumers based on the identifications in the

involved applications and registrations. Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Applicant's identification of its retail store services is not limited to retailing to other businesses and must be read to encompass retailing to the home user of personal computers as well as the business user.

For related *goods* typically sold at retail to general consumers, the absence of restrictions, in particular identifications, on channels of trade or classes of consumers, often leads to the conclusion that the *goods* can move in the same channels of trade, i.e., through the same types of stores or resellers, to the same ultimate consumers. However, as for the respective retail store *services* in this case, the mere fact that opposer and applicant provide such services is not sufficient reason to conclude the services may be offered together. Each provides these services through its own stores and web sites. There is nothing in applicant's identification that suggests that its retail store services focusing on computer hardware and software and peripherals would be rendered through a retail store focusing on sporting goods and equipment, apparel and footwear, or vice versa. In sum, merely because both parties provide retail store services and use similar methods of advertising does not mean that their respective services will be offered to consumers under circumstances and through channels of trade which would create a likelihood of confusion.<sup>[FN14]</sup>

\*12 Likewise, while opposer has many different types of goods listed in at least one of its registrations for THE SPORTS AUTHORITY (Reg. No. 2,071,449), and there are no restrictions on channels of trade for those goods, there is nothing in the record to suggest that such goods would move through a retail store focusing on computer hardware, software and peripherals. Nor would they be distributed through or by an entity providing business consultation services in the computer field.

We find little likelihood for confusion attributable to channels of trade employed by the parties, notwithstanding that there are no restrictions on the involved identifications. In regard to classes of consumers, the mere fact that both opposer and applicant are presumed to market to general consumers, including businesses and individuals, does not dictate a conclusion that confusion is likely to arise. There is nothing in the record to establish the overlap in purchasing habits of consumers of computer goods and services and consumers of sporting goods, equipment, apparel and footwear. We think it a fit subject for judicial notice that purchasers of computer hardware and software also would be purchasers of, at least, footwear and apparel, and perhaps sporting goods and equipment. There is nothing in the record, however, to suggest that merely because the same consumer may purchase these items, such consumer would consider the goods as likely to emanate from the same source or have the same sponsorship.

This factor favors applicant.

(4) *The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasers.*

Both opposer and applicant run retail stores. Opposer also acts as a sort of wholesaler insofar as it sells goods to businesses that will resell them; and applicant, too, sells some of its goods to smaller resellers. Of course, merely because a significant portion of each party's business is with ultimate consumers, rather than resellers, it does not automatically follow that such consumers are impulsive rather than careful. The record reveals that the goods retailed in opposer's stores and via its web site include a great variety of items in myriad price ranges. Likewise, applicant's customers for its computer retailing business may purchase anything from an expensive package of computer hardware and software to a relatively inexpensive accessory item. Neither party can be said to deal with only one type of consumer. Rather, it is clear that each markets some goods that might be bought on impulse and others that would require a good deal of deliberation.

The other services each party provides, e.g., applicant's consultation and design services relating to computers and opposer's various services such as advertising, marketing, importing and exporting, promoting sports teams, and sponsoring teams and competitions, would more uniformly require some degree of deliberation before purchase.

This factor favors neither party.

(5) *The fame of the prior mark.*

\*13 With this factor, we look at what fame a mark has achieved in the marketplace. "Thus, a mark with extensive public rec-

ognition and renown deserves and receives more legal protection than an obscure or weak mark.” Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 353, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). See also, Recot Inc. v. M.C. Becton, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (“The fifth *DuPont* factor, fame of the prior mark, when present, plays a ‘dominant’ role in the process of balancing the *DuPont* factors.”)

Opposer has spent a good deal more of its effort on trying to establish that its family of marks is famous than it has spent trying to establish that its two core marks have attained some degree of fame. At this point in our decision, however, we consider the record for its evidence of fame of THE SPORTS AUTHORITY and the TSA logo.

“Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value.” Kenner Parker, 963 F.2d at 352, 22 USPQ2d at 1456. In this case, opposer’s core marks were possessed of at least a high degree of suggestiveness when conceived, but have acquired sufficient distinctiveness to become strong marks. See The Sports Authority, Inc. v. Prime Hospitality Corp., 89 F.3d 955, 39 USPQ2d 1511 (2d Cir. 1996) (In decision vacating grant of summary judgment on other grounds, appeals court noted that the trial court had found THE SPORTS AUTHORITY to be descriptive but possessed of acquired distinctiveness).<sup>[FN15]</sup> In addition, from the record we know that opposer’s investment in advertising grew from \$1.2 million in 1988 to nearly \$70 million in 1998, the last year for which we have figures. Not included in these totals are the amounts opposer spends when it opens a new store. During the early and mid-1990s, opposer was opening stores regularly and expanding geographically, so that it now has 200 stores in 32 states and is the largest sporting goods retailer in the country. Opposer’s sales of sports related goods and services and apparel escalated from \$3 million in 1987 to nearly \$1.6 billion dollars in 1998.

These figures are unquestionably impressive. Cf. TCPIP Holding Co. v. Haar Communications Inc., 244 F.3d 88, 96, 57 USPQ2d 1971, 1975 (2d Cir. 2001) (footnote omitted) (“Some of the holders of these inherently weak marks are huge companies; as a function of their commercial dominance their marks have become famous.”)

On the other hand, we have little, if any, evidence to show the level of brand awareness that has resulted from opposer’s expansion and promotional efforts. There is no survey evidence and we do not have figures regarding household penetration or brand awareness that would tend to establish that opposer provides products and services of lasting value. For comparison, we note the evidence of record in the *Kenner Parker* and *Recot* cases:

\*14 In the two- to seven-year-old age group, one in every two children currently owns a PLAY-DOH product. A survey showed that 60% of mothers named PLAY-DOH for modeling compound without any prompting. One witness characterized PLAY-DOH as a “piece of gold” which has lasted over thirty years as a successful toy -- a very unusual occurrence in the toy business.

Kenner Parker, 963 F.2d at 351, 22 USPQ2d at 1455.

Recot ... has manufactured and sold a wide variety of snack food under its mark, FRITO-LAY, for over thirty years. Recot now sells FRITO-LAY products nationwide in supermarkets, grocery stores, mass merchandisers, and wholesale clubs, convenience stores, food services, and vending machines. ... In any given year, up to 90 percent of American households purchase at least one FRITO-LAY brand snack.

Recot, 214 F.3d at 1326, 54 USPQ2d at 1896.

We do not have a similar record in this case. TSAM’s witness Lisi, discussing TSAM’s core marks, testified that he had “commissioned two separate US valuations by outside valuation expert [sic] and looked at and worked with them and gone through all of the same factors, consumer recognition, you know, who are our competitors, what is their market share, what is our market share, those sorts of things.” (Lisi test. p.92) Yet we have no testimony or reports from the outside valuation expert or experts; not even a statement from Lisi as to the conclusions reached on consumer recognition and market share. Further, Lisi, opposer’s chief witness, was equivocal on whether the outside valuations are evidence that TSAM’s core marks are famous: “And from that information [i.e., the outside valuations], my personal impression is that the mark The Sports Authority, the mark Sports Authority and design and the family of Authority marks are extremely strong, if not famous.” (Lisi test. pp.92-93)

While opposer has introduced a number of its annual reports (Lisi test. exh. 25), and hundreds of pages of financial analyses

of opposer by financial analysts (Lisi test. exh. 23), there is no testimony or argument asserting that these materials contain any information on household penetration, brand awareness or brand value. Lisi also identified and introduced an affidavit and accompanying exhibit (Lisi test. exh. 22) intended to establish the number of viewer impressions created by opposer's television advertising over a three-year period; but without testimony from the individual who prepared the exhibit, the Lisi testimony is probative of nothing more than that he received the affidavit and report from an officer of opposer's ad agency. Likewise, Lisi introduced a "master list" of what are reported to number over 10,000 incidents of "unsolicited" press coverage of opposer and/or its stores. (Lisi test. exh. 24) However, no individual articles have been produced as a sample and we have no idea whether the articles are positive or negative; we know only that Lisi testified to their collection.

**\*15** These failures are significant. Because "the fame factor is based on underlying factfinding ... relevant evidence must be submitted in support of a request for treatment under the fame factor. This responsibility to create a factual record is heightened under the more deferential standard that [the Federal Circuit] must apply when reviewing PTO factfinding." *Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1360, 56 USPQ2d 1351, 1356 (Fed. Cir. 2000)(citations omitted). Opposer has not created a record on which we could find that its marks have attained the same level of fame as PLAY-DOH or FRITO-LAY.

As the largest sports retailer in the country and given the significant sums spent on advertising, almost all of which involves at least opposer's core THE SPORTS AUTHORITY mark and TSA logo, we conclude that there is some degree of fame that attaches to these marks. Fame is relative, however, not absolute, and we do not put opposer's marks on a par with the marks in *Kenner Parker and Recot*.

Nonetheless, the fame factor favors opposer.

*(6) The number and nature of similar marks in use on similar goods.*

With its notice of reliance, applicant introduced evidence of 41 third-party registrations that include the word "Authority" in a mark or slogan. We immediately discount 15 of these as having little, if any, probative value, for they cover marks where "Authority" is the entire mark, or appears in a slogan not in the same form as the marks of applicant and opposer, or they relate to "authorities" in the nature of public agencies.

Of the 26 remaining registrations, 23 are for words alone and in the "\_\_\_\_\_ Authority" form, some with a leading "The," others without it. Even the three registered marks with design elements include wording that would be read in the "\_\_\_\_\_ Authority" form. These 26 registrations include the following: ABC AUTHORITY for a web site providing information about "activity-based business management"; HIRE AUTHORITY for "employment agency services"; THE UNDERWATER AUTHORITY ("underwater" disclaimed), registered as a service mark in three classes for a wide variety of services provided in or under water, including construction, salvage, inspection, and engineering, among others; AUDIO AUTHORITY (and stylized AA design) ("audio" disclaimed) for items of audio visual equipment and display units and for custom design of display units and audio visual fixtures; LCI AUTHORITY for telecommunications and computer network-related services; COMPUTER SYSTEMS AUTHORITY ("computer systems" disclaimed) for various computer consulting and technical support services; PORT AUTHORITY for "microprocessor and electronic switching control devices"; POWER AUTHORITY for "surge protectors"; ROUTE AUTHORITY for hand-held, microprocessor-based devices for collecting and transferring data to personal computers; two registrations for THE AEC AUTHORITY (one in design form; both with "aec" disclaimed) for computer software for use in computer-aided design and engineering; THE DIAMOND AUTHORITY ("diamond" disclaimed) for retail jewelry store services; THE CLEANING AUTHORITY ("cleaning" disclaimed) for residential and building cleaning services; AMERICA'S TRAVEL AUTHORITY for computer software for retrieval and display of geographic, routing and travel information; DIRECT AUTHORITY for credit card services; THE HOME IMPROVEMENT AUTHORITY ("home improvement" disclaimed) for a monthly magazine on home improvement and repair; THE CODE AUTHORITY ("code" disclaimed) for publications in the field of product safety testing and certification, building codes, and commercial and residential construction; THE CRUISE AUTHORITY ("cruise" disclaimed) for a travel agency specializing in cruises; THE ULTIMATE AUTHORITY for magazines for collectors of stuffed toy animals and dolls; THE AIR AUTHORITY ("air" disclaimed) for environmental consulting; NATIONAL AUTO AUTHORITY and design, with smaller slogan "Pre-Purchase Inspection Services" ("NATIONAL AUTO" and slogan disclaimed) for used car inspection

services; MONITOR AUTHORITY (“monitor” disclaimed) for electronic home entertainment systems and components; two registrations for THE INTERNET PERFORMANCE AUTHORITY (“Internet performance” disclaimed in each) for “computer software for measuring, monitoring, and improving” quality of service of the Internet and other networks, and for services related thereto; PARTS AUTHORITY (“parts” disclaimed) for retail store services and distributorship services dealing in automobile parts, supplies and accessories; and THE LIGHTING AUTHORITY (“lighting” disclaimed) for “association services, namely promoting the art and science of illuminating engineering.”<sup>[FN16]</sup>

**\*16** Applicant has also introduced, via the LaRoche testimony deposition, reprints of numerous web pages that feature various marks including the term “Authority.” Many of these web pages appear to be web sites posted by the owners of certain registrations referenced above, e.g., THE UNDERWATER AUTHORITY, THE ABC AUTHORITY, THE CODE AUTHORITY, AUDIO AUTHORITY, PARTS AUTHORITY, LCI AUTHORITY, COMPUTER SYSTEMS AUTHORITY. Some other web pages include identical, or nearly identical, marks as some of those in the registrations referenced above, but appear to have been posted by entities other than the owners of the corresponding registrations, e.g., CRUISE AUTHORITY, THE DIAMOND AUTHORITY, HIRE AUTHORITY, AIR AUTHORITY INCORPORATED, and THE CLEANING AUTHORITY. Finally, there are web pages featuring “\_\_\_\_\_ AUTHORITY” marks unlike any of the registrations referenced above, e.g., THE JEANS AUTHORITY, THE COLOR AUTHORITY, THE PAYMENTS AUTHORITY, THE AUTO AUTHORITY, THE TRAVEL AUTHORITY, THE LEARNING AUTHORITY, SALES AUTHORITY, HEATING AUTHORITY, THE WINE AUTHORITY, MOBILE AUTHORITY, FLEET AUTHORITY, THE INSURANCE AUTHORITY, THE HEALTH AUTHORITY, and THE STORAGE AUTHORITY.

The last block of evidence intended by applicant to demonstrate widespread use and adoption of “\_\_\_\_\_ AUTHORITY” marks consists of the LaRoche search of BIG YELLOW, an on-line yellow pages directory. By this last block of evidence, applicant attempts to establish that there are numerous -- thousands, even -- businesses listed in BIG YELLOW which have “Authority” in their names. By the testimony of Clifford Sewing, we know that BIG YELLOW has been available over the Internet since 1996 and its listings are compiled from approximately 4500 yellow page directories from across the country. Sewing also testified that 13 million searches of the data base are conducted each month and 10-20 percent of these are searches seeking listings for businesses with particular names or terms, rather than all listings within a whole category or information corresponding to a particular phone number. In regard to the search conducted by LaRoche, Sewing testified, “It appears that the search is giving matching categories -- the database found 14,161 business listings and 781 categories with the name authority in it. So there's 14,000 plus businesses with the name authority across the country.”

Most of the BIG YELLOW listings are not relevant, because they are for “authorities” in the nature of public agencies, such as the “Holmes County Economic Development Authority” or the “Grand Rapids Area Transit Authority.” Many others, however, follow the “\_\_\_\_\_ Authority” pattern and appear to be businesses attempting to present themselves as “authorities” in their fields, e.g., “The Entertainment Authority,” “Sports Car Authority,” “Auto Lease Authority,” “Hair Authority,” “Boat Authority,” “CD Authority,” “Hire Authority,” “Nanny Authority,” “Glass Authority,” “Coupon Authority,” “Design Authority,” “Gem Authority,” “Landscaping Authority,” “Fence Authority,” “Kickboxing Authority,” “Moving Authority,” “Pet Authority,” “Plumbing Authority,” “Vinyl Authority,” “Chicago Bagels Authority,” “Pizza Transit Authority,” “Roof Authority,” “Storage Authority,” “Cruise Authority,” “Travel Authority,” “The Wine Authority,” “Tuxedo Authority,” “Wedding Authority,” “Resume Authority,” and “The Office Authority.”

**\*17** Opposer discounts much of the evidence of third-party registrations, web sites, and BIG YELLOW trade name listings.

In regard to the third-party registrations, opposer's witness Lisi, in his rebuttal testimony, argues that TSAM has actually taken assignments of one or two of the registered marks; that it has investigated the actual use of some of the registered marks and entered into co-existence agreements with the registrants; that it monitors other uses; and that opposer takes enforcement actions ranging from issuing cease and desist letters to filing civil lawsuits for uses to which it objects. The Lisi testimony also reveals that opposer does not have co-existence agreements with all users of “\_\_\_\_\_ Authority” marks, cannot afford to challenge all uses, and must “prioritize who we pursue or what we pursue and often that's determined by the severity of the problem and what's already being handled at a given time. ...we do the best we can with the resources we have.” (Lisi rebuttal test. pp.4-11) Similarly, in regard to web sites on which applicant relies, the Lisi rebuttal testimony

makes clear that opposer has been in contact with some of the entities behind the web sites. (Lisi rebuttal test. pp.12-23)

Opposer argues that neither the third-party registrations nor the Internet web sites are evidence of use of the marks shown therein. Yet the Lisi rebuttal testimony confirms that many of the registered marks and web sites have been put to some use, because opposer investigated the uses, in some instances, consented to particular uses, and in others monitors ongoing use.

It is well settled that third-party registrations are not evidence of use of the marks shown therein, or that consumers have been exposed to them. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973). Likewise, the Internet web sites and BIG YELLOW listings are of limited probative value. Cf. AMF Inc., 474 F.2d at 1406, 177 USPQ at 270 ("We think the listing of trademarks ... in various trade magazines should be treated in a similar manner as are third-party registrations. They give no indication as to actual sales, when the mark was adopted, customer familiarity with the marks, etc.") citing Gravel Cologne, Inc. v. Lawrence Palmer, Inc., 469 F.2d 1397, 176 USPQ 123 (CCPA 1972). Nonetheless, we find the numerous registrations and web site uses probative evidence that marks using a descriptive or suggestive term followed by the term "Authority" are attractive to many businesses, are adopted to convey the very suggestive connotation that the adopting entity is an expert or authority in the particular field in which it is engaged, and that such marks often co-exist<sup>[FN17]</sup> and are distinguished because of the other terms used in conjunction with "Authority." See Henry Siegel Co. v. M & R Mfg. Co., 4 USPQ2d 1154, 1161 n. 11 (TTAB 1987) and Bost Bakery, Inc. v. Roland Industries, Inc., 216 USPQ 799, 801 n. 6 (TTAB 1982).

**\*18** This factor favors applicant.

*(7) The nature and extent of any actual confusion.*

There is no evidence of actual confusion in this case. TSAM's witness Meyers testified that one customer in opposer's Manchester, New Hampshire store asked whether a computer shown in a display with a global positioning system could be purchased. This does not evidence confusion between the party's respective businesses. The absence of actual confusion is a factor that favors applicant.

*(8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.*

Opposer has had one of its retail stores located in Manchester, New Hampshire since prior to applicant's adoption of its marks. By the time of trial, the parties had concurrently operated in the same geographic market for approximately five years without any evidence of actual confusion. This factor favors applicant.

*(9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).*

Applicant uses THE PERSONAL COMPUTER AUTHORITY as a trade name and uses THE PERSONAL COMPUTER AUTHORITY and the PC AUTHORITY logo as house marks for its retail store services and business consultation services focusing on computers. Opposer has obtained 4 registrations for the words THE SPORTS AUTHORITY, one registration for the TSA logo and another for THE SPORTS AUTHORITY LTD. THE SPORTS AUTHORITY is utilized as opposer's trade name and both THE SPORTS AUTHORITY and the TSA logo are utilized as house marks for various goods and services relating to sports and apparel.

Because the respective marks are utilized as the parties' respective house marks, this factor slightly favors opposer, notwithstanding that the parties' goods and services are very different.

*(10) The market interface between applicant and the owner of a prior mark:*

- (a) a mere "consent" to register or use.*
- (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.*
- (c) assignment of mark, application, registration and good will of the related business.*
- (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.*

This factor is not an issue in this case.

(11) *The extent to which applicant has a right to exclude others from use of its mark on its goods.*  
There is no evidence on this factor.

(12) *The extent of potential confusion, i.e., whether de minimis or substantial.*

Opposer argues that the risk of potential confusion is great. Yet the parties' respective marks convey different specific commercial impressions, the parties have operated their retail establishments within miles of each other for approximately five years, the parties provide their respective consumers with very different goods and services, and there have been no known instances of actual confusion. While opposer's witness Lisi testified about possible expansion into marketing of more hand-held type electronic devices with embedded computer chips, we find the testimony vague and insufficient to evidence any genuine intent of opposer to bridge the gap between the parties. We conclude the extent of potential confusion is de minimis.

**\*19** This factor favors applicant.

(13) *Any other established fact probative of the effect of use.*

Opposer notes that it has been quite aggressive in investigating and, often, challenging other uses of "Authority" marks. Despite applicant's request that we disregard the table of enforcement actions presented in opposer's brief, even without resort to that table, the record clearly supports the conclusion that opposer has regularly ridden into battle against other "Authority" marks. While opposer has had many successes, these do not appear to have diminished the attractiveness of such marks to others. Further, TSAM witness Lisi admitted that it does not maintain a chart of uses of "Authority" marks that it does not find objectionable and has not challenged. Thus, the record does not allow us to accurately assess the percentage of potential conflicts opposer has risen to challenge.

This factor favors neither party.

#### Balancing of the DuPont Factors

By balancing the *duPont* factors, we conclude that there is no likelihood of confusion in this case.

Likelihood of confusion is decided upon the facts of each case. *In re Dixie Restaurants, Inc.* 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *Shell Oil*, 992 F.2d at 1206, 26 USPQ at 1688 (Fed. Cir. 1993). The various factors may play more or less weighty roles in any particular determination of likelihood of confusion. *duPont*, 476 F.2d at 1361, 177 USPQ at 567.

We note that the balance must initially tip in opposer's favor, because the Federal Circuit "has acknowledged that fame of the prior mark ... 'plays a dominant role in cases featuring a famous or strong mark.'" *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), quoting, *Kenner Parker*, 963 F.2d at 352, 22 USPQ2d at 1456. In addition, the Federal Circuit has held that in a particular case, a single *duPont* factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

We do not find this case an appropriate one in which to rule that the presumptive fame of opposer's mark alone can be a dispositive factor. That fame is presumed to attach to opposer's core marks solely because of sales and advertising figures. The record is, however, insufficient to establish that opposer's core marks are in the same class of marks as are PLAY-DOH and FRITO-LAY, which were the marks in, respectively, the *Kenner Parker* and *Recot* decisions. Even in those cases, where the record supporting the fame factor was greater, there were other *duPont* factors favoring the opposers. In this case, the only other *duPont* factor that favors opposer is the ninth, and that only slightly.

**\*20** On the other side of the balance, the first, second, third, sixth, seventh, eighth and twelfth *duPont* factors favor applicant.<sup>[FN18]</sup> The first and second are often key considerations. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *Kellogg*, *supra*, wherein the first factor alone was determinative.

In this case, though the balance initially tips in favor of opposer because of the fame factor, the many other factors that weigh in the balance in favor of applicant are sufficient to overcome the fame factor. Moreover, opposer has produced no evidence that the relevant public, i.e., consumers of diverse retail store services, has become accustomed to seeing the same or similar marks in connection with the operation of retail stores in fields as diverse as sports and apparel, on the one hand, and computer hardware, software and accessories on the other.

We find no likelihood of confusion among consumers when comparing opposer's marks THE SPORTS AUTHORITY and the TSA logo with applicant's marks THE PERSONAL COMPUTER AUTHORITY and the PC AUTHORITY logo. We note also, that comparison of applicant's marks with opposer's other registered marks does not yield any greater basis on which to find a likelihood of confusion. None of those marks benefits from the fame of opposer's core marks and they are no more similar to applicant's marks than opposer's core marks.

### **TSAM's FAMILY OF MARKS CLAIM**

As noted, the record is clear that opposer makes consistent and widespread use of its core marks, THE SPORTS AUTHORITY and the TSA logo. Also, as discussed above, priority of use is not an issue in this case, insofar as these and other registered marks of opposer are concerned. See *King Candy*, *supra*. In regard, however, to opposer's claim that it has a family of marks, opposer cannot show merely that it has a number of registrations with a common term, but must show that use of marks sharing "a recognizable common characteristic" predates applicant's first use of its marks and is made in such a way as to create "recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods." J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1462, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

Opposer has denied "any use of the term Authority that any entity may come up with ... would infringe upon [TSAM's] family of marks." (Lisi disc. dep. pp.40-41) Thus, it is clear that opposer does not claim rights in gross to the term "Authority." Opposer has described its asserted family as "all formed by the dominant surname AUTHORITY and most of which begin with a highly suggestive prefix..." (TSAM Brief p.2) TSAM's witness Lisi, in his discovery deposition, stated that "the core mark, father or mother mark is the mark Authority." (Lisi discovery dep. p.40) In its reply brief, however, TSAM echoes the main brief and asserts that its family is "anchored by its centerpiece trade name THE SPORTS AUTHORITY" and most members of the family include "a descriptive or suggestive word preceding the AUTHORITY family surname." (TSAM reply brief p.1) Though opposer's oldest registration is for the mark AUTHORITY alone -- for apparel -- this was registered prior to opposer's formation and obtained by assignment. We find the description of TSAM's family in its brief more apt than the Lisi statement.

**\*21** The progenitors of opposer's family clearly are its mark THE SPORTS AUTHORITY and THE SPORTS AUTHORITY logo. The "recognizable common characteristic" of marks used and/or registered by opposer, and which are, therefore, members of its family, is a mark format wherein one or more words, e.g., "Golf," "Tennis," "Golf & Tennis," "Fishing," "Marine," "Basketball," "Footwear," "Outdoor," "Bag," "Shoe & Apparel," and "Back to School," are used in conjunction with, and as adjectives modifying, the term "Authority." The testimony of TSAM's witness Lisi, and exhibits 3 and 37 thereto, which are samples of print advertisements for opposer's stores in which the core marks and other marks sharing the family characteristic are presented, demonstrate the formation of the family prior to applicant's first use of its marks.<sup>[FN19]</sup>

Many of the ads in Lisi exhibit 3 also feature use of slogans such as "We're the Authority on In-Line Skates and Apparel" or "We're the Authority on Great Athletic Footwear!" Slogans such as these, however, are in ads dated after applicant's first use of its mark, and do not share the same "recognizable common characteristic" as the family established prior to applicant's first use. We do not consider these slogans to be part of the family established prior to applicant's first use. To the extent these slogans may evidence opposer's attempt to create a new and different family other than the one we have recognized, they do not aid opposer in this case.

Nor do we consider opposer's registered mark AUTHORITY or marks such as AUTHORITY PRICE or the slogan "Come to the Authority on holiday savings" to be part of the family. The evidence of record of use of such marks is scant compared to



the evidence of use of the “\_\_\_\_\_ AUTHORITY” marks.<sup>[FN20]</sup>

While we find that opposer has promoted its “\_\_\_\_\_ Authority” marks as a family, we acknowledge applicant's argument that the family surname is weak and non-distinctive. (PCA brief p.12) Likewise, we acknowledge applicant's contention that opposer has presented no evidence, such as a survey, demonstrating public recognition of the family. (PCA brief p.15) Finally, we acknowledge applicant's contention that the advertisements in Lisi testimony exhibits 3 and 37 include none dated, respectively, after August 1997 and May 1995, and applicant's charge that opposer's advertising of its family of marks “has long since expired.” (PCA brief p.16)<sup>[FN21]</sup> Thus, this is not a case quite the same as Han Beauty Inc. v. Alberto-Culver Co., 236 F.3d 1333, 57 USPQ2d 1557 (Fed. Cir. 2001). In that case, the defendant stipulated before the Board that plaintiff had a family of marks without “temporal or other limitation.” *Id.* 236 F.3d at 1336, 57 USPQ2d at 1559. Here, defendant clearly contests recognition and distinctiveness of plaintiff's family characteristic.

**\*22** Applicant is correct in arguing that distinctiveness of the family characteristic is a factor to be considered. J & J Snack Foods, supra, 932 F.2d at 1463, 18 USPQ2d at 1891-92 (“It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.”)

In this regard, opposer contends that many of the members of its family are registered, on the Principal Register, without resort to Section 2(f) of the Lanham Act, and some have attained incontestable status. Opposer also relies on its extensive advertising and an “incredible volume of unsolicited articles written about TSAM by the press” to establish the strength of its family. Thus, opposer considers its family not merely presumptively strong but also famous. (TSAM brief pp.26-28)

We believe the record indicates that the strength of TSAM's family of marks is rather limited. We begin our consideration of the family's strength with the observation that the marks in the family are highly suggestive. TSAM has admitted that each mark in the family utilizes a suggestive or descriptive term as a modifier of the term “Authority.” The term “Authority,” too, is highly suggestive when used as part of a series of marks for retail store services, in that the term readily suggests that TSAM can provide customers “authoritative” assistance. Thus, the family characteristic readily suggests that the stores owned and operated by TSAM and those stores licensed to use its marks, are staffed by authorities in selecting the types of goods, or preparing consumers for the types of activities, that are referenced in the marks in its family.

We also note that, in the record, the family members play feature roles only in Lisi testimony deposition exhibits 3 and 37 and, even then, there is no evidence of promotion of the family in print ads after August 1997.<sup>[FN22]</sup> The family members do not appear at all in the transcripts of radio advertising (Lisi test. exh. 19); or in the photographs and exhibits which demonstrate use of TSAM's two core marks at athletic arenas and public displays at sports events (Lisi test. exhs. 9 & 10); or in the web pages from TSAM's web site (Lisi test. exh. 18); or in the catalogues, flyers and other print material submitted as Lisi testimony exhibits 20, 21, 34 and 35. In addition, PCA's testimony witness LaRochelle authenticated and introduced five of TSAM's flyers (LaRochelle test. exhs. 12-16) he received at his home, and none of these includes any members of the family other than TSAM's two core marks. Finally, TSAM's witnesses, Lisi and Meyers, could testify to use in the Manchester, New Hampshire THE SPORTS AUTHORITY store of only two other members of the family, besides the two core marks, specifically KNIFE AUTHORITY and SKI AUTHORITY; even then, the Meyers testimony is vague, as he only recalled the use of SKI AUTHORITY during re-direct testimony.

**\*23** Moreover, while opposer has made an unsupported assertion that the record shows there have been “hundreds of billions” of consumer impressions of its family because of advertising, all the record reveals is a round figure spent on advertising, on an annual basis, and does not in any way show that such expenditures were for ads featuring family members, as opposed to TSAM's two core marks. The sales and advertising figures, to be sure, are impressive. Yet there is no evidence they have translated into recognition of TSAM's family of marks.

In short, we find that the record shows that TSAM's family of marks was formed prior to applicant's first use, but its members are not now seen together in public very often and, therefore, the family possesses very limited strength. Certainly, we do not

find support for opposer's argument that its family of marks, as opposed to its core marks, is famous. Moreover, any strength attaching to TSAM's family of "\_\_\_\_\_ AUTHORITY" marks is further limited to the retailing of sporting goods and equipment, footwear, apparel and the like. There is nothing in the record to support a conclusion that the family would be recognized as extending beyond such goods and services. Cf. *Han Beauty*, 236 F.3d 1333, 57 USPQ2d 1557 (Fed. Cir. 2001) (Applicant's mark for hair care products would be perceived as indicating applicant's goods have common origin with opposer's hair care products marketed under family of similar marks); *J & J Snack Foods*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991) (Applicant's marks for frozen soft pretzels would be perceived as indicating applicant's goods have common origin with opposer's wide variety of food products marketed under family of similar marks); and *Motorola, Inc. v. Griffiths Electronics, Inc.*, 317 F.2d 397, 137 USPQ 551 (CCPA 1963) (Applicant's mark for electron gun used in television tubes and other electronic devices "would appear to many to be a member of opposer's family" of similar marks, where parties "obviously in the same general field.").

In terms of likelihood of confusion, we find that the *duPont* factors are balanced almost exactly the same when we compare TSAM's family and applicant's marks, as they were when we compared TSAM's core marks and applicant's mark; except that the fifth *duPont* factor, fame, does not favor opposer. Thus, under the circumstances presented by this case, we find no likelihood of confusion between TSAM's family of "\_\_\_\_\_ AUTHORITY" marks and applicant's marks THE PERSONAL COMPUTER AUTHORITY and the PC AUTHORITY logo.

## DECISION

The opposition is dismissed as to each of applicant's involved applications.

FN1. The registrations listed in the notice of opposition include the following, which we have listed by registration number, issue date, mark and goods or services with international classification. (We have listed here only those registrations pleaded in the notice of opposition, by issue date from the oldest to the most recent, and corrected errors in opposer's chart.)

1,245,417	July 12, 1983	AUTHORITY	Apparel, namely, rainwear, jackets, coats, suits, slacks and vests (Cl. 25)
1,527,526	February 28, 1989	THE SPORTS AUTHORITY	Retail store services featuring sporting equipment and clothing (Cl. 42)
1,529,035	March 7, 1989	THE SPORTS AUTHORITY & Design	Retail store services featuring sporting equipment and clothing (Cl. 42)
1,688,221	May 19, 1992	THE SKI AUTHORITY	Retail store services featuring ski equipment and clothing (Cl. 42)
1,821,430	February 15, 1994	THE SPORTS AUTHORITY	Ladies apparel; namely shirts, and men's apparel; namely hats, visors, pants, shirts, shorts and swim trunks (Cl. 25)
1,937,000	November 21, 1995	THE LOW PRICE AUTHORITY	Retail store services comprising the sale of sporting goods and equipment, footwear and clothing (Cl. 42)
1,938,392	November 28, 1995	THE BAG AUTHORITY	Athletic bags, drawstring bags used for sleeping bags and

			floor mats, duffle bags and soft luggage (Cl. 18)
1,963,911	March 26, 1996	THE KNIFE AUTHORITY	Retail store services featuring sporting goods and equipment, footwear and clothing (Cl. 42)
1,999,520	September 10, 1996	THE CLUB AUTHORITY	Management of recreation and fitness clubs of others; and business consulting services relating to health, recreation and fitness clubs (Cl. 35)
2,003,381	September 24, 1996	THE BICYCLE AUTHORITY	Repairs and maintenance of bicycles (Cl. 37). Retail store services in the field of bicycles and related accessories (Cl. 42)
2,071,449	June 17, 1997	THE SPORTS AUTHORITY	Scorebooks, instruction guides and books in the fields of sports, exercise, fitness and recreation; clip boards; printed forms; printed matter, namely art pictures, art prints, bags for merchandise packaging, calendars, gift certificates, illustrations, price tags, and magazines in the fields of sports, exercise, fitness and recreation; score cards; stationery (Cl. 16). Bags for travel and sports (Cl. 18). Towels (Cl. 24). Clothing, namely shirts, tops, pants and shorts; headwear; hosiery; sweat bands (Cl. 25). Shoe laces (Cl. 26). Advertising for others; import-export agency; marketing research; purchasing agents; sales promotion for others; and promoting sports teams, competitions and events for others (Cl. 35). Sponsoring sports teams, competitions and events for others (Cl. 36).
2,074,352	June 24, 1997	SHOE & APPAREL AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,074,353	June 24, 1997	IN-LINE SKATE AUTHORITY	Retail store services in the field of sporting goods and

			equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,074,354	June 24, 1997	AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,074,355	June 24, 1997	TEAM SPORTS AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,074,356	June 24, 1997	FISHING AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,074,357	June 24, 1997	HUNTING AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,074,358	June 24, 1997	BASKETBALL AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,074,359	June 24, 1997	GOLF AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,074,782	July 1, 1997	SPORTS AUTHORITY FOOD, SPIRITS AND SPORTS & Design	Restaurant services (Cl. 42)
2,076,213	July 1, 1997	OUTERWEAR AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,076,214	July 1, 1997	TENNIS AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,079,864	July 15, 1997	FITNESS AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear,

			headgear and related goods and services (Cl. 42)
2,079,866	July 15, 1997	HOCKEY AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,079,867	July 15, 1997	MARINE AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,082,095	July 22, 1997	EXERCISE AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,082,096	July 22, 1997	FOOTWEAR AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,082,097	July 22, 1997	RUNNING AUTHORITY	Retail store services in the field of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,096,403	September 16, 1997	THE FITNESS AUTHORITY THE LAST WORD IN FITNESS & Design	Services rendered by health clubs (Cl. 41)
2,098,608	September 23, 1997	THE FITNESS AUTHORITY THE LAST WORD IN FITNESS & Design	Fitness apparel, namely sweatshirts, t-shirts and tank tops (Cl. 25)
2,101,178	September 30, 1997	THE AUTHORITY ON SPORTING GOODS	Rental of sporting goods, including protective clothing and equipment (Cl. 41). Retail store services in the fields of fitness, sporting goods and equipment, apparel, footwear, headgear and related goods (Cl. 42).
2,102,208	September 30, 1997	THE SPORTS AUTHORITY	Computer services, namely interactive on-line publications in the fields of sporting goods and equipment, apparel, footwear, headgear and related goods and services (Cl. 42)
2,108,004	October 21, 1997	THE SPORTS AUTHORITY	Retail store services in the

		LTD.	fields of fitness, sporting goods and equipment, apparel, footwear, headgear and related goods (Cl. 35). Rental of sporting goods, including protective clothing and equipment (Cl. 41).
2,141,699	March 10, 1998	AQUARIUM AUTHORITY	Retail store services featuring pet fish and aquatic supplies (Cl. 42)
2,145,645	March 24, 1998	AQUARIUM AUTHORITY & Design	Retail store services featuring pet fish and aquatic supplies (Cl. 42)

FN2. In paragraph 6 of the notice of opposition, opposer asserts that its registrations have been issued by the United States Patent and Trademark Office “[i]n recognition of the valuable rights in and to Opposer’s Marks, both individually and as a family of AUTHORITY Marks.” While an issued registration carries certain evidentiary presumptions, there is no legal basis for opposer’s suggestion that the Office has engaged in any valuation of the extent of opposer’s rights in its registered marks or for the proposition that, in issuing registrations, the Office somehow has determined that opposer’s marks constitute a family. We have accorded the registrations properly made of record the evidentiary weight to which they are entitled under the statute and have evaluated opposer’s claim of the existence of a family of marks based on the evidence of record.

FN3. Of these assertions, only applicant’s assertion that the opposition is barred by laches, acquiescence and estoppel sets out the only true affirmative defenses. Applicant did not, however, submit evidence or argument in support of these defenses and we have not given them further consideration.

FN4. Each party utilized its notice of reliance to, among other things, indicate its reliance on testimony it took during its main testimony period. Moreover, the parties stipulated that each could file its notice of reliance during its testimony period but could submit the exhibits introduced thereby after the close of its testimony period. It appears that one reason they may have so stipulated was to allow each party additional time to prepare the testimony transcripts and associated exhibits therefor, prior to filing.

The parties are reminded that trial testimony depositions are noticed and taken during the party’s assigned testimony period but are not filed via notice of reliance. Rather, the transcript of a party’s testimony deposition and associated exhibits are served on the adverse party within 30 days of the taking of the testimony and, following correction of any errors, a certified transcript is filed with the Board, under cover of a notice of filing, with proof of service thereof. See Trademark Rule 2.125, 37 C.F.R. §2.125. For a discussion of the requirement for serving an adversary with a transcript within 30 days, see TBMP §713.13. For a discussion of filing with the Board, see TBMP §§713.11 and 713.12. In essence, so long as the party’s adversary is provided with its service copy within 30 days of the date of the testimony deposition, filing with the Board may be made thereafter, without need for the parties to enter into a stipulation to provide for filing outside the testimony period.

In contrast to the provisions of the rules that allow for filing of parties’ testimony deposition transcripts after their respective testimony periods, notices of reliance must be filed and served no later than the closing date of a party’s testimony period. Notices of reliance -- a party is not limited to one -- are utilized to introduce a variety of non-testimonial evidence and may be prepared whenever feasible prior to or during a party’s testimony period, but must be filed and served as noted. See Trademark Rules 2.120(j), 2.122(d)(2), and 2.122(e), 37 C.F.R. §§2.120(j), 2.122(d)(2), and 2.122(e).

FN5. It is the parties’ duty, under paragraph 12 of their stipulated protective agreement, to redact or segregate confidential information and submit it under seal. Though the parties provided in paragraph 18 of their agreement that the Board “shall enforce the provisions” of the agreement, the Board does not actively monitor the efforts of parties to comply with such an agreement. The agreement is for the benefit of the parties and it is the parties who are expected to abide by its terms.

Also, notwithstanding the provision to the contrary in paragraph one of the parties’ protective agreement, the Board’s ju-

isdiction over the parties ends when this proceeding does and the Board will not be involved in enforcing provisions of the agreement after conclusion of the opposition.

FN6. Any exhibits to the parties' notices of reliance, including exhibits to discovery and testimony depositions, which have been clearly stamped "confidential," shall be segregated by the Board from the publicly available proceeding file. The parties are allowed until 30 days from the date of this decision to submit a substitute for any filed deposition transcript which includes confidential testimony, replacing the pages containing the confidential material with blank numbered pages and placing the pages with confidential material in separate envelopes.

FN7. We have not been provided with a copy of any discovery request by opposer that relates to third-party uses or evidence PCA planned to submit at trial. In its reply brief, however, TSAM quotes its interrogatory no. 13. That interrogatory requested PCA to identify third parties known to be using the term "Authority" in a mark or trade name.

FN8. We note, too, that TSAM's witness Lisi testified to status and title of this and other registrations insofar as he identified and authenticated both a list of TSAM's "issued registrations" and photocopies of the listed registrations as members of the purported family of marks owned by opposer. Proof of the status and title of a registration may be made by direct testimony, as well as by submission, with a notice of reliance, of a copy prepared by the office showing status and title. See Trademark Rule 2.122(d)(2), 37 CFR §2.122(d)(2).

FN9. Applicant, aware of a prior, unrelated Board proceeding in which the Board criticized TSAM for relying in its brief on facts not in the record, cannot be faulted for its concern about the brief chart. To make clear that it was not attempting to introduce evidence of enforcement activity not in the record created at trial, opposer ought to have referenced the Lisi discovery deposition chart and Lisi testimony charts in a different manner. For example, opposer could have referenced one in its entirety and excerpts from the other, to paint a complete picture.

FN10. Except as otherwise indicated, the term "opposer," as used in our discussion of what the record reveals about the parties, refers to TSAM, its parent The Sports Authority, Inc., and the various The Sports Authority stores run by TSAM, its parent or by other licensees in Florida and Hawaii.

FN11. These marks are referenced in our discussion, *infra*, regarding opposer's claim that it has a family of marks.

FN12. TSAM's fourth asserted basis for its Section 2(d) claim - its ownership of 35 registrations - has not been presented at trial as one which requires an analysis of the *duPont* factors with regard to each mark but, rather, as further evidence of TSAM's asserted family of marks.

FN13. As noted, opposer's logo is, as shown by the record, its most prominently featured mark in print advertising, on its website, on billboards and signs, etc. Likewise, though applicant usually uses its two marks together, its logo is sometimes used alone, e.g., on its plastic shopping bag and on decals placed on computers; and when the marks are used together, e.g., on its store sign, the logo is the most visually prominent of the marks.

FN14. Of course, there are instances in which different types of services are rendered through retail establishments, as a retailer might contract with any number of businesses to provide, for example, delivery, installation, repair or maintenance services related to the goods it sells in its retail stores. We do not mean to suggest that goods can move through the same channels of trade but services cannot. Rather, we make the specific point that retail store services from different retailers are, almost by definition, provided through different stores.

FN15. By way of contrast with the *Prime* trial court's finding, we note that the Office has registered THE SPORTS AUTHORITY on the Principal Register without requiring a showing of acquired distinctiveness.

FN16. Each of the third-party registrations issued based on use of the mark in commerce, and some have been maintained

through the filing of affidavits of use under Section 8 of the Lanham Act.

FN17. In regard to the ability of at least some of such businesses to co-exist, we note again that TSAM's witness Lisi has testified on this point.

FN18. The fourth, tenth and eleventh factors favor neither party.

FN19. Occasionally, the ads show family members in a "THE \_\_\_\_\_ AUTHORITY" format. We do not view the presence or absence of "the" as a critical family characteristic.

FN20. Opposer asserts in its brief, more specifically, in its description of the record, that its "advertising efforts have been very successful in creating hundreds of billions of consumer impressions and establishing links in the minds of consumers between" opposer's goods and services and its family of marks. (TSAM brief pp.8-9) There is, however, no support in the record for such an assertion.

TSAM's witness Lisi testified that opposer's web site "had over a billion click throughs from Yahoo alone in the [1999] Christmas selling season...." (Lisi test. p.67) He also testified "that there are billions and billions of new impressions being created for the Authority marks through the Internet venue...." (Lisi test. p.70) Yet there is no independent support for these statements and, in any event, the only exhibits that correspond to this testimony show use of only TSAM's two core marks, of THE AUCTION AUTHORITY, and of a slogan that reads "The Ultimate Authority for Selection, Quality, and Value." In short there is no evidence that TSAM's web site has created either the number of advertising impressions trumpeted in opposer's brief or of an association between opposer's goods and services and the various family members shown in the print advertisements introduced by the Lisi deposition.

The Lisi testimony deposition also was used to introduce, as exhibit 22, two affidavits. One is from an officer of TSAM's advertising agency and is intended to establish that from 1990-92, there were approximately one and a quarter billion viewer impressions of opposer's television advertising. We have already noted, in our discussion of the fame of opposer's core marks, that this affidavit and its exhibit are not probative evidence. Moreover, even if we had found the affidavit and exhibit to be probative evidence, the affidavit and its exhibit do not establish either the level of viewer impressions described in opposer's brief or that such impressions related to promotion of opposer's family, as opposed to its core marks.

FN21. Applicant has also contended that the number of marks in opposer's family can number no more than five, because only five of its marks were registered prior to applicant's first use. Applicant is legally incorrect on this point.

FN22. The Lisi testimony deposition was taken March 9, 2000.

2I46E24FCB47464A33B614D75F58ED232image/png1960px500.0572.04001.40116240045CCA47430A9029D26EFE3E94  
64image/png3691px564.01016.04001.4022002 WL 745589 (Trademark Tr. & App. Bd.)  
END OF DOCUMENT



# **EXHIBIT 3**

# **EXHIBIT 3**

**H**

2007 WL 4287254 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

HORMEL FOODS CORPORATION AND HORMEL FOODS, LLC

v.

SPAM ARREST, LLC

CANCELLATION 92042134

November 21, 2007  
Hearing: February 23, 2007

Allen W. Hinderaker and William D. Shultz of Merchant & Gould P.C. for Hormel Foods Corporation and Hormel Foods, LLC

Derek A. Newman and Randall Moeller of Newman & Newman Attorneys at Law, LLP for Spam Arrest, LLC

Before Sams, Seeherman and Rogers  
Administrative Trademark Judges  
Opinion by Seeherman  
Administrative Trademark Judge:

Hormel Foods Corporation and Hormel Foods, LLC (hereafter collectively referred to as “petitioner”) have petitioned to cancel the registration of Spam Arrest, LLC for SPAM ARREST, with the word SPAM disclaimed, for “computer software, namely software designed to eliminate unsolicited commercial electronic mail.” <sup>[FN1]</sup> Petitioner has brought this action on the grounds of likelihood of confusion and dilution.<sup>[FN2]</sup> Specifically, petitioner has alleged that petitioner is the owner of the registered trademark SPAM and a family of SPAM trademarks; that petitioner has used the trademark SPAM for more than sixty years for a canned meat product and has expanded its use of the mark over the years to include a variety of goods and services; that petitioner has registered SPAM for items such as processed meats, wearing apparel, hand kitchen slicers, jewelry, playing cards, pens, mugs, tennis balls and toys and the service of participating in automobile races; that petitioner owns a SPAM family of marks; that petitioner uses SPAM with a variety of goods and services including clocks, knives, recipe books, mouse pads and entertainment celebrations; that petitioner has used SPAM and its SPAM family of marks since prior to applicant's claimed date of first use of August 24, 2002; that petitioner's SPAM mark is famous; that respondent's SPAM ARREST mark so resembles petitioner's SPAM mark and its family of SPAM marks as to be likely, when applied to respondent's goods, to cause confusion or mistake or to deceive; and that respondent's SPAM ARREST mark dilutes the distinctive quality of petitioner's previously used and registered mark SPAM and its family of SPAM marks.

In answer to the petition, respondent has admitted the averments of paragraphs 3 and 6 of the petition for cancellation, which read as follows:

3. Hormel Foods is also the owner of trademark registrations for marks that are derivative of the SPAM trademark, making up the SPAM family of marks. These marks include SPAMARAMA for entertainment services, Registration No. 2059462; SPAMBURGER for processed meat, Registration No. 1819104; SPAM JAM for entertainment services in the nature of an annual festival featuring a variety of activities, namely exhibitions, cooking and other contests, and music, Registration No. 2561571; and SPAMTASTIC for mail order catalog services in the field of clothing, footwear, headwear, jewelry, home, kitchen, sporting goods, paper goods and printed matter, and children's toys, Registration No. 2478066;

\*2 6. Applicant's SPAM ARREST mark is composed of Petitioners' entire SPAM mark with the term "arrest" immediately following Petitioners' mark.

Respondent has also admitted that petitioner is the owner "of the registered trademark SPAM and the family of SPAM trademarks, that the United States Registrations include Nos. 775187, 1338031, 1415969, 1298745, 1505620, 1716102, 1985602, 2057484, 2373313 and 2639240"; and that petitioner has a website at www.spam.com. Respondent has otherwise denied the salient allegations of the petition for cancellation. Respondent has also asserted as affirmative defenses amplifications of its denial of likelihood of confusion; that "spam," when used in connection with unsolicited commercial email, is generic; and acquiescence and estoppel. Specifically, respondent alleges that petitioner has acquiesced in respondent's and others' use of the term "spam" with respect to unsolicited commercial email by posting statements on its website and through its representatives to the effect that petitioner does not object to use of the term "spam" to describe unsolicited commercial email; that respondent has detrimentally relied on such statements; and that petitioner should be equitably estopped from asserting trademark or service mark rights in the term "spam" with respect to unsolicited commercial emails and any related products and services.

#### **Procedural Issues**

In its trial brief petitioner asserts that respondent's affirmative defenses should be stricken. However, the basis of petitioner's position with respect to respondent's defense of acquiescence and estoppel is that the defense should fail for lack of proof, not that the defense should be stricken because it is not a valid defense. The Board does not strike an affirmative defense solely for lack of sufficient support.

As for the affirmative defense that SPAM is a generic term, petitioner argues that a pleading of genericness is merely a pleading that third parties use a term, and that third-party use does not establish an affirmative defense. [FN3] However, respondent is not asserting that others use SPAM as a mark, but that the term is generic. Thus, respondent is not asserting that petitioner has failed to object to third parties' use of marks containing the word SPAM, which might be viewed as an assertion that petitioner's mark is entitled to a limited scope of protection. Nor is respondent asserting that petitioner's mark is generic, which of course would have to be asserted as a counterclaim, only that "spam" has a generic meaning. The evidence petitioner itself submitted, as well as the testimony of its own witnesses, shows that "spam" means unsolicited commercial email, so it would appear that petitioner is objecting to the form, rather than the substance, of respondent's defense. Even if this defense does not fit into the category of a true affirmative defense, it serves to put petitioner on notice as to why respondent believes there is no likelihood of confusion and dilution, and is thus an amplification of respondent's denial of the claims. The Board does not strike such amplifications.

\*3 Accordingly, we do not strike either of these asserted defenses.

With respect to the pleaded ground of dilution, we note that petitioner's claim fails to assert that petitioner's

mark became famous prior to the filing date of the application which subsequently resulted in issuance of the registration that is the subject of this proceeding. However, because respondent has not raised an objection to this omission, but has substantively argued the ground of dilution, and because petitioner has submitted evidence as to the fame of its mark prior to respondent's filing date, we deem the pleadings to be amended to include such an allegation. See Fed. R. Civ. Proc. 15(b). In addition, petitioner did not plead ownership of Registration No. 3022539 for SPAM for "downloadable software, namely screen savers," because this registration had not issued at the time the petition for cancellation was filed. However, petitioner made the application of record with its notice of reliance filed August 29, 2005, and submitted a printout of information for the registration taken from the USPTO TARR<sup>[FN4]</sup> database with its supplemental notice of reliance filed on December 14, 2005. Respondent has treated this registration as being of record, and has discussed the effect of petitioner's use of the mark for such goods. Accordingly, we deem the petition for cancellation to be amended pursuant to Fed. R. Civ. Proc. 15(b) to include this registration.

As noted above, petitioner, in submitting a copy of Registration No. 3022539, did not submit a copy of the registration prepared and issued by the USPTO showing current status of and current title to the registration, but submitted a printout from the TARR database. Although Rule 2.122(d)(1) of the Trademark Rules was amended, effective August 31, 2007, to allow a plaintiff to make its registrations of record by submitting a "current printout of information from the electronic database records of the USPTO showing the current status and title of the registration," trial and briefing in this proceeding was completed prior to that date. Accordingly, the amended rule is not applicable, since it does not have retroactive effect. However, respondent has treated not only this registration, but all the materials submitted by petitioner as being of record ("depositions and exhibits described by Petitioners Hormel Foods Corporation and Hormel Foods, LLC... in Petitioners' Trial Brief ... at 9-10"). Respondent's brief, p. 10. These pages of petitioner's trial brief list all of the materials submitted with petitioner's notices of reliance, including materials that would normally not be considered acceptable for submission by notice of reliance.<sup>[FN5]</sup> As a result, we deem all of the materials submitted by petitioner to be stipulated into the record.

\*4 During the course of the testimony depositions each party raised various objections and/or motions to strike the testimony and exhibits of the other's witnesses. Because these objections were not maintained in the parties' trial briefs (with the exception of two motions to strike which the Board decided in its order of January 12, 2007<sup>[FN6]</sup>), the objections have been deemed to be waived. However, the Board has still considered the probative value of the testimony and exhibits in making its decision herein. For example, although books and newspaper articles are of record, they are not competent to prove the truth of the statements made in those publications. See authorities collected in Section 704.08 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (2d ed. rev. 2004). Thus, we have considered these materials only to show public exposure to the statements, unless witnesses have testified as to the truth of particular statements.

We have also given very limited probative value to the testimony of Ivan Ross, an expert witness who gave his opinion as to the fame of the mark SPAM. Much of the basis for his opinion is not of record herein. For example, he testified that he relied on the declaration of Nicholas Meyer (test. p. 22) in forming his opinion. Although Dr. Ross identified the declaration as an exhibit to his testimony, no one in a position to know the facts recited in the declaration ever testified during the testimony period that the statements in the declaration were true and continued to be true. Compare, *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993)(declaration of witness submitted in connection with summary judgment motion was part of record for trial where witness identified and attested to accuracy of it during testimony period). More importantly, although Dr. Ross stated, at p. 20 of his deposition, that he was not "expressing a legal opinion," it is clear that his

opinion as to the fame of petitioner's mark was in the context of trademark law. He referenced trademark cases and trademark treatises, and stated that he was adopting "the concept or the construct of fame as I understand it being utilized in trademark parlance." The determination of whether a mark is famous in terms of trademark law and concepts is something that is within the province of the courts and the Board to decide, and we decline to adopt or give probative weight to what is, in effect, a legal conclusion by an "expert" on such an issue.

### The Record

The record consists of the testimony and exhibits and other material listed at pages 9 and 10 of petitioner's trial brief and pages 9 and 10 of respondent's trial brief. In particular, it includes the pleadings; the file of the registration sought to be cancelled; the testimony depositions, with exhibits, of opposer's witnesses George Mantis, Shawn Radford, Ivan Ross, Gregory Carpenter, Nicholas Meyer, Jeffrey Grev, Lance Pogones, Ellen Kohl and Kevin Jones (including Mr. Jones's rebuttal testimony deposition), and of respondent's witnesses Brian Cartmell and Lea Knight; printed publications; third-party registrations and third-party application files; each party's responses to the other's discovery requests, including responses made by the parties in an opposition brought by petitioner against respondent's application for SPAM ARREST for services;<sup>[FN7]</sup> transcripts of discovery depositions; and petitioner's registrations<sup>[FN8]</sup> for SPAM for deviled luncheon meat spread;<sup>[FN9]</sup> t-shirts;<sup>[FN10]</sup> caps;<sup>[FN11]</sup> wearing apparel;<sup>[FN12]</sup> kitchen hand tools, namely slicers;<sup>[FN13]</sup> processed meat;<sup>[FN14]</sup> magnets, jewelry, namely watch, necklace, earrings and tie tack, playing cards, pencils, pens, and note cube, mug and insulated beverage containers;<sup>[FN15]</sup> entertainment services, namely participating in automobile races;<sup>[FN16]</sup> poultry;<sup>[FN17]</sup> retail gift shop services and educational and entertainment services, namely providing museum services featuring exhibits, memorabilia, and various multimedia presentations;<sup>[FN18]</sup> and downloadable software, namely screen savers;<sup>[FN19]</sup> and for SPAMBURGER for processed meat;<sup>[FN20]</sup> SPAMARAMA for entertainment services in the nature of an annual festival featuring a variety of activities, namely, exhibitions, cooking and other contests, and music;<sup>[FN21]</sup> SPAMTASTIC for mail order catalog services in the field of clothing, footwear, headwear, jewelry, home, kitchen, sporting goods, paper goods and printed matter, and children's toys;<sup>[FN22]</sup> and SPAM JAM for entertainment services in the nature of an annual festival featuring a variety of activities, namely exhibitions, cooking and other contests, and music.<sup>[FN23]</sup>

\*5 It is noted that the discovery depositions of Nicholas Meyer and Kevin Jones that were submitted by respondent bear a statement that they are "confidential," although they were not in fact filed under seal. The Board has treated these depositions as being confidential for the present, but because it is the general policy of the Board that all papers in proceedings be public, the parties are allowed thirty days in which to submit redacted versions of these depositions, failing which they will be treated as part of the public record. We also note that portions of the testimony depositions and certain exhibits identified therein were submitted under seal, although some of the information contained in the so-called confidential materials could not, in fact, reasonably be characterized as confidential. For example, in the deposition of Nicholas Meyer the number of cans of SPAM meat that have been sold has been redacted, although there is a public "counter" displaying this number at the Spam Museum. To the extent that information that has been marked as "confidential" is necessary for us to discuss in our opinion, we have done so, although we have tried to be sensitive about not revealing truly confidential information. However, the survey conducted by George Mantis, and which was submitted under seal, is the basis for petitioner's claim of dilution, and it is the evidence on which much of the testimony of petitioner's expert witnesses is based. Therefore, any discussion of the probative value of this survey necessarily requires a discussion of some of the information in the survey. Similarly, an alleged incident of actual confusion is based on a "verbatim" report, Exhibit 193, which petitioner has marked as confidential. Again, we cannot discuss the probative value of this evidence without discussing it herein, and therefore we have done so.

The parties have fully briefed the case, and both were represented at an oral hearing before the Board.

### **Facts**

Petitioner Hormel Foods LLC is a wholly-owned subsidiary of petitioner Hormel Foods Corp. and is the owner of petitioner's intellectual property, which it licenses back to Hormel Foods Corp. Petitioner adopted the trademark SPAM for a canned luncheon meat product which is made from pork and ham, and the name is derived from "SPiced hAM." Since 1937, when the product was introduced, 6.3 billion cans of SPAM luncheon meat have been produced. During World War 2 SPAM luncheon meat was provided to both U.S. and Allied soldiers, and to civilians in Europe, and many famous people, such as President Eisenhower, Prime Minister Margaret Thatcher and Premier Nikita Khrushchev, have written about their experiences regarding SPAM luncheon meat during that period.

Petitioner's SPAM luncheon meat is sold in virtually every retail outlet that carries food, including grocery stores, mass merchandising stores such as Wal-Mart and Target, club stores such as Costco, and convenience stores.

\*6 Petitioner promotes its SPAM meat product in various ways. In addition to television, radio, print and billboard advertising, it sponsors athletes or athletic contests (currently it sponsors a race car driver named Jesse Smith); it sends SPAMMOBILES, trucks built to resemble a can of SPAM, throughout the country, where they host block parties, or appear at grocery stores or sporting events and distribute SPAMPLES (samples of SPAM product); it does in-store demonstrations; distributes coupons; sponsors recipe contests at local and state fairs and national contests for recipes using SPAM meat (one winner, who created a SPAM cheesecake recipe, appeared on the "Tonight Show"); has sponsored festivals called SPAM JAM and SPAMARAMA; and operates the SPAM Museum in Austin, MN, which town has the nickname of SPAMTown USA, a nickname that appears on postal marks used on mail sent from Austin. In addition, in 1998 petitioner started the SPAM Fan Club, which currently operates on-line and can be joined without charge.

Two cans of SPAM, an original can and the modern version, are on display at the Smithsonian Museum of American History in Washington, DC, and a can of SPAM was part of a Library of Congress "Heritage" exhibit in which various household items were featured. Petitioner's SPAM trademark or product also has received mentions on various television programs and in movies. The opening of the SPAM Museum was featured on the "Today Show" in June 2002; a segment on the "David Letterman Show" had a product called "SPAM on a rope"; "Northern Exposure" had an astronaut saying that he was considered "SPAM in the can"; a quiz on the Rosie O'Donnell show called "Pam [Anderson] or SPAM" asked "What is more popular in Hawaii than anywhere else in the world?"; and an episode of "MASH" showed a SPAM lamb. Petitioner has also engaged in co-promotion with the Broadway musical "Spamalot." The trademark SPAM is included in a lyric in the show, and a large can of SPAM appears at that point. In connection with the opening, petitioner created a special edition "Honey Grail" can of SPAM, which has characters from Spamalot appearing on the labeling.

Petitioner's sales and advertising figures, as well as brand awareness studies, have been submitted under seal. However, because respondent has admitted the fame of the SPAM mark in terms of the issue of likelihood of confusion, see applicant's response to opposer's request for admission No. 33 in Opp. No. 91153159, there is no need for us to refer to these figures, and we will say only that they are extremely large.

In 1991 petitioner started selling collateral products--merchandise bearing SPAM trademarks. It began with T-shirts and flip flops, but then expanded to a multitude of products, including various apparel, kitchen items, jew-

elry and office supplies. The 2000 SPAMTASTIC gift catalog displays such items as caps, shirts, flannel pants, ties, backpacks, sunglasses, tennis balls, clocks, cutting boards, mugs, paper clips, letter openers, mouse pads, light switch plates, Swiss army knives, snowdomes, toy banks, balloons and golf umbrellas with the mark SPAM or representations of the SPAM can on them, as well as a SPAM CAM disposable camera and earrings in the shape of a SPAM can. These products are available for order on-line or through petitioner's toll free telephone number or SPAMTASTIC catalog, or at the gift shop of the SPAM Museum. The operator of the SPAM gift shop testified that he sometimes sells items to stores for resale, but there is no information as the extent of these re-sales or the particular items sold.

\*7 In addition, petitioner has licensed the SPAM mark for use on lottery tickets, including tickets sold in South Dakota and Minnesota, and on slot machines.

Respondent was founded in September 2001. Its product and services are offered under the mark SPAM ARREST, and their purpose is to help their customers avoid spam. Emails from known addressees are permitted to go directly into the customer's inbox. Unrecognized addressees are asked to verify that they are an actual person, rather than a computer that is sending bulk commercial emails. Verified messages then go into the customer's inbox, while unverified messages go into another box, where the customer can review them if he or she wishes. Messages that remain in this latter box are automatically deleted after seven days.

There is some question as to when respondent first used its mark in connection with its software. Respondent's founder testified that it first used its mark in May 2002, when its first customer tried its services, and that its first sale occurred in August 2002. However, we need not concern ourselves with the exact date in 2002 on which respondent used its mark for software because it is clear that it is the filing date of respondent's intent-to-use application, November 27, 2001, that is the earliest date on which respondent can rely for priority purposes.

Respondent offers its software and its services through the Internet, both directly through its website and through affiliates--companies with whom it has a contractual relationship--who offer it through their websites. Respondent publicizes its goods and services through various types of Internet advertising, including banner ads on the websites of others; it has also done some radio advertising on the Howard Stern show, and had prepared a television commercial which was, at the time of its CEO's testimony in 2005, about to be shown on the Discovery Channel. Its primary marketing is through the challenge response that is part of respondent's spam-filtering service; that is, people are directed to respondent's website in order to verify that their email message is not spam, and in this way they are exposed to respondent's website and its product/services. Respondent and its SPAM ARREST product have also received mentions in various print media and website articles.

In 2003 respondent's sales were in the \$200,000 range; at the time of Mr. Cartmell's testimony deposition in October 2005 respondent had spent between \$400,000 and \$500,000 for marketing.

The word "spam" is a recognized generic term for unsolicited commercial email. There are various stories about how this term came to be adopted, including that it was a term used on computer game-playing sites to describe different types of abusive behavior, and that it is an acronym for "sending public announcement messages." However, the widely-reported origin, which appears in Merriam-Webster's Collegiate Dictionary, 11<sup>th</sup> ed. © 2003, is that it is derived from "a skit on the British television series *Monty Python's Flying Circus* in which chanting of the word *Spam* overrides the other dialogue." Whatever its origin, "spam" is well recognized today as the generic term for such email. The definition of "spam" in the Merriam-Webster dictionary is "unsolicited usu. commercial e-mail sent to a large number of addresses." See also, definition in Random House Webster's

College Dictionary © 2001: "a disruptive, esp. commercial message posted on a computer network or sent as e-mail." Numerous media stories use it as the generic term, and even federal legislation is called the CANSPAM Act, CANSPAM being an acronym for the awkwardly named "Controlling the Assault of Non-Solicited Pornography and Marketing Act of 2003," which was obviously devised in order to result in the acronym CANSPAM.

### Analysis

#### Standing

**\*8** Petitioner has demonstrated its standing by virtue of the registrations it has made of record, and its evidence of common law rights in the mark SPAM, thus showing it is not a mere intermeddler. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

#### Priority

Because this is a cancellation proceeding, and both parties own registrations, priority is in issue. *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281 (TTAB 1998); Cf. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Respondent began using its mark after the filing of its intent-to-use application, so the earliest date on which it can rely is the November 27, 2001 filing date of that application. Petitioner can rely on the filing date of the applications that matured into its various pleaded registrations that are of record; with the exception of Registration No. 3022539 for SPAM for a screen saver, those dates precede, often by a significant period of time, respondent's constructive use date. Moreover, the evidence shows that petitioner began using the mark SPAM for all of its registered goods prior to the November 27, 2001 filing date of respondent's application.

There is been some discussion between the parties with respect to petitioner's use of the mark for a screen saver. According to the testimony of Kevin Jones, the mark was first used in 1994 by an individual at Indiana University, who created a screen saver of flying cans of SPAM and requested permission from petitioner to use the design. It is not clear to us that the use at the university constitutes actual trademark use of the mark SPAM for a screen saver. However, Mr. Jones testified that the screen saver was available to be downloaded from the spam.com website in the fall of 1997, when the website "first went up." Test., p. 15. Thus, petitioner has demonstrated its priority with respect to the mark SPAM for the screen saver. We recognize that the screen saver is available at no charge, but it is not necessary to actually sell a product in order to obtain trademark rights. <sup>[FN24]</sup> In any event, as we discuss *infra* in our analysis of the *du Pont* factor of the relatedness of the goods, whether or not petitioner has priority with respect to the mark for screen savers has no effect on our decision herein.

Petitioner has also presented evidence of prior common law use of SPAM for a wide variety of collateral merchandise items, including mouse pads, in addition to those items for which it has obtained registrations. These goods are sold primarily through petitioner's online catalog, its toll free telephone number, and its gift shop associated with the SPAM Museum in Austin, MN.

**\*9** In addition, petitioner has asserted a family of marks based on the term SPAM, e.g., SPAMTASTIC, SPAMARAMA, SPAM BURGER. In order to demonstrate priority with respect to this asserted family, petitioner must show that the family was created, i.e., would have been recognized as a family, prior to the November 27, 2001 filing date of the application which resulted in issuance of respondent's registration. In its answer respondent has admitted that petitioner's registered SPAM-derivative marks make up a family of marks. Paragraph



3. In view of this admission, we accept that petitioner has a family of marks consisting at least of these registered marks, and also note that a family may be expanded by the later inclusion of additional marks.<sup>[FN25]</sup> Petitioner's catalog and fan club newsletters from prior to 2001 include references to SPAM, SPAMTASTIC and SPAM BURGER, and given respondent's admission that petitioner has used its registered SPAM-derivative marks as a family, we find that petitioner has established prior use of a family of SPAM marks.

#### **Likelihood of confusion**

The issue of likelihood of confusion is determined by considering the factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), for which there is evidence of record. However, this case presents a very unusual situation in terms of that analysis. Fame is one of the du Pont factors, and where fame is present, it plays a major role. *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Here, it is undisputed that petitioner's trademark SPAM is a famous mark in terms of the likelihood of confusion analysis. At the same time, it is also undisputed that "spam" is a recognized word, a generic term for unsolicited commercial email, and that respondent uses and has registered its mark SPAM ARREST for software that blocks spam. This dichotomy between the fame of petitioner's trademark and the generic meaning of that same term must inform our analysis of the du Pont factors.

The first factor we consider is the similarity of the marks. Obviously, the word SPAM in respondent's mark and SPAM in petitioner's mark is identical, and to that extent the marks are similar in appearance and pronunciation. However, when it comes to the meaning of the marks, they are very different. Although petitioner's mark SPAM was derived from "spiced ham," it must be considered an invented word rather than a suggestive term, and therefore it has no meaning other than that of a trademark for petitioner's goods. On the other hand, because "spam" is a generic term for unsolicited commercial email, and applicant's goods are identified as "computer software, namely, software designed to eliminate unsolicited commercial electronic mail," as it is used in respondent's mark SPAM has the connotation of the generic term, referring to unsolicited email, and the entire mark has the connotation of software that stops or filters spam/unsolicited commercial email. Because of this difference in connotation of "spam" in the respective marks, the marks as a whole are different in connotation and commercial impression. Further, we consider these differences to outweigh the similarities in appearance and pronunciation resulting from the common element "spam." See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRYSTAL CREEK for wine not likely to cause confusion with CRISTAL for champagne); *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras not likely to cause confusion with CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear not likely to cause confusion with PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear not likely to cause confusion with BOTTOMS UP for men's suits, coats and trousers).

\*10 Moreover, respondent's mark SPAM ARREST differs from petitioner's family of SPAM marks for the same reasons, i.e., the difference in meaning and commercial impression. In addition, SPAM ARREST does not have the same overall look as the members of petitioner's family of SPAM marks. Although petitioner claims that its family of marks consists of the word SPAM followed by a second word, we disagree. In petitioner's marks, SPAM is either followed by a generic term, e.g., SPAMMOBILE, SPAM JAM, or it replaces a syllable in a known word or phrase with "SPAM," such as SPAMBURGER, SPAMTASTIC. This latter usage of SPAM is reinforced by the use of such terms (as opposed to marks) in petitioner's advertising, recipes, and the like, e.g., SPAMPLES, SPAMBASSADORS. SPAM ARREST, on the other hand, would not be viewed as a phrase in which SPAM has been substituted for another term or phrase, nor is it followed by a generic term. Rather, as stated above, the word SPAM in SPAM ARREST would be understood as the generic word "spam," meaning

unsolicited commercial email, and ARREST would be seen as a verb. Thus, SPAM ARREST would not be perceived as being a part of petitioner's family of marks.

This du Pont factor favors respondent.

With respect to the factor of the similarity of the goods and services, there are two points that we must consider. The first is the similarity of petitioner's computer products to respondent's computer software. Petitioner has shown prior common law use of SPAM for a computer mouse and computer wallpaper, and common law use as well as a registration for SPAM for "computer software, namely, a screen saver." Petitioner also has pointed to various gaming devices that employ computer software and feature the SPAM mark.

The mere fact that respondent's goods are a type of computer software and petitioner's goods can be used with computers, or contain computer software, or even are a type of computer software, is not a sufficient basis on which to find these items related. The mere fact that a term—"computer" or even "computer software"—can be found to describe the goods of the parties does not make them similar. See *Harvey Hubbell Incorporated v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517, 520 (TTAB 1975) ("The mere fact that the term 'electronic' can be used to describe any product that includes an electronic device does not make a television set similar to an electronic microscope, or an electronic automotive ignition system similar to telemetering devices.") See also, *General Electric Company v. Graham Magnetics Incorporated*, 197 USPQ 690 (TTAB 1977); *In re Cotter and Company*, 179 USPQ 828 (TTAB 1973). Screen saver computer software and computer software to filter unsolicited commercial email are so different in their nature and purpose that, without more, we cannot conclude that consumers would assume that these goods are related.

\*11 Petitioner also uses its mark SPAM for a very wide range of goods. The evidence shows that SPAM is a merchandising mark, and that consumers buy the disparate items because they bear the trademark SPAM (or a variation thereof, such as a picture of the SPAM can). Lance Pogones testified that "pretty much it seems anything we can put SPAM on will sell." Test., p. 6. As a result, consumers are likely to view many very different items that bear the mark SPAM as being related to petitioner's luncheon meat.

However, when used in connection with computer software to filter unsolicited commercial email, the word "spam" would be viewed as having its generic meaning of unsolicited email, and therefore such computer software would not be viewed as a collateral product of petitioner's. As a result, we cannot find respondent's computer software that is designed to eliminate unsolicited commercial electronic mail as being related to petitioner's various goods or services, despite the broad range of collateral uses of its mark.

As for the goods for which petitioner has obtained registrations, we have considered them not only as collateral goods, but as items in their own right, as they are identified on the face of the registrations. In either category, petitioner has not demonstrated that consumers will view these various items, e.g., apparel, pens, mugs, jewelry, as related to computer software designed to eliminate unsolicited commercial electronic mail.

Thus, in the case of the particular software at issue herein, we find that respondent's computer software is not related to petitioner's products or services.

The next du Pont factor we consider is the channels of trade. Respondent has made the point that it offers its software through its own website and those of its affiliates, but in determining likelihood of confusion we must deem the goods to travel in all channels of trade that are appropriate for such computer software. This would include computer stores, Internet websites, and mass merchandisers such as Wal-Mart. In addition to grocery

stores and the like, petitioner's luncheon meat is also sold at mass merchandisers, including Wal-Mart. However, although these items can be sold in a mass merchandise store like Wal-Mart, there is no evidence that canned luncheon meat and email filtering software is sold together, or that people buying one item would come in contact with the other.

Neither party has discussed the potential channels of trade for petitioner's other goods that are the subject of its registrations. Thus, we have no evidence as to whether these items would be sold in the same channels of trade; certainly there is nothing to suggest that such items would be sold in the same stores with the exception of mass merchandisers that sell virtually everything. However, as with luncheon meat and email filtering software, we have no basis on which to conclude that any of petitioner's identified goods would be displayed in proximity to software of the type identified in respondent's registration, or that consumers for the various goods identified in petitioner's registrations would come in contact with such software.

\*12 As for those items for which petitioner has common law rights, the channels of trade for these goods are primarily limited to sales from petitioner's catalog, its website, its toll-free telephone number, and its museum gift shop.<sup>[FN26]</sup> Respondent's software is also offered through the Internet, but we do not regard the fact that both parties' goods are offered through this medium as evidencing that they are sold through the same channels of trade. They are sold on different websites, with petitioner's collateral goods being sold through its own website, while spam-filtering software is not sold on this site.

The only evidence of petitioner's goods and spam filtering software being sold on the same website is Exhibit 195 to Jeffrey Grev's testimony, which is the result of a search for "spam" on the Sam's Club website.<sup>[FN27]</sup> This search retrieved items of petitioner's canned luncheon meat (which indicated that they were available only for in-store pickup) and software which filters spam. The fact that a single website, for what is in effect an on-line superstore or mass merchandise store, offers both types of products is meager evidence that consumers would encounter both, or that luncheon meat and computer software for filtering spam are normally offered in the same channels of trade.

Accordingly, we find that this du Pont factor does not favor either party.

As for the conditions under which and buyers to whom sales are made, both parties' goods are consumer items. All of petitioner's goods, whether its primary meat products or its collateral items, are bought by the general public. They include many inexpensive items which would not be purchased with great care. The consumers for respondent's product include anyone who uses email. Such consumers must be considered to include the general public, although they may be considered somewhat more sophisticated in terms of checking the nature of the product which they will load on their computers. Thus, to the extent that the class of purchasers of both parties' goods are the same and that they are the public at large, this factor favors petitioner. However, to the extent that consumers of spam-filtering software will be careful about the software that they download or purchase for their computers, and will understand the generic meaning of "spam" when they see it in a mark for such software, this factor favors respondent.

This brings us to the fifth du Pont factor, that of the fame of petitioner's mark. As noted previously, petitioner has demonstrated, and respondent has acknowledged, that its mark SPAM is famous for canned luncheon meat. Even dictionary definitions that are of record list "Spam" as "1. *Trademark*. A canned food product consisting esp. of pork formed into a solid block," Random House Webster's College Dictionary © 2001; " *trademark* used for a canned meat product," Merriam-Webster's Collegiate Dictionary, 11<sup>th</sup> ed. © 2003. It is because of the

fame of this mark that petitioner has successfully expanded its mark to use on collateral products, i.e., has used it as a merchandising mark by which consumers purchase other products because of the very fact that SPAM is printed on them. There is no question that, as a famous and therefore strong mark, SPAM is entitled to a broad scope of protection. However, the fame of the mark does not entitle petitioner to a monopoly on the use of SPAM as a trademark for all goods and services. If the du Pont factor of fame were interpreted in such a manner, owners of famous marks would essentially have a right in gross in a term. However, as the Court said in *The University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983):

\*13 The fame of the University's name is insufficient in itself to establish likelihood of confusion under § 2(d). "Likely \*\*\* to cause confusion" means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law and to concepts embodied in 15 USC § 1052(d).

Here, although there has been testimony, based on the survey conducted by George Mantis, that consumers associate SPAM ARREST with SPAM, at best that association is clearly of the "brings to mind" variety, rather than evidence that consumers believe that computer software designed to eliminate unsolicited commercial electronic mail that is sold under the mark SPAM ARREST emanates from or is sponsored by petitioner. The survey itself was not even designed to determine whether there was a likelihood of confusion between respondent's mark and petitioner's mark(s); rather, its stated purpose was to assess "whether the name 'SPAM ARREST' has attained secondary meaning and whether it dilutes the distinctiveness of Hormel's SPAM trademark." Exhibit 1.<sup>[FN28]</sup> Survey respondents were first shown a card with the words "SPAM ARREST" and, below that term, "Computer Software," and asked whether "the product shown on this card is put out by one company, more than one company, no company, or don't know." Only after follow-up questions on the issue of "secondary meaning" were a second series of questions put, i.e.:

Totally separate and apart from the company that puts out this product, does the name of this product bring to mind any other products or brands?

If the answer was in the affirmative, respondents were then asked:

What products or brands come to mind?

It is clear from these questions that the interpretation of the survey results that is most favorable to petitioner<sup>[FN29]</sup> is that, for those interviewees who mentioned SPAM luncheon meat, SPAM ARREST merely recalled petitioner's mark and/or product.

Thus, although the fame of petitioner's mark certainly favors petitioner herein, petitioner has not shown how that fame has carried over to computer software designed to eliminate unsolicited commercial electronic mail, or that consumers would associate such software with the source of petitioner's SPAM and SPAM-derivative products and services. In fact, as discussed below with respect to the du Pont factor of the number and nature of similar marks in use on similar goods or services, the evidence shows that petitioner's mark is not a strong mark for such goods.

\*14 Respondent has submitted evidence that numerous products and services for the filtering of unsolicited commercial email are offered under trademarks that include the word SPAM. At his testimony deposition respondent's founder and CEO, Brian Cartmell, identified printouts from almost 100 websites using such trademarks. The marks include SPAM KILLER, SPAM STOP, SPAM BUTCHER, SPAM SLEUTH, SPAM K O, SPAM GRIP and SPAM SHREDDER, and are for various "solutions" to spam, which may be software or ser-

vices or a combination thereof. Our analysis of this factor of third-party use, and the evidence regarding it, is somewhat different from the usual situation. Frequently the Board has given little weight to evidence of third-party use without testimony regarding the extent of such use, because we could not determine whether the public had been exposed to the marks. However, in the case of these computer solutions, as opposed to what may be a local restaurant or a product sold in a limited area, a normal channel of trade for these goods and services is the Internet, and therefore anyone with Internet access who is looking for a way to block or filter spam may be exposed to the marks. The second “anomaly” regarding this factor is that normally evidence that a term common to the marks at issue is frequently used by third parties shows that a plaintiff's mark is weak and entitled to a limited scope of protection. That is, because consumers have been exposed to multiple uses of the element that is common to the parties' marks, they are more likely to be able distinguish the marks based on relatively small differences. Here, however, petitioner's trademark SPAM has been shown to be a famous mark, and is obviously a strong mark in general. What the third-party use shows in this case is that, in the field of email filtering/spam blocking solutions, the trademark SPAM is not a strong mark because the term “spam” is used by so many third parties for its generic meaning. This du Pont factor favors respondent.<sup>[FN30]</sup>

We examine together the next du Pont factors, the nature and extent of any actual confusion and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. The only arguable evidence of actual confusion consists of a verbatim report taken by petitioner's employees. These verbatim reports are prepared by petitioner's consumer affairs department, and can be reports of either telephone conversations, emails or letters. The particular “verbatim” is on a report dated December 1, 2002 to December 15, 2003, and reads in its entirety as follows:

Message: I do not understand how this will stop my spam. Will you please [sic] stop my spam? Your other web site will not work for me. I went to <http://www.spamarrest.com> and they do not even have live help. Where can I stop this? Please stop it. Why do I have to pay to stop spam? Please stop it completely! Your food is good but your advertising to stop it does not have live help. Do you want me to wait for help? This is so wrong. Carma [sic] will get you.

\*15 Exhibit 193 to the testimony deposition of Nicholas Meyer. Mr. Meyer could give no further information about this message; he could not identify whether it came in by email, phone or letter, or any information as to who wrote it, or an address or telephone number. Although he thought that there might be more information on the message in the consumer affairs department, including whether or not a response was sent, the only information he had was the exhibit itself.

We do not regard this message as evidencing an incident of actual confusion. Based on the limited information petitioner has provided, we cannot even ascertain that it was sent by a customer, or that it was a serious complaint and not a joke. There are just too many unknowns to give it real probative value. Thus, the factor of actual confusion is neutral.

So, too, is the factor of the lack of actual confusion. At the time of trial respondent had been operating for a limited period of time. Although respondent's CEO testified that millions of people have visited its website, these visits are primarily so that the person can verify that the email message it has sent to a customer of respondent's is not spam, and it is not clear to what extent the sender actually examines the website, rather than merely typing in a word to show that a computer is not the source of the message. As a result, there has not been sufficient concurrent use without confusion for us to conclude that this factor should favor respondent.

In terms of the du Pont factor of the variety of goods on which a mark is or is not used, as we have said, petitioner's mark SPAM is not only a famous mark for its luncheon meat, but is used as a merchandising mark on a

wide variety of products. In this respect, this factor favors petitioner.

The only other factor that has been discussed by the parties is the extent to which [respondent] has a right to exclude others from use of its mark on its goods. Petitioner argues that, because it has prior rights in the mark SPAM, petitioner can exclude respondent "from causing confusion of its famous SPAM mark," and therefore respondent has no right to exclude others. Brief, p. 42. Respondent, on the other hand, argues that because it has a registration for its mark, it is entitled to exclude others from using its mark or a confusingly similar mark in connection with its identified goods. As the factor is listed in the du Pont decision, it refers to the extent that the applicant has a right to exclude others, since du Pont was an ex parte proceeding in which the applicant was seeking to register its mark, and registration had been refused by the Office in view of a previously registered mark. The present proceeding is a cancellation action, and therefore, obviously, respondent owns a registration. Although registrations are entitled to the presumptions set forth in Section 7(b) of the Statute, here the very purpose of this proceeding is to cancel respondent's registration. In such circumstances, respondent cannot simply rely on its registration as prima facie evidence of the registrant's exclusive right to use the mark in commerce on the goods identified in the registration, in the face of petitioner's evidence challenging that right. This du Pont factor is neutral.

\*16 After considering all of the du Pont factors on which we have evidence or argument, we find that petitioner has failed to prove that respondent's mark SPAM ARREST for "computer software, namely software designed to eliminate unsolicited commercial electronic mail" is likely to cause confusion with petitioner's mark SPAM and its SPAM-derivative marks for its various goods. In particular, because the word "spam" in respondent's mark will be viewed as having its generic meaning of unsolicited commercial electronic mail, the marks as a whole are different in connotation and commercial impression. Differences in the marks alone can be dispositive in finding no likelihood of confusion. See *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) Here, as detailed above, there are additional factors that favor a finding of no likelihood of confusion. While we have given great weight to the fame of petitioner's mark, that fame does not extend to computer software for filtering spam. Simply put, the scope of protection of petitioner's mark, while extremely broad, does not extend to prevent the use of SPAM ARREST for spam filtering software, since consumers will understand SPAM as used in respondent's mark in its generic sense rather than as referring to petitioner's mark(s).

#### **Dilution**

The second ground for cancellation is that of dilution. As an initial matter, we note that respondent, relying on *Moseley v. V. Secret Catalogue, Inc.*, 537 US 418, 123 S.Ct. 1115, 65 USPQ2d 1801 (2003), has asserted that petitioner's claim must fail because petitioner never produced any evidence of actual dilution. However, the October 6, 2006 amendments to the Lanham Act, made after the Moseley decision, make it clear that the standard to be applied in ascertaining dilution is "likely to cause dilution," not "actual dilution." See Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c):

Dilution by Blurring; Dilution by Tarnishment.--

(1) Injunctive relief.--Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury. (emphasis added)

Although this proceeding was tried and briefed prior to the amendment of the Lanham Act, the standard applic-

able in TTAB proceedings both prior to and after the amendment of the Act was and is likelihood of dilution, whether or not the defendant's mark is in use. *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1734 (TTAB 2003).<sup>[FN31]</sup>

**\*17** Petitioner has asserted dilution by blurring and dilution by tarnishment. Because petitioner devotes more of its argument to the former assertion, we will address that first.

In order to succeed on a claim of dilution, a plaintiff must prove that its mark is famous and distinctive. Fame for dilution purposes is different from fame for likelihood of confusion. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Further, the plaintiff must show that its mark became famous prior to the first use or constructive first use of the defendant's mark. In the present case, therefore, petitioner must establish that its mark became famous prior to November 27, 2001, the filing date of the intent-to-use application that resulted in issuance of the registration that is the subject of this proceeding.

As noted previously, respondent has admitted the fame of petitioner's mark only for purposes of the likelihood of confusion analysis, and not for purposes of dilution. However, we find based on the evidence of record that, prior to 2001, petitioner's mark SPAM had achieved the degree of fame with respect to canned meat that is necessary for a dilution claim. At that point, petitioner had used the mark for such goods for over 60 years; had achieved an extremely large volume of sales that were still very high even in the period shortly before respondent's adoption of its mark; and had engaged in significant promotion and advertising of its mark throughout the entire period of its use. In addition, the various uses or mentions of petitioner's mark and its meat product, e.g., in the Smithsonian Museum, in a Library of Congress display, on numerous television programs, all demonstrate that the mark and product are recognized by the public. This recognition is also shown by the brand awareness studies that petitioner made of record, showing an extremely high "aided" brand awareness even among non-users of petitioner's canned meat.

In addition to proving fame, petitioner must prove that its mark is distinctive. *Toro Co. v. ToroHead Inc.*, *supra*. As the Board stated, *id.* at 1177:

To be vulnerable to dilution, a mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner's goods or services, i.e., devoid of its trademark context. H.R. REP. No. 104-374, at 3 (1995) ("the mark signifies something unique, singular, or particular"). Also, courts have indicated that a mark can be famous but not particularly distinctive. See, e.g., *Sporty's Farm L.L.C. v. Sportsman's Market Inc.*, 202 F.3d 489, 497, 53 USPQ2d 1570, 1576 (2d Cir. 2000) ("[E]ven a famous mark may be so ordinary, or descriptive as to be notable for its lack of distinctiveness"); *TCPIP Holding Co. v. Haar Communications Inc.*, 244 F.3d 88, 96, 57 USPQ2d 1971, 1975 (2d Cir. 2001) (footnote omitted) ("Some of the holders of these inherently weak marks are huge companies; as a function of their commercial dominance their marks have become famous. It seems unlikely that Congress could have intended that the holders of such non-distinctive marks would be entitled to exclusivity for them throughout all areas of commerce").

**\*18** Thus, in order to prove dilution, "the mark's owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner's use of the mark. What was once a common noun, a surname, a simple trademark, etc., is now a term the public primarily associates with the famous mark. To achieve this level of fame and distinctiveness, the party must demonstrate that the mark has become the principal meaning of the word." *Id.* at 1180.

The evidence shows that “spam,” in addition to being petitioner's trademark, has a well-recognized meaning as a generic term for unsolicited commercial email; the term is used by consumers, the media, Congress, state legislatures and those who sell solutions for such unwanted email. Thus, it does not have the requisite degree of distinctiveness to support a finding of dilution, at least vis-à-vis respondent's use of the term as part of the mark SPAM ARREST for computer software designed to eliminate unsolicited commercial email. Even petitioner's expert witness Gregory Carpenter, a professor in Northwestern University's business school, recognized that “a second meaning would diminish the uniqueness” of the SPAM brand, test. p. 38, and the more “spam” is used as a generic term, “the greater the impact on the SPAM brand.” p. 29.<sup>[FN32]</sup>

The situation we have here is somewhat analogous to that in *Hasbro Inc. v. Clue Computing Inc.*, 66 F. Supp.2d 117, 131, 52 USPQ2d 1402, 1413 (D. Mass. 1999), *aff'd*, 232 F.3d 1, 56 USPQ2d 1766 (1st Cir. 2000), in which “Clue” was found to be a common word with many meanings and the “defendant's use of the word ‘clue’ is entirely consistent with the common usage of the word.” We acknowledge that, as opposed to CLUE, which was a common word at the time the plaintiff adopted it as a mark, here petitioner created the trademark SPAM, and it became a generic word many years later and after (and perhaps was adopted by others as a generic term because of) the vast success it enjoyed as a trademark for petitioner's canned meat. However, although it may be unfortunate for petitioner that its mark has become a generic word for unsolicited commercial email, that is what has happened. As a result, SPAM is not a distinctive mark of petitioner and its goods and services when it is used in connection with email, or with goods or services that deal with unsolicited commercial email. In other words, the fact that “spam” has become a generic term for unsolicited commercial email is what diluted the distinctiveness of petitioner's mark, and this dilution occurred prior to respondent's adoption of the mark SPAM ARREST.

In addressing the fact that “spam” is a generic term (and presumably to differentiate the dilution caused by generic usage of the mark versus purported dilution when used in respondent's trademark), petitioner has taken the position that the use of “spam” is acceptable when it is used as an ordinary generic term, but that it is not acceptable when SPAM is used as part of a trademark. Its expert witness Gregory Carpenter testified that there is a distinction between the use of “spam” as a generic term and use in a commercial context, test. pp. 34-35:

\*19 As a word in the language, no organization is actively seeking to create associations surrounding that .... So there's no individual with an economic incentive to promote a particular word in the English language. And so therefore, the associations--the word will mean what it--what the public comes to believe it ought to mean. But it won't--there won't be another commercial enterprise seeking to create a set of associations that may interfere or diminish the value of the Hormel brand per se.

Although we understand the distinction that petitioner is making, we do not believe that this is a significant difference, or one that is drawn by the statute or the case law. If a term is generic, others should have the right to use it, even as a disclaimed term in a trademark, to describe the goods or services with which the mark is used. And as we stated in our discussion of likelihood of confusion, respondent is using the term “spam” in the mark SPAM ARREST in its generic sense, and that is the meaning that would be perceived by consumers.

This is not to suggest, however, that simply because a mark has a generic meaning in other contexts it can never be considered distinctive in terms of proving dilution. We are saying only that, when a trademark has an alternative generic meaning, and it is being used in a second mark to project that generic meaning, there can be no dilution of the original mark under the statute because that mark is not distinctive with respect to the goods which the generic term describes. This would be the case whether the trademark owner invented a mark and the mark subsequently became a generic term, as is the case here, or the trademark owner chose an ordinary word that is arbitrary for its goods and through its efforts caused the mark to become distinctive for those goods.



In assessing petitioner's claim of dilution, we have considered the survey conducted by The Mantis Group, Inc., and the testimony of George Mantis with respect to that survey. It is this evidence on which petitioner primarily relies in asserting that respondent's mark will dilute petitioner's mark. The survey was a "mall intercept" survey, in which people over the age of 18 found in eight different shopping malls, two in each of the four census regions of the country, were requested to participate. In order to qualify as a participant, an interviewee had to answer that, in the past 60 days or within the next 60 days, he or she had used or was likely to use the Internet to send and receive e-mail and had purchased or was likely to purchase a canned meat product, and had purchased or was likely to purchase "computer software related to their use of the Internet, such as software to protect their data or filter E-mail." Mantis test. exhibit 1. Of the 159 people questioned about SPAM ARREST, the Mantis report concluded that 71 indicated in some way that SPAM ARREST brought to mind petitioner's product or trademark. We note that more than one fifth of the answers that were submitted as part of this group mention, in addition to petitioner's mark SPAM or meat, various third-party trademarks, e.g., NetZero, Microsoft and McAfee, or various other products or items, including computer software, pop-ups, and email programs. Thus, the Mantis report's calculation that for 44.7% of survey respondents SPAM ARREST brought to mind petitioner or its meat product is not as impressive as it would appear from the conclusion in the report.

**\*20** Respondent submitted the testimony of its own expert witness, Lea Knight, with respect to the validity of the survey. Her testimony shows what we have frequently seen when we have a "battle of the experts": no survey is perfect. Several of her comments really speak more to ways the survey could have been improved, rather than indicating major flaws, and some of her comments, while valid for a marketing survey, do not take into account trademark principles that must be applied by the Board. However, we find certain of her criticisms valid, and we have our own additional concerns about the survey.

First, as Ms. Knight pointed out and as Mr. Mantis recognized, a mall intercept survey does not use a random sample of the population whose views are sought. Thus, the results of the survey are not projectible. The survey results tell us about the opinions of the people who participated in the survey, but we cannot extrapolate from them what the results would be if a survey could be taken of everyone in the United States who fit the screening criteria. We acknowledge that mall intercept surveys are a recognized survey technique, and that they have been considered in trademark proceedings, but their value is limited. Here, where the number of respondents to the dilution questions is quite small (159), the survey provides limited information about consumer views. Further, even the people who were actually interviewed were not necessarily representative of the people who were approached to participate in the survey. Although equal numbers of people from each age group and gender and location were "intercepted" in each of the malls, the vast majority of them did not meet the screening criteria. Thus, the number of actual interviews could have been primarily from one mall or from a single geographic region. The survey report fails to indicate the number of interviewees from each mall. Nor does the report indicate the day of the week or the time of day that the interviews were conducted. Obviously, these factors have an impact on demographics.

Those who participated in the survey had purchased in the preceding sixty days, or intended to purchase in the next sixty days, both a canned meat product and "computer software related to their use of the Internet, such as software to protect their data or filter their E-mail." The computer software identified in respondent's registration has a very specific, limited purpose-- to eliminate unsolicited commercial electronic mail. The generic term "spam" means "unsolicited commercial electronic mail," and the question of whether consumers would draw an association between the mark SPAM ARREST and petitioner's mark SPAM must be determined in connection with this specific type of computer software, not a general category of computer software related to use of the Internet.<sup>[FN33]</sup> Thus, it is not clear that the participants in the survey constituted the relevant group of pur-

chasers.

**\*21** We also have concerns about the questions in the survey. As noted in our discussion of fame with respect to likelihood of confusion, the questions regarding dilution were asked after questions whose purpose was to determine “secondary meaning” of the defendant’s mark. We cannot ascertain whether these earlier questions had any effect on the interviewees’ responses. And we also are concerned with the introduction to the question on dilution, i.e., “Totally separate and apart from the company that puts out the product...” Mr. Mantis, during his discovery deposition, explained that in order to do a survey on dilution, one must test in the context of the defendant’s product category, but the introduction to the question on dilution might well have been interpreted by the participants as a direction to ignore the product category. Aside from that problem, the prompt that the survey respondents were shown, a card with SPAM ARREST in all capital letters and “Computer Software” below it, could have resulted in the respondents considering all types of computer software, when “spam” has a generic meaning only in connection with computer software for a specific purpose. “Computer software” is overly broad to be used as a description of the product category for respondent’s goods. Petitioner itself has recognized, quoting from Toro, supra at 1183, that “dilution by blurring occurs ‘when a substantial percentage of consumers, upon seeing the junior party’s use of a mark on its goods, are immediately reminded of the famous mark and associate the junior party’s use with the owner of the famous mark....’” Brief, p. 46 (emphasis added). Using the descriptor “computer software” does not adequately advise the survey respondents what the junior party’s goods are.

We also have a concern about whether consumers were merely guessing or trying to come up with an answer to please the interviewer. At the beginning of the questions relating to “secondary meaning,” the participants were told, “In a moment I’m going to hand you a card which shows the name of a product. I will then ask you some questions. For each of my questions, if you don’t know or don’t have an answer, please don’t guess.” However, this caution was not repeated at the point the interviewees were questioned about dilution, and again, the introduction to the dilution question, “Totally separate and apart from the company that puts out this product...” might well have been viewed as a request to guess. In this connection, we note that the question on dilution, “Totally separate and apart from the company that puts out this product, does the name of this product bring to mind any other products or brands?” did not include “if any” or a similar phrase which would be considered permission for the participant to say “no.” In contrast, the question on “secondary meaning” began with such an indicator of permission to say no, i.e., “if you have an opinion.” As a result, participants may have simply tried to come up with an answer to please the interviewer. Certainly at least one of the responses indicates to us that the interviewee was just guessing: “(Hormel) What do you want to know. The ham or Spam. Is that what you want to know.” See response No. 100.<sup>[FN34]</sup>

**\*22** Most important to the question of whether dilution is likely, the survey results do not tell us whether people would reference petitioner’s mark and product any time they saw “SPAM” alone or because respondent’s complete mark SPAM ARREST causes such an association. In this connection, Ms. Knight pointed out that the survey did not control for this factor—that is to say, it failed to take this possibility out of the equation—and Mr. Mantis admitted as much during his discovery deposition. Mantis disc. p. 106. The absence of a control is of particular note since the survey did use a control in the “secondary meaning” portion, and Mr. Mantis has testified that a control is a way to eliminate “noise.” At least two of the responses that petitioner has listed as indicating dilution show that the interviewees, in answering whether the name of the product brings to mind other products or brands, were looking only to the word SPAM in respondent’s mark, rather than to the mark itself. Response No. 104: “Other products as far as the name Spam. As far as a meat product. Arrest like an allergy product.” Response No. 84: “Yes, the spam part.” Thus, the survey responses purportedly indicating an associ-

ation between defendant's mark and "meat," or petitioner, or petitioner's mark, are equally consistent with the conclusion that it is the generic word "spam," and not respondent's mark SPAM ARREST, that creates the association with petitioner's trademark SPAM and its canned meat product.

This conclusion, that people make a connection between spam email and petitioner's mark and/or product, is supported by the media references to petitioner's mark in articles about unsolicited email. The record includes a large number of articles, broadcast segments and the like about unsolicited commercial email in which a can of petitioner's meat product is used as a visual illustration. Petitioner acknowledges "the frequent use of the SPAM trademark and SPAM product image by the public when discussing the subject of unsolicited commercial email." Reply brief, p. 22. Even federal legislation regarding unsolicited email is named the CANSPAM Act. Although petitioner has written to various media protesting the use of its product in these stories, the fact remains that there has been public exposure connecting petitioner's trademark and product with unsolicited commercial email (spam).

In summary, we have so many concerns about the survey that we accord it little probative value. Further, to the extent that the testimony of petitioner's various expert witnesses rely heavily on the results of the survey, that testimony, too, has limited value.

Aside from failing to prove the distinctiveness of its mark with respect to products and services relating to unsolicited commercial email or spam, petitioner has failed to prove that the involved marks are essentially the same. As the Board stated in *Toro*, and as reiterated in *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1514 (TTAB 2005), *aff'd* 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007), to support an action for dilution by blurring, the marks must be similar enough that a significant segment of the target group would see the two marks as essentially the same. The connotation of SPAM in respondent's mark is unsolicited commercial email because it is used in connection with a product that filters such email. Thus, respondent's mark is different from petitioner's mark in connotation and commercial impression, and therefore the marks are not essentially the same.

**\*23** In view of the foregoing, we find that petitioner has failed to prove either that petitioner's mark is distinctive when consumers encounter the mark in the context of unsolicited commercial email or products or services that address this problem, or that respondent's mark causes dilution by blurring.

Petitioner also argues that respondent's mark causes dilution by tarnishment. Petitioner bases this claim on a few Internet postings that allege respondent engages in sending spam emails and/or that its software is spyware, and therefore the association of petitioner's mark with respondent's software tarnishes petitioner's mark. The postings on which petitioner relies cannot be used as proof of the truth of the statements made therein. Moreover, the number of these negative postings is so limited (and some have been retracted) that we cannot conclude that the public regards respondent's product as inferior or offensive.

In conclusion, we find that petitioner has failed to prove dilution, whether by blurring or tarnishment.

#### **Affirmative Defenses**

In view of our finding that petitioner has failed to prove its pleaded grounds of likelihood of confusion or dilution, we need not reach respondent's affirmative defenses. However, in the interest of rendering a complete opinion, we discuss them briefly. With respect to respondent's claim that "spam" is a generic term for unsolicited commercial email, we have considered this claim in our analysis of the grounds of likelihood of confusion and dilution. As for the affirmative defense of acquiescence and estoppel, respondent bases this defense on a posi-

tion statement that appeared on petitioner's website at the time respondent filed its intent-to-use application in November 2001. This statement essentially said that "we do not object to use of this slang term [spam] to describe UCE [unsolicited commercial email], although we do object to the use of our product image in association with that term." The evidence shows that respondent was not aware of petitioner's position at the time it filed its application, and became aware of it only after June 13, 2002, when respondent received a cease and desist letter from petitioner.

As a general rule, the equitable defense of acquiescence in an opposition or cancellation proceeding does not begin to run until the mark is published for opposition. *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904 (TTAB 2005) Cf. *National Cable Television Association, Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991) [laches runs from the time from which action could be taken against the trademark rights inhering from registration].

Petitioner brought this cancellation proceeding on May 5, 2003, approximately nine months after the publication date of the underlying application on August 6, 2002, and just one and one-half months after issuance of the registration on March 25, 2003. Moreover, petitioner advised respondent of its objection to the use of SPAM ARREST for its services in June 2002, shortly after respondent's application for SPAM ARREST for services was published for opposition. This relatively short period, with respect to use of the mark for either the goods or services, cannot be viewed as an unreasonable delay.

\*24 Moreover, although petitioner's policy statement that was on-line in 2001 did not specifically state that petitioner objects to third parties using SPAM as a part of their trademarks, as a later version of the statement does make clear ("we do object to the use of the word 'spam' as a trademark"), we do not read the 2001 statement as advising third parties that petitioner does *not* have an objection to the registration of such marks. Moreover, it is clear that respondent did not rely even on a mistaken interpretation of this policy statement when it adopted its mark, since it was not aware of the position statement until after its application was filed, and after the March 2002 date that it now asserts was the date of first use of its mark for its goods.

Accordingly, if petitioner had demonstrated that it was entitled to judgment on either its claim of likelihood of confusion or its claim of dilution, we would find that proof of either claim would not be barred by acquiescence.

### Decision

Petitioner having failed to prove its pleaded grounds of likelihood of confusion and dilution, the petition for cancellation is dismissed.

FN1. Registration No. 2701493, issued March 25, 2003, based on an intent-to-use application that was filed on November 27, 2001.

FN2. The petition also recited an alternative ground of mere descriptiveness or genericness, but petitioner stated in its trial brief, at footnote 1, that it "is not advancing the mere descriptiveness claim." Although petitioner also states that it "chooses to prosecute this cancellation on the grounds of likely confusion and likely dilution without prejudice to its claim of mere descriptiveness," we treat petitioner's failure to prosecute this ground as a waiver of it.

FN3. Petitioner relies on three non-precedential Board decisions. Prior to January 23, 2007, the Board's policy had been that decisions which were not designated as "citable as precedent" were not citable authority. See Gen-

eral Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270, 1275 n. 9 (TTAB 1992). On January 23, 2007, a notice in the Official Gazette stated that henceforth the Board would permit citation to any TTAB disposition, although a decision designated as not precedential is not binding upon the TTAB.

FN4. TARR stands for Trademark Applications and Registrations Retrieval.

FN5. It appears that petitioner treated its notice of reliance as a vehicle for advising the Board and respondent as to all evidence on which it would rely in support of its case. For example, petitioner stated at paragraph 27 that it had taken or planned to take the testimony depositions of several individuals, but did not submit them with the notice. Indeed, the notice of reliance was signed and filed on August 29, 2005, although the testimony deposition of Ellen Kohl did not take place until August 30, 2005. Petitioner also submitted a copy of the file of respondent's registration, although such material is automatically of record pursuant to Trademark Rule 2.122(b). Many of the exhibits petitioner submitted with its notice of reliance were duplicate copies of exhibits that were made of record during the various testimony depositions, with petitioner explaining that "Exhibits 1-212 were the subject of Petitioner's testimony depositions. The exhibits set forth in this Notice of Reliance are offered for the independent basis set forth in each paragraph." p. 1, n. 1. However, once an exhibit is properly made of record, it may be referred to or relied on by any party to a proceeding for any purpose without further action, and it was therefore unnecessary for petitioner to submit duplicate filings.

In addition, we note that petitioner sometimes marked the same exhibits with more than one number, essentially introducing a single exhibit twice during the course of two depositions but with different numbers (although in other depositions, previously marked exhibits were referred to by the number under which they were originally introduced). The Board frowns on the submission of duplicate exhibits and petitioner has wrongly burdened the Board by not taking care to avoid duplications in the record.

FN6. The parties cross-moved to strike or exclude testimony and exhibits relative to a survey conducted by petitioner and the responsive testimony and report offered by respondent. The Board denied the motions, but stated that the probative value to be accorded to such evidence would be considered at final hearing. We do so infra.

FN7. This opposition proceeding, No. 91153159, was suspended on September 30, 2003, upon stipulated motion of the parties, pending a determination in the present cancellation proceeding.

FN8. These registrations are all owned by petitioner Hormel Foods LLC.

FN9. Registration No. 755187, issued August 20, 1963; Section 8 & 15 affidavits accepted and acknowledged; renewed twice.

FN10. Registration No. 1338031, issued May 28, 1985; Section 8 & 15 affidavits accepted and acknowledged; renewed.

FN11. Registration No. 1415969, issued November 14, 1986; Section 8 & 15 affidavits accepted and acknowledged; renewed.

FN12. Registration No. 1498745, issued August 2, 1988; Section 8 & 15 affidavits accepted and acknowledged.

FN13. Registration No. 1505620, issued September 27, 1988; Section 8 & 15 affidavits accepted and acknowledged.

FN14. Registration No. 1716102, issued September 15, 1992; Section 8 & 15 affidavits accepted and acknow-

ledged; renewed.

FN15. Registration No. 1985602, issued July 9, 1996; Section 8 & 15 affidavits accepted and acknowledged; renewed. The status and title copy was furnished by the USPTO in June 2005, during petitioner's testimony period and prior to the renewal of the registration. In accordance with Board policy, we have confirmed that Office records reflect the renewal of the registration. See TBMP §704.03(b)(1)(A) (2d ed. rev. 2004) and cases cited at footnote 142. In checking the status of the registration, we have also confirmed that Section 8 & 15 affidavits were accepted and acknowledged, respectively, although this information inexplicably does not appear on the copy of the registration prepared by the USPTO.

FN16. Registration No. 2057484, issued April 29, 1997; Section 8 & 15 affidavits accepted and acknowledged; renewed. The status and title copy was furnished by the USPTO in June 2005, during petitioner's testimony period and prior to the renewal of the registration. We have confirmed that Office records reflect the renewal of the registration.

FN17. Registration No. 2373313, issued August 1, 2000; Section 8 & 15 affidavits accepted and acknowledged.

FN18. Registration No. 2639240, issued October 22, 2002.

FN19. Registration No. 3022539, issued December 6, 2005.

FN20. Registration No. 1819104, issued February 1, 1994; Section 8 & 15 affidavits accepted and acknowledged; renewed.

FN21. Registration No. 2059462, issued May 6, 1997; Section 8 & 15 affidavits accepted and acknowledged; renewed. The status and title copy was furnished by the USPTO in June 2005, during petitioner's testimony period and prior to the renewal of the registration. We have confirmed that Office records reflect the renewal of the registration.

FN22. Registration No. 2478066, issued August 14, 2001; Section 8 & 15 affidavits accepted and acknowledged. The status and title copy was furnished by the USPTO in June 2005, during petitioner's testimony period and prior to the filing of the Section 8 and 15 affidavits. We have confirmed that Office records reflect the filing of these affidavits.

FN23. Registration No. 2561571, issued April 16, 2002.

FN24. In its brief respondent makes the comment that petitioner's registration for SPAM for screen savers is subject to cancellation because "Hormel's trademark claims relating to screen savers are purely defensive, and constitute nothing more than litigation strategy." p. 33. Because respondent did not bring a counterclaim to cancel petitioner's registration, we give no consideration to this attack.

FN25. We note, however, that many of the so-called "marks" that petitioner claims are not marks at all, but are merely terms used in petitioner's advertising or other promotional materials. See The Amazing SPAM Joke Book, by Kevin Kestner, which petitioner's in-house counsel pointed to as an example of SPAM-derivative marks which make up its family of marks. This book consists primarily of joke riddles which use variations of "Spam" in the answers, such as "Q: What is believed to be George Hormel's favorite breed of dog? A: The Cocker SPAMIEL."

FN26. Mr. Pogones, whose company operates the Spam Museum gift shop, testified that he also sold SPAM-licensed products “wholesale to different retailers in places that resell SPAM stuff themselves,” test., p. 15. However, the evidence regarding such sales is very limited, and does not indicate the items sold nor the extent of the sales. We have only the following testimony, pp. 15-16, from Mr. Pogones:

I guess there is companies across the country, different locations, Hawaii is really popular with SPAM, and there is companies in Hawaii that call us and they can order on a wholesale basis.... We sell the SPAM-branded merchandise to them and they resell it in their stores. There is also Mall of America, we sell a lot of SPAM stuff, too, there is a place in Alaska, smaller retailers, different places that resell it.”

This testimony is too vague for us to conclude that computer software designed to eliminate unsolicited commercial electronic mail and the unidentified SPAM-branded merchandise referred to in Mr. Pogones's testimony would be sold in the same stores.

FN27. A search for “spam” on the Wal-Mart website did not retrieve petitioner's meat product (Exhibit 194); the closest it came were some cookbooks featuring SPAM meat as an ingredient and a “biography” of SPAM; the same search on the Target website did not retrieve petitioner's meat product either, only the SPAM cookbook. It did, however, retrieve some third-party use of SPAM for a CD and DVD, namely, what appears to be a musical group called the Spam Allstars.

FN28. Apparently the portion of the survey designed to assess secondary meaning related to the originally pleaded ground that respondent's mark was merely descriptive or generic. That ground, as noted previously, has been waived by petitioner, and we make no comment as to the probative value of the survey as it might relate to that ground.

FN29. We discuss, in our analysis of the dilution ground, other problems with the survey.

FN30. We recognize that petitioner has made efforts to police its mark and has written cease and desist letters to many third parties about their use of SPAM in their trademarks. While such policing is commendable, and we are sympathetic to the fact that petitioner's resources do not permit it to take action against every party that uses SPAM in its trademark, the fact remains that in terms of public exposure, there are numerous marks in this field that contain the word “spam,” and therefore petitioner's mark SPAM is not a strong mark with respect to such goods and services.

FN31. Although the NASDAQ decision held evidence of actual dilution is not required in a Board case, respondent cites a Board decision marked “not citable as precedent” as stating that the NASDAQ decision did not address the question of whether actual dilution must be demonstrated where the defendant's mark is in use, as it is here. Even so, that decision did not state that, as respondent claims, actual dilution must be shown.

FN32. Mr. Carpenter also testified, based on the Mantis survey, that such damage had not yet occurred to petitioner's mark. In particular, it appears from Mr. Carpenter's testimony that he viewed the results of the survey as being representative of or projectible to all consumers. Because of the flaws in that survey, as discussed *infra*, we give no probative value to the conclusions Mr. Carpenter reached based solely on that survey.

FN33. As Ms. Knight noted, it is not clear how participants would interpret “computer software related to their use of the Internet.”

FN34. The survey report did not include the actual filled-out questionnaires, only typed answers that were grouped into tables. We have reproduced the response as listed in the report, including the punctuation provided

in the table.

#### CONCURRING OPINION

**\*25** Rogers

Administrative Trademark Judge

I firmly agree with the assessment of the majority but add a few observations about the Mantis survey.

As the Board stated in the Toro decision, for a famous mark to be vulnerable to dilution, it must be “so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner's goods or services, i.e., devoid of its trademark context.” In the case at hand, the word SPAM is devoid of its context as a trademark for plaintiff's goods when it is instead “spam,” i.e., the term for unwanted commercial email. Accordingly, the survey respondents should have been qualified as understanding that “spam” is unwanted commercial email. Then the survey questions would have ensured that respondents were individuals who understood the word “spam” devoid of its context as a trademark for plaintiff's goods.

In addition, not only did the Mantis survey fail to ensure that respondents understood the term “spam” in its generic context, but the conditions used to qualify respondents could very well have qualified individuals who were *not* purchasers, users, or prospective purchasers or users of defendant's products. This is because one *could* qualify as a survey respondent if, within the prior or next 60 days, one (1) had or was likely to send and receive email, (2) had purchased or was likely to purchase a canned meat product, and (3) had purchased or was likely to purchase software to protect data when using the Internet. On this last point of qualification, the respondent only had to have purchased or be likely to purchase software to protect data *or* filter email. And as the majority has observed, the stimulus card did not refer to email filtering software as the product associated with the mark SPAM ARREST.

Finally, by requiring survey respondents to have purchased or be likely to purchase a canned meat product, the survey likely skewed the results to favor collection of responses from individuals who would be more likely to draw an association with plaintiff. From the record it appears that plaintiff's canned meat products must be preeminent in their field. Thus, any purchaser or prospective purchaser of canned meat would be much more likely to be aware of plaintiff than individuals who were not purchasers or prospective purchasers of such products. By ensuring a group of survey respondents much more likely to be familiar with plaintiff, the survey increased the likelihood of associations with plaintiff among the respondents.

Plaintiff has conducted brand awareness surveys showing awareness of its mark and/or products even among individuals who do not purchase or use the products. Evidence of an association of the generic term “spam” with plaintiff among survey respondents qualified as understanding the meaning of the generic term and who were not purchasers or users of plaintiff's products would have been powerful evidence; but it was not the type of evidence provided in this case.

2007 WL 4287254 (Trademark Tr. & App. Bd.)  
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# **EXHIBIT 4**

# **EXHIBIT 4**

2006 WL 478990 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

IN RE TOY CONCEPTS

Serial No. 76326801

February 15, 2006

Myron Amer of Myron Amer, P.C. for Toy Concepts

Janice L. McMorrow, Trademark Examining Attorney  
Law Office 115  
(Tomas V. Vlcek, Managing Attorney)

Before Seeherman, Bucher and Holtzman  
Administrative Trademark Judges  
Opinion by Holtzman  
Administrative Trademark Judge:

An application has been filed by Toy Concepts (applicant) to register the mark SPLASHER-BLASTER for “water toys, namely, water guns” in International Class 28.<sup>[FN1]</sup>

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's goods, so resembles the registered mark SPLASH N' BLAST! for “toys, namely inflatable toys for use in the water” in International Class 28 as to be likely to cause confusion.<sup>[FN2]</sup>

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was not requested.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, including the similarities of the marks and the similarities of the goods. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to the goods. Relying on a definition of “inflate” as meaning “to expand or distend with air,” applicant argues that its water guns would typically be made of metal or rigid plastic and as such would not be an inflatable toy. Applicant maintains that although applicant's and registrant's toys may be sold in the same stores, purchasers would be aware by the diverse nature of the goods that a different manufacturer makes each, and they would not believe that these diverse goods emanate from the same source.

Applicant's and registrant's toys may be specifically different. However, the question is not whether purchasers

can differentiate the goods, but rather whether purchasers are likely to confuse the source of the goods. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Thus, it is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

Applicant's "water toys, namely, water guns" and registrant's "toys, namely inflatable toys for use in the water" are, on their face, related goods. Both products are toys that are intended for use in a swimming pool or other water environment. Moreover, as the examining attorney's evidence shows, these toys may be, and often are, used together for the same play activity in the water. The examining attorney has submitted printouts from on-line stores (e.g., *pooltoy.com* and *matteroffun.com*) located on the eBay website, showing that water toys, such as inflatable rafts and tubes, are sold together with toy guns that squirt water.<sup>[FN3]</sup> In addition, and as applicant recognizes, these toys would be sold in the same channels of trade, including all the usual retail outlets for toys, to the same ordinary consumers. Furthermore, such purchasers, particularly considering the inexpensive nature of these toys, would not be expected to exercise a high degree of care and thus would be more prone to confusion.

\*2 Applicant argues that it is not specified in the identification of goods that its water guns would necessarily be used in a swimming pool or other water environment. However, applicant has described its goods as "water toys" and, in any event, it is entirely reasonable to assume that toy water guns could be used in the water as well as on land. In addition, the Internet evidence submitted by the examining attorney shows that these types of toys are indeed used in water.

It is clear that despite the differences in the goods, these toys, if sold under similar marks, would be perceived by consumers as emanating from the same source.

We turn then to the marks. Applicant essentially argues that the differences in the marks, in particular, the addition of the suffix ER and "deletion" of the N' in applicant's mark are sufficient to distinguish one mark from the other. Noting that the N' in registrant's mark is short for the word "and," applicant argues that registrant's mark "connotes two activities, namely to splash and to blast" whereas in applicant's mark, the dash "joins the two words into one occurrence" that would be associated with a water gun, not an inflatable toy. Reply Brief, p. 2.

When the marks are examined in detail on a side-by-side basis, the differences in the marks may be discerned. However, a side-by-side comparison is not the test. In the normal marketing environment, purchasers would not usually have an opportunity to examine the details of the respective marks. Furthermore, the average purchaser is not infallible in his recollection of trademarks and often retains only a general overall impression of marks that he may previously have seen in the marketplace. In *re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988). Thus, it is the overall impression of the marks derived from viewing the marks in their entirety that is controlling. See *Dan Robbins & Associates, Inc. v. Questor Corporation*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979). See also *E.I. Du Pont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F.Supp. 502, 185 USPQ 597, 603 (EDNY 1975) (overly analytical approach with close attention to specific differences is less important than the overall impression of general similarity.)

We find that when applicant's mark SPLASHER-BLASTER and registrant's mark SPLASH N' BLAST! are properly considered in their entirety and as they would be encountered in the marketplace, the similarities in

sound, appearance, meaning and overall commercial impression far outweigh their differences.<sup>[FN4]</sup>

The core elements of applicant's and registrant's marks are the same. Both marks consist essentially of two words SPLASH and BLAST. Furthermore, the two words appear in the same order in both marks. As a result, applicant's and registrant's marks look similar and sound similar, with insufficient differences to distinguish them. The 'N' in registrant's mark would not be given any emphasis, and the exclamation point and hyphen are not in themselves visually memorable. Moreover, there is nothing unusual about adding "er" to the end of a word, and this suffix added to SPLASH and BLAST does not significantly alter the appearance of the basic words or the sound of those words when they are spoken.

\*3 Further, in relation to the respective goods, the two marks have similar meanings and create similar overall impressions. Both marks suggest the play activity of "splashing" and "blasting" others with water. While applicant's mark may relate more directly to the device itself, a toy water gun, it is the general nature of the activity suggested by these marks that purchasers are likely to remember when seeing the marks at separate times on these closely related goods, not the specific differences in meaning.

We find that purchasers who are familiar with registrant's SPLASH N' BLAST! inflatable water toys would be likely to believe, upon encountering applicant's mark SPLASHER-BLASTER for closely related toy water guns, that both toys originated with or are somehow associated with or sponsored by the same entity.

**Decision:** The refusal to register under Section 2(d) of the Trademark Act is affirmed.

FN1. Application Serial No. 76569020, filed March 14, 2005, based on an allegation of a bona fide intention to use the mark in commerce.

FN2. Registration No. 2480633, issued August 21, 2001.

FN3. Applicant's objections to the examining attorney's evidence are noted. While it certainly would have been the better practice for the examining attorney to have highlighted or marked the relevant information in these Internet printouts, we will not, as applicant requests, refuse to consider the evidence on this basis. Applicant's contention that the examining attorney's evidence is untimely because it was submitted for the first time with her final refusal is utterly meritless. At any time during the six month period between the final refusal and the time for appeal, applicant could have responded to the examining attorney's evidence with arguments and/or evidence of its own. See TMEP section 715.03. Applicant chose not to do so.

FN4. Contrary to applicant's contention, there has been no change in the examining attorney's "legal position" regarding the similarities of the marks. Her position was, and still is, that the marks are similar. The examining attorney is not precluded from raising, during prosecution or on appeal, new or different arguments for her position that the marks are similar. What is more, the Board is not bound by the examining attorney's rationale for the refusal but may affirm based on a different rationale. See TBMP §1217.

2006 WL 478990 (Trademark Tr. & App. Bd.)  
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# **EXHIBIT 5**

# **EXHIBIT 5**

2007 WL 4616268 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

NAUTICA APPAREL, INC  
v.  
BRIAN CARLUCCI

OPPOSITION 91165909 TO APPLICATION SERIAL 75695360 FILED ON MAY 25, 1999

December 18, 2007

Stephen L. Baker of Baker and Rannells, PA for Nautica Apparel, Inc.

Lori M. Stockton of Blakely, Sokoloff, Taylor & Zafman, LLP for Brian Carlucci

Before Hairston, Bucher and Bergsman  
Administrative Trademark Judges  
Opinion by Bergsman  
Administrative Trademark Judge:

On May 29, 1999, Brian Carlucci filed an intent-to-use application (Serial No. 75695360) to register the mark NAUTIGIRL, in standard character format, for goods ultimately identified as follows:

Spectacles and their parts and accessories, namely replacement eyeglass lenses, eyeglass frames, eyeglass earstems, eyeglass nose pieces and foam strips; sunglasses; eyeglass and sunglass cases specially adapted for protective and/or anti-glare eyewear and parts therefore; protective or safety helmets for skiing, snowboarding, and bicycling; diving suits and diving gloves, in class 9; and,

Wet suits for water skiing, sailing, windsurfing, surfing, kayaking, canoeing, and personal watercrafting, jogging suits for triathlons, water resistant jackets and pants for water skiing, sailing, windsurfing, surfing, kayaking, canoeing, and personal watercrafting, thermal underwear, water sport boots, gloves, water sport headwear, namely caps and hoods; men's, women's and children's clothing, namely hats, baseball caps, visors, t-shirts, pajamas, bathing suits, sweatshirts, sweat pants, tank tops, gaiters, shorts, pants, jackets, dresses, sweaters, gloves, belts for clothing, shoes, athletic shoes, sandals, boots, beach footwear, and ski and snowboard clothing, namely ski pants, ski jackets, ski bibs, ski gloves and ski masks, in Class 25.

Nautica Apparel, Inc. opposed the registration of applicant's mark on the grounds of priority of use and likelihood of confusion and dilution. Opposer claimed ownership of thirty-seven (37) federally-registered trademarks for NAUTICA or variations thereof. The most relevant registrations are set forth below:

1. Registration No. 1464663 for the mark NAUTICA, in standard character format, for "hosiery, shoes, undershirts, undershorts, shirts, blouses, trousers, jackets, pants, coats, suits, bathing suits, bathrobes, slippers and shorts," in Class 25;

[FN1]

2. Registration No. 1553539 for the mark NAUTICA, shown below, for “spectacles, namely eyeglasses and sunglasses, and accessories, namely cases and straps,” in Class 9;<sup>[FN2]</sup> and,

nautica

3. Registration No. 3168753 for the mark NAUTICAKIDS, in standard character format, for “coats; dresses; footwear; gloves; headwear; jackets; jeans; pajamas; pants' raincoats; robes; scarves; shirts; shorts; skirts; sweaters; swimsuits; t-shirts; trousers; underwear; vests,” in Class 25.<sup>[FN3]</sup>

\*2 Although not pleaded in the Notice of opposition, during the prosecution of the opposition, opposer also claimed prior use of the mark NAUTICA GIRL on girls' clothing.

#### Evidentiary Issues

##### A. Opposer's “Family” of “Nautica” Marks.

In its brief, opposer asserts for the first time that it has a family of marks:

Considering the parties' respective marks in their entirety, NAUTIGIRL is practically indistinguishable in look, sound, meaning, and/or commercial impression from Nautica's NAUTICA GIRLS mark and is similar to all of opposer's NAUTICA Family of Marks, especially on goods directed to women or girls. Applicant's mark leaves the impression of a “Nautica” line of clothing and eyewear targeted to women/girls.<sup>[FN4]</sup>

The Court of Appeals for the Federal Circuit has defined a family of trademarks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. ... Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

*J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

In order to create the requisite recognition of the common element of the marks or “family surname,” the common element must be so extensively advertised that the public recognizes the “family surname” as a trademark. *Reynolds & Reynolds Co. v. I.E. Systems, Inc.*, 5 USPQ2d 149, 1751 (TTAB 1987). The Board has made the following requirements:

In order to establish a “family of marks,” it must be demonstrated that the marks asserted to comprise its “family” or a number of them have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.

*American Standard Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978). In the absence of direct testimony by purchasers, we must place ourselves in the position of average consumers and attempt to understand their reaction to the marks as they are encountered in the marketplace. *Id.* In this regard, the mere fact that opposer has registered many of the

purported “family” members is not sufficient to prove that a family of marks exists. *Consolidated Foods Corp. v. Sherwood Industries, Inc.*, 177 USPQ 279, 282 (1973)(“the registrations, per se, are manifestly incompetent to establish the extent of use of the registered marks, whether one or more of the registered marks have been promoted, advertised, used or displayed in any manner likely to cause an association or ‘family’ of marks, or that, at the least, a good number of the registrations have become known or familiar of frozen confections and the like”).

\*3 Opposer's evidence fails to establish that opposer has created a family of “Nautica” marks. First, the evidence does not show that the different “Nautica” marks have been promoted, advertised, used or displayed together in any manner likely to cause an association among the marks or that there is a “family” of marks. Second, the record is silent as to the extent of any advertising of the different marks. Therefore, the record in this case falls short of presenting the type of evidence necessary to support an allegation of a “family” of “Nautica” trademarks. Accordingly, opposers' claim of likelihood of confusion must be based solely on its use of its individual “Nautica” trademarks.

#### B. Opposer's Objections to Applicant's Notices of Reliance.

##### 1. Applicant's second notice of reliance.

Applicant filed a notice of reliance on printouts of articles retrieved from the LexisNexis database that reference Nautilus, Inc. According to applicant, “Each of the excerpts are relevant to the continued use of the mark NAUTILUS, to the weakness and dilution of Opposer's mark, to the differences in the parties' respective marks, the fact that opposer does not own the exclusive right to all uses of marks containing the prefix ‘NAUTI,’ and other Dupont factors.” Opposer objected to the LexisNexis articles referencing Nautilus, Inc. to show use of the NAUTILUS trademark as constituting hearsay.

The newspaper articles are admissible and probative only for what they show on their face, not for the truth of the matters contained therein. TBMP §704.08 (2<sup>nd</sup> ed. rev. 2004).

While excerpts from newspapers are properly made of record by notice of reliance, such excerpts do not establish the truth of the statements contained therein. Rather, newspaper excerpts, considered in the context of the record and the issues in this case, are evidence only of the manner in which the term is used therein and of the fact that the public has been exposed to the articles and may be aware of the information contained therein.

*Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1721 n.52 (TTAB 1999). *See also Otis Elevator Co. v. Echlin Mfg. Co.*, 187 USPQ 310, 312 n.4 (TTAB 1975) (newspaper articles are admissible to show that opposer's mark was the subject of an article that appeared in newspapers and magazines); *Exxon Corp. v. Fill-R-Up Systems, Inc.*, 182 USPQ 443, 445 (TTAB 1974) (newspaper articles introduced by a notice of reliance are admissible to show that the articles appeared in the respective newspapers or magazines, on a specific date, and referenced applicant or its mark). Accordingly, we have considered the articles in applicant's second notice of reliance only for establishing that Nautilus, Inc. or the NAUTILUS trademark was referenced in an article, the manner in which it was used, and that the public may have been exposed to the terms and, therefore, may be aware of the information in the articles.<sup>[FN3]</sup>

##### 2. Applicant's third and fourth notices of reliance.

\*4 Applicant filed notices of reliance on printouts of news articles retrieved from the LexisNexis database that reference the term “nautical clothing.” According to applicant, “Each of the excerpts are relevant as to the generic nature of Opposer's marks, to the weakness of Opposer's marks, to the differences in the parties' respective marks, and other Dupont factors.” Opposer objects to these notices of reliance to the extent that applicant is attacking the validity of its registrations on the ground that NAUTICA is generic for a type of clothing without having filed counterclaims for cancellation.

To the extent that applicant is asserting that “Nautica” means “nautical clothing,” and is therefore a generic term, such an



attack is impermissible in the absence of counterclaims to cancel opposer's pleaded registrations. However, it is clear that applicant is not attempting to attack opposer's registrations. Thus, we regard applicant's arguments as going only to the scope of protection to be accorded opposer's NAUTICA trademarks in terms of determining whether there is a likelihood of confusion between the marks NAUTICA and NAUTIGIRL when applied to their respective goods.

#### The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark. The record also includes the following testimony and evidence:

##### A. Opposer's evidence.

1. The testimony deposition of Margaret Bizarri, the trademark manager of the legal department of VF Sportswear, Inc., the parent company of opposer, with attached exhibits;
2. Notices of reliance on certified copies of opposer's pleaded registrations for the mark NAUTICA and variations thereof for clothing, spectacles, and other goods and services showing that the title to the registrations is in opposer's name and that the registrations are subsisting;
3. Notices of reliance on articles from publications retrieved from the LexisNexis database referencing opposer and its NAUTICA trademarks; and,
4. Notice of reliance on printouts from the TTABVUE database to show that opposer filed petitions to cancel Registration No. 1641348 for the mark FASHION NAUTIQUE (Cancellation No. 92046670) and Registration No. 1478791 for the mark SKI NAUTIQUE (Cancellation No. 92046665).

##### B. Applicant's evidence.

1. Notice of reliance on certified copies showing status and title of ten (10) third-party registrations for marks beginning with "Nauti" in Class 25 and one third-party registration for a mark beginning with "Naut" in Classes 9 and 25;
2. Notice of reliance on printouts of articles retrieved from the LexisNexis database that reference Nautilus, Inc.; and,
3. Notices of reliance on printouts of news articles retrieved from the LexisNexis database that reference the term "nautical clothing."

#### Standing

\*5 Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

#### Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

However, with respect to opposer's claim of prior use of the mark NAUTICA GIRL for girls' clothing, because opposer does not own a registration for that mark, opposer must prove its first use of NAUTICA GIRL. For purposes of establishing priority, opposer must show that it used its NAUTICA GIRL trademark prior to May 25, 1999, the filing date of ap-

plicant's application. In an opposition, applicant may rely on the filing date of his application. *Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974); *Intersat Corp. v. Int'l Telecomm Satellite Org.*, 226 USPQ 154, 156 n.5 (TTAB 1985).

Opposer based its claim of prior use solely on the testimony of Margaret Bizarri, opposer's trademark paralegal. Ms. Bizarri testified that opposer had been using NAUTICA GIRL on clothing since July 1994.<sup>[FN6]</sup> However, Ms. Bizarri is not involved in the marketing or sales of opposer's products. Ms. Bizarri is responsible for trademark application filings, searches, post registration filings, and reviewing sponsorship agreements, licenses, color boards, and advertising.<sup>[FN7]</sup> Moreover, because Ms. Bizarri started working for opposer in March 2001,<sup>[FN8]</sup> her testimony regarding opposer's first use of the mark NAUTICA GIRL is not based on first-hand knowledge, but upon a review of company records. In that regard, Ms. Bizarri testified that she maintains copies of all the advertisements and all the color boards from opposer's inception to the present.<sup>[FN9]</sup> In preparing for her deposition, she reviewed the color boards from 1991 through the present and compiled a representative sample to introduce into evidence.<sup>[FN10]</sup> Despite the facts that color boards are created seasonally and that she reviewed all of the color boards and compiled a representative sample in preparation for her deposition, she was unable to document any use of the mark NAUTICA GIRL prior to 2005.<sup>[FN11]</sup>

Q. And in any documents that you reviewed and presented here today, do any of those demonstrate that the mark [NAUTICA GIRL] was being used back as early as July of 1994?

A. No.<sup>[FN12]</sup>

Moreover, Ms. Bizarri could not confirm that opposer had continuously used the mark NAUTICA GIRL.

Q. Did your company ever stop using Nautica Girl at any point for any period of time after July of 1994?

\*6 A. I don't know the answer to that.<sup>[FN13]</sup>

Nor could she provide the revenues relating to sales of NAUTICA GIRL products.

Q. Are you aware of your company's sales volume of products bearing the Nautica Girl term?

A. No. I don't - - if you mean individually, no.

Q. With respect to products bearing that term.

A. No.<sup>[FN14]</sup>

In view of the foregoing, we are not persuaded that opposer has made either prior or continuous use of NAUTICA GIRL. Accordingly, opposer's claim of likelihood of confusion must be based solely on its NAUTICA trademark registrations.

#### Likelihood Of Confusion

Our determination of likelihood of confusion under Section 2(d) of the Lanham Act is based on an analysis of all the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are discussed below.

##### A. Fame

We turn first to the factor of fame, because this factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Id.* A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

In determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002);

*Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1817 (TTAB 2005). This information, however, must be placed in context (e.g., a comparison of advertising figures with competitive products, market share, reputation of the product, etc.). *Bose Corp. v. QSC Audio Products Inc.*, *supra*.

We note that fame for likelihood of confusion purposes and for dilution are not the same, and that fame for dilution purposes requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, *supra*; *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Likelihood of confusion fame “varies along a spectrum from very strong to very weak” while dilution fame is an either/or proposition — sufficient fame for dilution either exists or does not exist. *Id.* See also *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 (TTAB 2005)(likelihood of confusion “Fame is relative ... not absolute”). A mark, therefore, may have acquired sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame. *Toro Co. v. ToroHead Inc.*, *supra*, citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225, 1239 (1<sup>st</sup> Cir. 1998)(“[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection”). In order to help keep the concepts of likelihood of confusion fame and dilution fame distinct, we will refer to “public recognition and renown” when referring to likelihood of confusion fame. *Toro Co. v. ToroHead Inc.*, *supra*.

\*7 The evidence of public recognition and renown consists of the following testimony and evidence:

1. Opposer began using its NAUTICA trademark for clothing in 1983;<sup>[FN15]</sup>
2. Opposer began using its NAUTICA trademark for eyeglasses in 1987;<sup>[FN16]</sup>
3. Opposer advertises its products through sponsorship agreements, television advertising, billboards, store fliers, company mailers, and through the Internet;<sup>[FN17]</sup>
4. Opposer has sponsored numerous and varied events, including triathlons, volleyball tournaments, and sailing events. At these events, opposer displays the NAUTICA trademark on signage at the events on tents, flags, uniforms, and equipment;<sup>[FN18]</sup>
5. Between 2000-2005, opposer averaged \$28 to \$29 million annually in advertising and promotional expenses in the United States;<sup>[FN19]</sup>
6. Between 2000-2005, opposer's annual wholesale sales in the United States averaged approximately \$1 billion;<sup>[FN20]</sup>
7. Opposer sells its products through retail stores such as Lord & Taylor, Macys, and Bloomingdales and through the Internet by Amazon.com;<sup>[FN21]</sup>
8. Opposer licenses retailers such as Linens-N-Things and Bed, Bath & Beyond to sell NAUTICA products;<sup>[FN22]</sup>
9. Opposer has between 135-140 freestanding NAUTICA retail stores in the United States, and eight (8) NAUTICA KIDS retail stores in the United States;<sup>[FN23]</sup>
10. Opposer has received substantial media attention referencing the NAUTICA trademark. A sampling of the articles referencing opposer include the following:  
 Repp Premier Big & Tall, a new chain of stores across the country, features lines from top American designers, such as Ralph Lauren and Nautica's David Chu, who've discovered big and tall guys have money, too.  
*The Boston Herald* (December 9, 1999).

Fortunately for OP [Ocean Pacific] and other image-based brands, Baker says, "the major power brands - - Tommy, Ralph and Nautica - - have begun to give licensing a whole new arena to play in because it's become for them a new opportunity for brand extension and revenue growth."

\*\*\*

"Our goal as a branded company is to run the business like these power brands [Tommy, Ralph and Nautica] are run, by controlling the marketing, advertising, design and branding for the licensee," reveals Baker.

*Children's Business* (August 1, 1999).

David Chu hasn't reached the single-name recognition of a Ralph, Calvin or Tommy. But the designer behind the mega-successful and popular Nautica line continues to impress onlookers.

*Columbus Dispatch* (February 16, 1999).

For today's teen-ager (sic), style means never wearing anything that looks like it fits just right or like something your parents or older sibling might have worn. "In" are oversized fleece pullovers, nylon windbreakers in black or some flashy color, and anything with the words Nike, Polo, Nautica, Structure or Tommy Hilfiger emblazoned on it."

\*8 *Portland Press Herald* (March 22, 1999).

"This is an ultra-modern Belk store," said store manager, Kenneth Jarman, listing famous names such as Nautica and Chaps, Tommy Hilfiger, Liz Claiborne and Jantzen.

*The Virginian-Pilot* (June 21, 1998).

Meanwhile, at NationsBanc Montgomery Securities, Susan B. Silverstein has been touting what she calls "Men's Wear's Triple Crown": Tommy Hilfiger, Nautica Enterprises and Polo Ralph Lauren. The trio's consistently good-looking product backed by strong advertising has driven sell-throughs at a high rate, she said, thus allowing them to maintain beefy margins.

*WWD* (May 14, 1998).

Top companies such as Polo Nautica, Tommy Hilfiger and Polo Ralph Lauren will continue to shine, providing the cachet of well-known brands combined with quality merchandise, according to the Street.

*Daily News Record* (August 29, 1997).

Millershor, whose dresses sell for between \$200 and \$350, is angling to open in-store boutiques throughout its network of more than 2,000 department store locations. This merchandising technique-made famous by powerful sportswear brands such as Nautica, Tommy Hilfiger and Donna Karan — is practically unheard of in the dress business.

*Crain's New York Business* (May 5, 1997).

The turnaround has been accomplished by shutting down low-profit departments such as home electronics, stocking individual stores with merchandise that reflects local community tastes and playing up megabrands such as Ralph Lauren and Nautica as well as The Bon's own private labels.

*The Seattle Times* (March 13, 1997).

Tony Baptista, 17, of Boston stressed the importance of labels when it comes to donning the best duds.

"Strictly Nikes, Nautica shirts, Levis or Ralph Lauren jeans," he said. "And a leather coat. You gotta get the letha."

*The Boston Herald* (September 8, 1996).

Consistent with the task at hand, the inaugural issue achieved its most striking effects with the advertising, 175 pages of stylish photographs representing all the great and glorious names in the retail merchants' Hall of Fame, not only Armani and Ferragamo but also Tommy Hilfiger, Clinique, Ralph Lauren, Versace, Piaget, Nautica, Valentino, and Donna Karan — the immortals bringing the gifts of the Magi to a cradle of democracy.

*Harper's Magazine* (November 1995).

On a recent visit, a group of older, black, male students, who were gathered in the gym, stood out in their up-

scale, preppy attire. Tailored shirts in richly colored stripes and plaids were tucked neatly into chinos and Dock-er pants.

Labels with cachet — Tommy Hilfiger, Nautica, Polo, and Roundtree and Yorke — are considered essential among this crowd.

*The Commercial Appeal* (October 1, 1995).

Nautica International, a leading men's-wear company, has joined forces with Sailing World magazine in Newport as national sponsors of the regatta series, and ESPN commentator Gary Jobson, best known for his America's Cup broadcasts from Australia and San Diego, is the national spokesperson.

\*9 *Providence Journal-Bulletin* (August 13, 1995).

Younkers has the dominant market share in most if (sic) its 54 locations, competing against the likes of WalMart and Dillard as well as J.C. Penney and Sears. The company carries tried-and-true labels such as Liz Claiborne, Carol Little, Tommy Hilfiger, Ralph Lauren and Nautica, but nearly 20% of its apparel carries store labels.

*Forbes* (July 19, 1993).

"This could be her [Donna Karan] big breakthrough," said retail industry consultant Alan Millstein. "This could put her in the big leagues with Ralph Lauren, Tommy Hilfiger and Nautica. Only one other American designer has ever successfully produced both a men's and women's line, and that was Ralph Lauren. This is her ticket to the hundred-million-dollar club."

*The Atlanta Journal and Constitution* (March 21, 1993).

The clothing makers are hearing from women and men, in their 20's, 30's, 40's and beyond who are asking for good-looking, casual clothes. Cases in point are Ralph Lauren's Polo and Donna Karan's DKNY, as are the ubiquitous Nautica and Tommy Hilfiger lines. All four collections of sporty denims, tweeds, parkas and handknit-looking sweaters are so popular with retailers and customers that they take up a good deal of the selling-floor space in area department stores.

*St. Louis Post-Dispatch* (October 18, 1992).

Downtown's Warehouse Row, eight handsomely renovated turn-of-the-century railroad warehouse buildings, has 30 factory outlet shops selling the names you know, including Albert Nippon, Perry Ellis, Ralph Lauren, Adrienne Vittadini, Bass, J. Crew, Nautica, and Johnston & Murphy.

*The Atlanta Journal and Constitution* (April 29, 1992).

On the other hand, opposer's testimony and evidence regarding its sales revenues and advertising lack context. For ex- ample:

1. Opposer has not provided any information regarding its market share;
2. Opposer has not provided any information regarding the identity of the television shows and television networks on which it advertises (e.g., nationally broadcast television shows on major networks versus specialty shows or local shows on cable networks);
3. Opposer has not provided any information regarding the identity of the newspapers and magazines where it places its print advertising;
4. Opposer has not provided any information regarding how many people visit its Internet site; and,
5. Opposer has not provided any information regarding how many people participated in and attended its numerous and varied sponsored events, including triathlons, volleyball tournaments, and sailing events.

Nevertheless, in view of opposer's long use of its NAUTICA mark in connection with clothing and spectacles, its extens-

ive sales and advertising expenditures, as well as the unsolicited media attention it has received, we find that opposer's mark has a high degree of public recognition and renown. In particular, with respect to the unsolicited media attention, Opposer's NAUTICA mark is listed in the same context as many other well-known clothing trademarks (e.g., Donna Karan, Ralph Lauren, and Tommy Hilfiger), and the NAUTICA line of products is described as "ubiquitous," "names you know," "big leagues," "tried-and-true labels," "labels with cachet," "Hall of Fame," and "megabrand."

**\*10** In view of the foregoing, the fame (or public recognition and renown) of the NAUTICA trademark is a factor that favors finding that there is a likelihood of confusion.

**B. The similarity or dissimilarity and nature of the goods.**

Applicant is seeking to register its mark for a variety of products in Classes 9 and 25, including spectacles and eyeglass cases (Class 9) and clothing, namely, athletic shoes, sandals, boots, beach footwear, t-shirts, shorts, pants, bathing suits (Class 25). Opposer has registered the NAUTICA trademark for spectacles and cases (Class 9) and clothing, namely, shoes, shirts, pants, shorts, and bathing suits (Class 25). Although the description of goods in the application and opposer's registrations are not identical, many of the products listed therein are the same. The fact that some of the applicant's goods are either identical or closely related to opposer's goods is sufficient to support a finding of likelihood of confusion. *Tuxedo Monopoly, Inc. v. General Mills Fund Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application). The fact that the description of goods in the application and opposer's registrations include other items that may not be related does not obviate the relatedness of the identical products. *Id.*

**C. The similarity or dissimilarity of likely-to-continue trade channels.**

Because the goods are in part identical, we must presume that the channels of trade and purchasers would be the same. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

**D. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.**

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, *supra*. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). See also, *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the goods are in-part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

**\*11** In addition, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the

recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Opposer argues that applicant's mark NAUTIGIRL is similar to its NAUTICA and NAUTICAKIDS marks for the following reasons:

1. Applicant's mark and opposer's marks share the prefix "Nauti";
2. The prefix "Nauti" is the dominant portion of applicant's mark because the suffix "girl" is descriptive;<sup>[FN24]</sup> and,
3. Consumers encountering applicant's NAUTIGIRL mark will believe that it is part of opposer's well-known NAUTICA line of clothing and eyewear.

On the other hand, applicant contends that its mark NAUTIGIRL does not resemble opposer's NAUTICA marks for the following reasons:

1. Opposer's mark conveys the commercial impression of something nautical. In fact, opposer's registrations include a statement that the word "Nautica" means "nautical";
2. Opposer's mark is inherently weak, and therefore entitled to only a narrow scope of protection or exclusivity of use because the word "Nautica" means "nautical," and "nautical clothing" is a recognized type of clothing; and,
3. The prefix "nauti" in applicant's mark is a fanciful abbreviation for the word "naughty," and when combined with the suffix "girl" conveys the commercial impression of a naughty girl.

However, contrary to the preceding argument in Applicant's Trial Brief (No. 3 *supra*), during the prosecution of its application, applicant argued that the commercial impression engendered by its mark NAUTIGIRL pertains to something nautical, not a naughty girl.

Contrary to the Examining Attorney's assertion, NAUGHTY GIRL! and NAUTIGIRL create an entirely different commercial impression.<sup>[FN25]</sup> The commercial impression created by the mark NAUGHTY GIRL! as applied to brassieres and bikini panties is clearly one of bad or immodest or illicit behavior, or behavior otherwise lacking in propriety ...

\*\*\*

The mark NAUTIGIRL creates an entirely different commercial impression as a result of the spelling of the mark and the clothing on which the mark is used. "Nauti" as opposed to "Naughty" creates the commercial impression of pertaining to ships or the water. "Nauti" is the root of the words "nautical," which pertains to ships and navigation, and "nautilus," which is a genus of marine animal.

\*12 Further, the clothing and apparel covered in the application are clothing for water sports, other sports, and beachwear (i.e., shorts, t-shirts, swimwear). Applied to these goods, the commercial impression created by the mark NAUTIGIRL is clearly that it is nautical related clothing for girls.<sup>[FN26]</sup>

The file of an application involved in an opposition forms part of the record without any action by the parties, and the parties may make reference to the file for any relevant and competent purpose. Trademark Rule 2.122(b)(1), 37 CFR §2.122(b)(1). Allegations made by the applicant during the prosecution of its application may be used by the opposer as evidence against the applicant as an admission against interest. *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981). See also *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281,

1283 (Fed. Cir. 1984), *quoting Interstate Brands Co. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (applicant's earlier contrary position before the Examining Attorney as to the meaning of its mark illustrates the variety of meanings that may be attributed to, and commercial impression projected by, applicant's mark).

We accept applicant's contention made during the prosecution of its application that the mark NAUTIGIRL conveys the commercial impression of nautical or water related clothing for girls.<sup>[FN27]</sup> In fact, some of applicant's goods are specifically water related (*i.e.*, diving suits and diving gloves, wet suits, water resistant jackets and pants for water skiing, sailing, windsurfing, surfing, kayaking, canoeing, and personal watercrafting, water sport boots, water sport headwear, namely caps and hoods, bathing suits, and beach footwear). Likewise, opposer's NAUTICA marks convey the commercial impression of nautical or water related products. Opposer has translated the word "Nautica" into English as "nautical."

Opposer's NAUTICA marks and applicant's NAUTIGIRL mark are similar in appearance and sound because they share the "nauti" prefix. Opposer's NAUTICAKIDS mark shares the same structure as applicant's NAUTIGIRL mark: both marks have the "nauti" prefix followed by a suffix describing the users of the products (*i.e.*, kids or girls). Thus, some consumers may mistakenly believe that NAUTIGIRL clothing is an expansion of the NAUTICAKIDS clothing line.

While there are obvious differences between opposer's marks and applicant's mark, we find that the similarities outweigh the differences, especially because opposer's marks have a high degree of public recognition and renown. In view of the foregoing, the similarity of the marks is a factor that favors finding that there is a likelihood of confusion.

#### E. The strength of opposer's mark.

\*13 Applicant introduced the following 11 third-party registrations owned by six (6) entities with a "Naut" or "Nauti" prefix for clothing products.<sup>[FN28]</sup>

#### Nautilus, Inc.

Mark	Registration No.	Goods
NAUTILUS	1086063	Hats
NAUTILUS	1084853	T-shirts and sports shirts
NAUTILUS	1391673	Shoes and athletic footwear
NAUTILUS	2970870	A wide variety of clothing

#### Correct Craft, Inc.<sup>[FN29]</sup>

Mark	Registration No.	Goods
SKI NAUTIQUE	1478791	Shirts, shorts, caps, hats, visors, sweat shirts, sweat pants and jackets
FASHION NAUTIQUE	1641348	Clothing, namely, shirts, jackets, pants, swimwear, and caps

#### Scott Hartley

Mark	Registration No.	Goods
THE NAUTI DOLPHIN	2313902	Hats and shirts (and restaurant services)



THE NAUTI DOLPHIN and Design

2318607

Hats and shirts (and restaurant services)

## Miscellaneous Entities

Mark	Registration No.	Goods
NAUTICUS	2124601	Clothing, namely, t-shirts, sweat shirts and hats sold at the National Maritime Center
NAUT-ON-CALL	2556304	Shorts, pants, shirts, shoes and hats
NAUTICAL LIVING	2744158	T-shirts, headbands, sweatshirts, pants, coats, jackets, hats, visors, belts, sweaters, neckerchiefs, socks

\*14 While the third-party registrations do not establish the use of the registered marks, that the registered marks are known to the public, or that the public is conditioned to reacting to portions of the marks, they may be used to show that the mark, or a portion of the mark has a specific meaning and that the mark has been adopted and registered to reflect that meaning. *Marcal Paper Mills, Inc. v. American Can Co.*, 212 UAPQ 852, 863 (TTAB 1981). In this case, applicant is using the third-party registrations to show that the marks have been adopted and registered to suggest that the terms “naut” and “nauti” convey the commercial impression of “nautical clothing.”

In this regard, applicant also introduced numerous LexisNexis database articles referencing the term “nautical clothing” for the purpose of showing that “nautical clothing” is recognized as a type of clothing. Because opposer's NAUTICA marks mean “nautical,” opposer contends that the NAUTICA marks are inherently weak marks and are limited to a narrow scope of protection or exclusivity of use.

Under different circumstances, the third-party registrations and news articles might be sufficient to show that a “naut” or “nauti ” prefix conveys a commercial impression engendering “nautical clothing” and, therefore, preclude a finding of likelihood of confusion. However, in view of the public recognition and renown of the NAUTICA marks, opposer's marketplace strength of its NAUTICA marks outweighs any inherent weakness in opposer's marks created by the translation of “Nautica” as “nautical.”

Applicant introduced numerous articles retrieved from the LexisNexis database referencing Nautilus, Inc., the owner of the NAUTILUS trademark registrations listed above for the purpose of showing that opposer does not own the exclusive right to use marks with the “Nauti” prefix. However, these articles do not support applicant's premise. The relevant articles reported that Nautilus was launching a fitness apparel line called RESPONSIV<sup>[FN30]</sup> and that the Nautilus fitness apparel business would feature the Pearl Izumi brand.<sup>[FN31]</sup> While a few articles reported that the Nautilus fitness apparel business would feature both the Pearl Izumi and Nautilus brands,<sup>[FN32]</sup> there were no articles that reported on Nautilus brand clothing and the impact that the product has made in the market. It is not even clear whether Nautilus has, in fact, launched a line of NAUTILUS clothing.

Finally, even were we to concede that “Nauti” marks are weak, it has been said that likelihood of confusion “is to be avoided, as much between ‘weak’ marks as between ‘strong’ marks.” *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974). *See also, Matsushita Electric Industrial Co., Ltd. v. National Steel Construction Co.*, 442 F.2d 1383, 170 USPQ 98 (CCPA 1971); *King Kup Candies Inc. v. King Candy Co.*, 288 F.2d 944, 129

USPQ 272 (CCPA 1961).

F. Balancing the factors.

\*15 The dominant factor in this case is the fame of opposer's NAUTICA marks. Because opposer has established that its NAUTICA marks are entitled to a high degree of public recognition and renown, they are more likely to be remembered and associated in consumers' minds than weaker marks and accorded more protection. In addition, to the high degree of public recognition and renown, applicant's mark is proposed for use in connection with goods which are identical in part to the goods in opposer's registrations. Therefore it is more likely that consumers will be confused when purchasing applicant's products when applicant's products are identified by a mark that is similar to opposer's famous marks. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). In reaching this decision, we note that there is "no excuse for even approaching the well-known trademark of a competitor ... and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1091, 1094 (Fed. Cir. 1989), quoting *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962).

In view of the foregoing, we find that applicant's mark NAUTIGIRL, when used in connection with the products described in applicant's application, so resemble opposer's NAUTICA marks for clothing and eyeglasses as to be likely to cause confusion.

Because we have found that there is a likelihood of confusion, we do not have to decide the issue of dilution.

Decision: The opposition is sustained and registration to applicant is refused.

FN1. Registration No. 1464663, issued November 10, 1987; Sections 8 and 15 declarations accepted and acknowledged. Opposer included a statement in its registration that the English translation of the word "Nautica" is "nautical." On February 20, 2007, opposer amended the drawing of the mark to standard character form from a lower case block letter form. The original display of opposer's mark is identical to the display in Registration No. 1553539 *infra*. The original lower case block format display of opposer's mark is not so distinctive as to be a factor in our decision.

FN2. Registration No. 1553539, issued August 29, 1989; Sections 8 and 15 declarations accepted and acknowledged. Opposer included a translation statement that "Nautica" means "nautical."

FN3. Registration No. 3168753, issued November 7, 2006.

FN4. Applicant's Brief, p. 11.

FN5. The same holds true for the articles referencing the NAUTICA trademark that opposer introduced through its notices of reliance.

FN6. Bizarri Dep., p. 28.

FN7. Bizzari Dep., p. 7.

FN8. Bizarri Dep., p. 6.

FN9. Bizarri Dep., pp. 9-10. Ms. Bizarri explained that color boards are presented to the buyers to show the products. (Bizarri Dep., p. 34). Applicant's counsel characterized the color boards as "wholesale catalogues. (Bizarri Dep. P. 33).

Based on the preceding exchange at the deposition and a review of Exhibits 2 and 5, it appears as though color boards are presentation boards that opposer uses to present its products to its distributors (*i.e.*, the retail stores that sell NAUTICA clothing and eyewear). The color boards display samples, photographs or renderings of the products. Ms. Bizarri testified that the color boards are created seasonally. (Bizarri Dep., p. 30).

FN10. Bizarri Dep., p. 12.

FN11. Bizarri Dep., pp. 29-30; Exhibit 5.

FN12. Bizarri Dep., pp. 28-29.

FN13. Bizarri Dep., p. 29. *See also* p. 30.

FN14. Bizarri Dep., p. 30.

FN15. Bizarri Dep., pp. 10, 17-18.

FN16. Bizarri Dep., p. 18.

FN17. Bizarri Dep., p. 18.

FN18. Bizarri Dep., pp. 19-20.

FN19. Bizarri Dep., pp. 21-22; Exhibit 7. We have some concern regarding the source of opposer's advertising expenses in the United States. Ms. Bizarri testified that she compiled the advertising and revenues from annual reports, other financial records, and discussions with personnel from accounting. (Bizarri Dep., pp. 38, 40-45, 47). Exhibit 7 is a summary of the revenues and advertising expenses. The advertising expenses are set forth in terms of worldwide advertising. Nevertheless, Ms. Bizarri testified as to advertising expenses in the United States without any explanation how she derived those figures. However, we accept Ms. Bizzari's testimony regarding advertising expenses in the United States because opposer has substantial sales that indicate that there has been substantial advertising, and there is no reason to doubt Ms. Bizzari's veracity.

FN20. Bizarri Dep., p. 21-22; Exhibit 7. Ms. Bizarri testified that the average sales in the United States were \$800 million. However, the data on which Ms. Bizarri relied indicates that the average sales were actually \$1 billion. Ms. Bizarri also testified that retail sales should be approximately double the wholesale sales, or in this case \$2 billion. (Bizarri Dep., p. 22)

FN21. Bizarri Dep., p. 16.

FN22. Bizarri Dep., p. 16.

FN23. Bizarri Dep., p. 17.

FN24. Margaret Bizarri, opposer's trademark paralegal, testified that other companies use "girl," "boy," or "kids" as part of their marks (*e.g.*, Tommy Girl, Brooks Brothers Boys, Talbot Kids and Gap Kids). (Bizarri Dep., p. 48).

FN25. During the prosecution of applicant's application, the Examining Attorney refused registration because applicant's mark so resembles the mark NAUGHTY GIRL! for brassieres and bikini panties (Registration No. 1082710) as to be likely to cause confusion.

FN26. Applicant's May 9, 2000 Response to the Office Action mailed November 9, 1999.

FN27. If we accept both of applicant's arguments, NAUTIGIRL could convey the commercial impression of a naughty girl on a boat.

FN28. Applicant submitted one registration filed under Section 44(d) of the Trademark Act of 1946, 15 U.S.C. §1126(d), and not use in commerce. A registration issued solely on the basis of an application filed under Section 44(d) does not require use in commerce. Without use in commerce, the registration has very little probative value. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

FN29. Opposer has filed petitions to cancel the Correct Craft registrations.

FN30. *The Columbian* (August 1, 2006); *Business Wire* (July 27, 2006).

FN31. *Business Wire* (February 17, 2006).

FN32. *The Oregonian* (August 1, 2006); *The Oregonian* (December 28, 2005).

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# **EXHIBIT 6**

# **EXHIBIT 6**

2008 WL 906635 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

Playboy Enterprises International, Inc.  
v.  
Rick Worobec

OPPOSITION 91165814 TO APPLICATION SERIAL 78430099 FILED ON JUNE 4, 2004

March 18, 2008

William T. McGrath of Davis McGrath LLC for Playboy Enterprises International, Inc.

Claire F. Hawkins of Christensen O'Connor Johnson Kindness PLLC for Rick Worobec

Before Walters, Cataldo and Bergsman  
Administrative Trademark Judges  
Opinion by Bergsman  
Administrative Trademark Judge:

Rick Worobec filed an intent to use application on the Principal Register for the mark PLAY BODY, in standard character format, for "clothing, namely, under garments, swimwear; footwear, namely shoes," in Class 25 (Serial No. 78430099). Playboy Enterprises International, Inc. has opposed the registration of applicant's mark on the ground of priority of use and likelihood of confusion. Opposer has alleged that applicant's mark PLAY BODY, when used in connection with clothing, is likely to cause confusion with opposer's famous PLAYBOY trademarks, used in connection with a wide variety of goods and services, including clothing.<sup>[FN1]</sup> Applicant denied the salient allegations in the notice of opposition.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark. The record also includes the following testimony and evidence:

A. Opposer's evidence.

1. Notice of reliance on a certified copy, showing the current status and ownership in opposer, of Registration No. 3140250 for the mark PLAYBOY, in standard character form, for lingerie, sleepwear, loungewear, wraps, and robes;<sup>[FN2]</sup>
2. Notice of reliance on applicant's responses to opposer's first set of requests for admission;
3. Notice of reliance on applicant's responses to opposer's first set of interrogatories;

4. Testimony deposition of Judy Kawal, opposer's Senior Director of Business Management in the licensing group, with attached exhibits; and,

5. Testimony deposition of Michelle McCoy, opposer's in-house trademark counsel, with attached exhibits.

**B. Applicant's evidence.**

1. Notice of reliance on opposer's responses to applicant's first set of interrogatories;

2. Notice of reliance on the definition of the word "Playboy" in Webster's Third New International Dictionary of the English Language, p. 1737 (1993); and,

3. Notice of reliance on 14 photocopies from the Trademark Office electronic search system of trademark registrations including the word "Play."

Standing

In her testimony deposition, Michele McCoy introduced into evidence certified copies of opposer's pleaded registrations showing their current status and their title in opposer. The following registrations were made of record:<sup>[FN3]</sup>

\*2 1. Registration No. 984548 for the mark PLAYBOY and design, shown below, for "articles of men's and women's clothing, namely, shirts, sleepwear, ties, sweaters, warm-up shirts," in Class 25;<sup>[FN4]</sup>



PLAYBOY

2. Registration No. 1328611 for the mark PLAYBOY, in typed drawing form, for "clothing articles, namely, shirts, ties, t-shirts, ski jackets, gym shorts, sweatpants, bathing suits, briefs, hosiery, sport socks, collared button-down knit shirts, sweat shorts, sweaters, velour tops, jogging suits, and shorts," in Class 25;<sup>[FN5]</sup>

3. Registration No. 1318244 for the mark PLAYBOY and design, shown below, for "footwear," in Class 25;<sup>[FN6]</sup> and,



4. Registration No. 1320822 for the mark PLAYBOY, in typed drawing form, for "footwear," in Class 25.<sup>[FN7]</sup>

During her deposition Ms. McCoy also testified that Registration No. 0600018 for the mark PLAYBOY, in block letters, for a monthly magazine is an active registration and that opposer owns it.<sup>[FN8]</sup>

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

#### Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in the opposition. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

#### Likelihood of Confusion

Our determination of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052 (d), is based on an analysis of all the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are discussed below.

##### A. Whether opposer's PLAYBOY mark is famous?

We turn first to the factor of fame, because this factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Id.* A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

\*3 In determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2s 1811, 1817 (TTAB 2005). This information, however, must be placed in context (e.g., a comparison of advertising figures with competitive products, market share, reputation of the product, etc.). *Bose Corp. v. QSC Audio Products Inc.*, *supra*.

Opposer's primary business is the distribution of a monthly men's magazine. Over time, it has expanded into three separate divisions: publishing, entertainment (i.e., wireless, online, and television), and licensing (i.e., licensed products and freestanding locations including clubs and retail stores).<sup>[FN9]</sup> The first issue of PLAYBOY magazine was distributed in December 1953, and it has been published continuously ever since. The first issue featured Marilyn Monroe on the cover.<sup>[FN10]</sup> PLAYBOY magazine is the best selling monthly men's magazine in the world.<sup>[FN11]</sup> It is 14th largest "consumer publication" in the United States.<sup>[FN12]</sup> It has a paid circulation in the United States of 3 million, which is larger than *Esquire*, *GQ*, and *Men's Journal* combined.<sup>[FN13]</sup> More than 10 million people read the magazine each month.<sup>[FN14]</sup> In addition, opposer publishes, on average, 25 special editions per year. Those publications have a circulation of more than 2 million and a readership of approximately 7.5 million.<sup>[FN15]</sup> There is an online edition of PLAYBOY magazine, and it has more than 15,000 subscribers.<sup>[FN16]</sup>

In addition to its photographic pictorials of women, PLAYBOY magazine is noted for publishing interviews



with famous people, including Jimmy Carter, Yasir Arafat, Donald Trump, Michael Jordan, Nicole Kidman, Jack Nicholson, George Clooney, Bill Gates, and others.<sup>[FN17]</sup> Also, many noted authors have contributed to the magazine, including Jane Smiley, John Updike, Scott Turow, Kurt Vonnegut, Michael Creighton, and Stephen King.<sup>[FN18]</sup> Some of the well-known women who have posed for PLAYBOY pictorials include Marilyn Monroe, Pamela Anderson, Anna Nicole Smith, Carmen Electra, Cindy Crawford, Drew Barrymore, Elle MacPherson, and Jenny McCarthy.<sup>[FN19]</sup> Opposer also operates a PLAYBOY television network.

The PLAYBOY television network is available to approximately 30 million households in the U.S. and Canada.<sup>[FN20]</sup> The PLAYBOY trademark is prominently featured on network broadcasts.<sup>[FN21]</sup> Also, opposer operates a radio channel on SIRIUS Satellite Radio. It airs 24 hours a day, 7 days a week.<sup>[FN22]</sup>

Opposer has a retail website at [www.playboystore.com](http://www.playboystore.com). That website averages 500,000 “unique visitors every month,” and it ships more than 300,000 orders annually.<sup>[FN23]</sup> In addition, opposer provides mail order service. It has distributed catalogs to over 10 million people.<sup>[FN24]</sup>

\*4 Opposer's licensing business began in 1970.<sup>[FN25]</sup> Today, opposer licenses a wide variety of PLAYBOY branded products, including key chains, jewelry, outerwear, undergarments, shirts, swimwear, lingerie, socks, scarves, ties, footwear, headwear, apparel accessories, bags, luggage, and cosmetics.<sup>[FN26]</sup> In 2006, retail sales for all of opposer's PLAYBOY branded products was in excess of \$120 million, including \$40 million for apparel items.<sup>[FN27]</sup> In 2005, opposer's retail sales for PLAYBOY branded products was also approximately \$120 million, and it was approximately \$115 million in 2004.<sup>[FN28]</sup> Opposer's licensees have spent in excess of \$900,000 per year advertising PLAYBOY branded products in 2004, 2005, and 2006.<sup>[FN29]</sup>

PLAYBOY branded products can be found in approximately 3500 different stores in the United States, including Henri Bendel, Bloomingdales, Urban Outfitters, Hot Topic, Spencer Gifts, and Kitson.<sup>[FN30]</sup>

Opposer receives unsolicited media attention in television, online, and in magazines and newspapers on almost a daily basis.<sup>[FN31]</sup> For example, in the period between March 14, 2007 and March 20, 2007, “Playboy” was referenced on *The Tonight Show with Jay Leno* (NBC), *The Late Show* (CBS), *Two and a Half Men* (CBS), *Real Sports with Bryant Gumbel* (HBO), *The Real Housewives of Orange County* (Bravo), and *Paradise City* (ETV).<sup>[FN32]</sup> Opposer is also referenced in the press (e.g., *Esquire*, *Newsweek*, *Teen Vogue*, *Chicago Tribune*, *Cosmopolitan*, *New York Post*, and the *New York Daily News*).<sup>[FN33]</sup>

Opposer also receives unsolicited media attention when celebrities wear PLAYBOY apparel, including Justin Timberlake, Britney Spears, Christina Aguilera, Paris Hilton, Posh Spice, Jay-Z, and Jewel.<sup>[FN34]</sup>

The Wikipedia website reports that “*Playboy* is one of the world's best known brands.”<sup>[FN35]</sup> Finally, although applicant denies that the PLAYBOY mark is famous,<sup>[FN36]</sup> he admits that the “PLAYBOY trademark is widely recognized in the United States.”<sup>[FN37]</sup>

In view of the foregoing, opposer has established that its PLAYBOY mark is famous and thus entitled to a broad scope of protection.<sup>[FN38]</sup> In this regard, we note that several courts have recognized that opposer's mark is strong and should be accorded a high degree of protection. *Playboy Enterprises, Inc. v. Chuckleberry Publishing, Inc.*, 687 F.2d 563, 215 USPQ 662, 665 (2<sup>nd</sup> Cir. 1982) (PLAYBOY is distinctive and is widely recognized); *Playboy Enterprises, Inc. v. Frena*, 839 F.Supp. 1552, 29 USPQ2d 1827, 1833 (M.D. Fla. 1993) (PLAYBOY is a well-known mark and widely associated with Playboy Enterprises); *Playboy Enterprises, Inc. v. P. K. Sorren Export Company, Inc. of Florida*, 546 F.Supp. 987, 218 USPQ 795, 800 (S.D. Fla. 1982)

(PLAYBOY is a strong mark, entitled to broad protection). In addition, we also note that applicant has not introduced any evidence of third party uses of PLAYBOY that would weaken the strength of opposer's mark. The 14 third-party registrations consisting, in whole or in part, of the word "play" for clothing are insufficient to show that opposer's mark is a weak mark entitled to a limited scope of protection.

B. The similarity or dissimilarity and nature of the goods as described in the application and registration.

\*5 The goods identified in applicant's application are "clothing, namely, under garments, swimwear; footwear, namely shoes." Opposer has pleaded and proven ownership of registrations that include a wide variety of clothing, including lingerie, briefs, bathing suits, and footwear. Thus, the goods at issue are at least in part identical. The fact that the only some of the products listed in the description of goods are identical is sufficient to support finding that there is a likelihood of confusion. *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any items that comes within the identification of goods in the application). The fact that opposer's registrations include additional items does not obviate the relatedness of the identical products. *Id.*

C. The similarity or dissimilarity of established, likely-to- continue trade channels and buyers to whom sales are made.

Given the identical nature of the parties' goods (clothing, namely, under garments, swimwear, and footwear) and the absence of any trade channel restrictions in either party's description of goods, we must presume that the clothing products of the parties would be marketed in the same channels of trade, to the same classes of purchasers. *Genseco Inc. v. Martz*, 66 USPQ2d 1260 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any trade restrictions in the identifications thereof as to channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"); *Miles Laboratories v. Naturally Vitamin Supplements*, 1 USPQ2d 1445, 1450 (TTAB 1987).

D. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. Du Pont de Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). See also *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the goods are in-part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

\*6 Opposer's PLAYBOY marks and applicant's PLAY BODY mark are similar in appearance because they share the word "play" at the beginning of the mark, followed by the letters "BO," in "boy" and "body," and ending in the letter "y." The significance of the word "play" is highlighted by its location as the first word of each mark. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of

a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, *supra* (upon encountering the marks, consumers must first notice the identical lead word). While there are differences between the appearance of opposer's PLAYBOY mark and applicant's PLAY BODY mark, the similarities outweigh the dissimilarities.

Likewise, we find that the marks are more aurally similar than dissimilar.

The marks PLAYBOY and PLAY BODY have different meanings. The word "Playboy" is a recognized word meaning "a young and wealthy man who lives a frivolous indolent life devoted chiefly to the pursuit of pleasure." [FN39] On the other hand, the term "play body" appears to be a coined term without any recognized meaning. However, because of the renown of opposer's PLAYBOY marks, consumers may associate the marks PLAYBOY and PLAY BODY with a single source because of the emphasis opposer places on photographic pictorials of women in its magazines. The marks engender a similar commercial impression created, on the one hand, by the above-noted meaning of the word "playboy" and opposer's renown for featuring naked women in its magazines, and, on the other hand, by applicant's use of the word "body" in its mark PLAY BODY causing consumers to draw a connection between PLAY BODY and PLAYBOY featuring photographs of women's bodies.

While there are differences between the marks PLAYBOY and PLAY BODY, we find that on balance the similarities outweigh the differences.

#### E. Balancing the factors.

In view of the fame of opposer's PLAYBOY mark, the identity of the goods, and the similarity of the marks, we find that applicant's use of PLAY BODY, in connection with "clothing, namely, under garments, swimwear; footwear, namely shoes," is likely to cause confusion with the mark PLAYBOY for clothing, including lingerie, briefs, bathing suits, and footwear.

Decision: The opposition is sustained and registration to applicant is refused.

FN1. Opposer also alleged that the registration of applicant's mark will cause dilution of opposer's famous PLAYBOY trademarks, but presented no arguments in support of that claim in its brief. We therefore deem opposer to have waived its pleaded dilution ground, and we have given it no consideration.

FN2. The registration issued September 5, 2006. Opposer claimed first use anywhere and first use in commerce on August 1, 1960.

FN3. We previously noted that opposer introduced a certified copy of Registration No. 3140250 through a notice of reliance. Opposer also included a certified copy of Registration No. 2485583 for the mark PLAYBOY, in typed drawing form, for "clothing articles, namely, vest and bow ties, cummerbunds and pocket squares," in Class 25. That registration issued on September 4, 2001. However, no declaration of use in accordance with Section 8 of the Trademark Act of 1946 has been filed. Accordingly, we will not give this registration any further consideration.

FN4. The registration issued on May 21, 1974; Sections 8 and 15 affidavits accepted and acknowledged; second renewal.

FN5. The registration issued on April 2, 1985; Sections 8 and 15 affidavits accepted and acknowledged; re- newed.

FN6. The registration issued on February 5, 1985; Sections 8 and 15 affidavits accepted and acknowledged; re- newed.

FN7. The registration issued on February 19, 1985; Sections 8 and 15 affidavits accepted and acknowledged; re- newed.

FN8. The registration issued on December 28, 1954; Sections 8 and 15 affidavits accepted and acknowledged; third renewal. (McCoy Dep., pp. 18-20; Exhibits 36 and 37).

FN9. Kawal Dep., p. 7.

FN10. McCoy Dep., p. 23.

FN11. McCoy Dep., p. 23.

FN12. McCoy Dep., p. 24

FN13. McCoy Dep., p. 23; Exhibits 39-43 (publisher's statements by the Audit Bureau of Circulations, an independent third party that monitors circulation figures).

FN14. McCoy Dep., p. 24.

FN15. McCoy Dep., pp. 25-26.

FN16. McCoy Dep., p. 27.

FN17. McCoy Dep., pp. 27-28.

FN18. McCoy Dep., p. 28.

FN19. McCoy Dep., p. 29.

FN20. McCoy Dep., pp. 29-30. We understand Ms. McCoy's testimony to be that 30 million households have access to the PLAYBOY television network, not that 30 million households subscribe or watch the PLAYBOY network.

FN21. McCoy Dep., p. 30.

FN22. McCoy Dep., p. 31.

FN23. McCoy Dep., p. 32; Kawal Dep., p. 18. Subsequently, Ms. McCoy testified that "We do have a publicly available number for Playboy on-line, and it looks like we have 6 million unique visitors, and 68 million page views each month." McCoy Dep., p. 37. However, it is not clear whether Ms. McCoy's testimony is limited to the United States or references worldwide activity.

FN24. McCoy Dep., p. 35; Kawal Dep., p. 19. It is not clear whether the testimony is referring to distribution in the United States or worldwide.

FN25. Kawal Dep., p. 13.

FN26. Kawal Dep. pp. 8-9, 11, and 26.

FN27. Kawal Dep., p. 11. However, Ms. Kawal later testified that retail sales for apparel items averaged approximately \$50 million per year in 2004, 2005, and 2006. (Kawal Dep., p. 15).

FN28. Kawal Dep., p. 12.

FN29. Kawal Dep., p. 15.

FN30. Kawal Dep., p. 16.

FN31. McCoy Dep., pp. 40-41.

FN32. McCoy Dep., Exhibit 45.

FN33. Kawal Dep., pp. 38-39; Exhibit 13.

FN34. Kawal Dep., pp. 36-37; Exhibit 12.

FN35. Kawal Dep., Exhibit 18 (<http://en.wikipedia.org>). We note this evidence simply for what is reported in Wikipedia and how its contributors perceive the PLAYBOY trademark. We also note that the May 15, 2003 issue of *Rolling Stone* magazine identified opposer's bunny logo as a significant American logo. The theme of the May issue was "American Icons." (Kawal Dep., Exhibit 16).

FN36. Applicant's Response to Request for Admission No. 11.

FN37. Applicant's Response to Request for Admission No. 10.

FN38. Although we have found that PLAYBOY is famous for purposes of opposer's likelihood of confusion claim, we have not addressed the question of whether PLAYBOY is famous in the context of a dilution claim. Fame for likelihood of confusion and dilution is not the same. Fame for dilution requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Likelihood of confusion fame "varies along a spectrum from very strong to very weak" while dilution fame is an either/or proposition — it either exists or it does not exist. *Id.* See also *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1507 (TTAB 2005) (likelihood of confusion "[f]ame is relative ... not absolute"). A mark, therefore, may have acquired sufficient public recognition and renown to be famous for purposes of likelihood of confusion without meeting the more stringent requirement for dilution fame. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1170, citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 USPQ2d 1225, 1239 (1st Cir. 1998) ("[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection").

FN39. Webster's Third New International Dictionary of the English Language Unabridged, 1737 (1993) introduced through applicant's second notice of reliance.

21f38feb7004b511dd8c43c1c374dcccimage/png2450px439.02212.04001.4011f39569b004b511dd8c43c1c374  
dcccimage/png2693px660.01826.04001.4022008 WL 906635 (Trademark Tr. & App. Bd.)  
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# **EXHIBIT 7**

# **EXHIBIT 7**

2007 WL 1849136 (Trademark Tr. &amp; App. Bd.)

## THIS OPINION IS NOT PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

ROBERT A. SCHEDER

v.

TOURISTIK ARBEITSGEMEINSCHAFT ROMANTISCHE STRABE GBR

CANCELLATION 92045257

June 19, 2007

Before Walters, Rogers and Cataldo  
Administrative Trademark Judges

By the Board:

Touristik Arbeitsgemeinschaft Romantische Strabe ("Registrant") owns U.S. Reg. No. 3011652, issued on November 1, 2005,<sup>[FN1]</sup> on the Principal Register for the mark ROMANTIC ROAD for certain tourism services and certain publication services in, respectively, Classes 35 and 41.<sup>[FN2]</sup>

On December 12, 2005, Robert A. Scheder ("Petitioner") filed a petition to cancel only the International Class 35 services in the registration, claiming that the mark is primarily geographically descriptive. Petitioner alleges that Registrant's continued use and registration of ROMANTIC ROAD in connection with the identified services "damages [his] business because [he is] engaged in the sale of related goods and services and [he has] an interest in using the term 'Romantic Road' descriptively in [his] business" (Pet. ¶ 1).<sup>[FN3]</sup>

Registrant denied all of the salient allegations. This case now comes up on Registrant's motion for summary judgment on petitioner's claim of geographic descriptiveness, filed September 1, 2006.<sup>[FN4]</sup> In its motion, Registrant contends that the mark is **not** primarily geographically descriptive of the services it renders<sup>[FN5]</sup> and in support Registrant provides documentary evidence of the history of the mark. In response, Petitioner challenges Registrant's documentary evidence and has submitted maps and other references to the area known as the "Romantic Road".

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). *See also Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence of record and any inferences, which may be drawn from the underlying undisputed facts, must be viewed in the light most favorable to the non-moving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. *See Opryland USA, Inc. v. Great American Music Show, Inc.*



, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Section 2(e)(2) of the Trademark Act prohibits registration of marks which, when used in connection with the identified goods and services, are primarily geographically descriptive. For a plaintiff to establish that a mark is primarily geographically descriptive, the party must typically show that the mark is the name of a place known generally to the public, and that the public would make a goods/place association, *i.e.*, believe that the goods or services for which the mark is registered originates in that place. See *In re Societe Generale des Eaux Minerales de Vittel, S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988). However, "a case of unregistrability cannot be made out simply by evidence showing that the mark sought to be registered is the name of a place known generally to the public." See *In re Societe Generale* 824 F.2d at 959, 3 USPQ2d at 1452. Further, it has been held that a designation coined and promoted as a mark but which incidentally designates a particular location can function as a mark and is not primarily geographically descriptive. See *In re Pebble Beach Co.*, 19 USPQ2d 1687 (TTAB 1991). See also *Horseshoe Bay Resort Sales Co. v. Lake Lyndon B. Johnson Improvement Corporation*, 53 S.W.3d 799 (Tex. App. 2001).

**\*2** In this case, Registrant does not dispute that ROMANTIC ROAD has come to identify a specific geographic region, and that its goods and services originate from there, but argues that ROMANTIC ROAD is not primarily geographically descriptive because its primary significance is as a trademark/service mark to designate Registrant's goods and services.

According to the documented history provided by Registrant, the term ROMANTIC ROAD<sup>[FN6]</sup> was coined<sup>[FN7]</sup> in 1950 by a small group of city tourist boards in Southern Germany who formed a joint venture<sup>[FN8]</sup> to offer travel services and promote tourism in the American-occupied portion of Southern Germany. (Reg.'s Mot. Summ. J. Ex. A, Decl. of Wunschenmeyer, managing director of current registrant at ¶¶ 4-7). The term was coined to refer to their promotional and travel services along the 350-kilometer series of roads connecting Würzburg near the River Main to the city of Füssen near the Alps. (Reg.'s Mot. Summ. J. Ex. B., Minutes of Meeting of the Joint Venture at pp. 9-10).<sup>[FN9]</sup>

During the initial meeting of the members of the joint venture, the members agreed to set up a guided tour involving eighteen cities along the route and decided to create a pictorial guidebook to illustrate the tourist opportunities along the route.<sup>[FN10]</sup> Since then additional cities have joined the joint venture; the mark has been put on signs alongside the roads through those cities; and publicity has been extensive with each member city promoting and offering services under the mark by publishing and disseminating directories of local hotels and inns, providing guided tours and most recently hosting informational websites.<sup>[FN11]</sup> (Decl. of Wunschenmeyer at ¶¶ 13, 16 and Reg.'s Mot. Summ J. Ex. C, Shareholder's Agreement).

On January 1, 2005, a Shareholders' Agreement went into effect that legally established a civil law corporation<sup>[FN12]</sup> as a successor-in-interest to the unincorporated association (joint venture). (Reg.'s Mot. Summ J. Ex. C). Additionally, Registrant has approximately forty partners consisting of local enterprises such as hotels, museums, restaurants, etc., which promote services offered under the mark, including tourism organizations, whose promotional activities are directed by Registrant. (Ex. C at p. 16; Decl. of Wunschenmeyer at ¶¶ 13-14; Reg's Resp. 12 to Petr's Interrog. # 12).

Petitioner has offered in response to the motion, his own declaration disputing parts of Registrant's translations<sup>[FN13]</sup> and providing copies of maps, road signs, websites, internet search results and documents in German, all

purporting to demonstrate that ROMANTIC ROAD identifies a physical location.

As noted above, the burden is on the party moving for summary judgment, in this case Registrant, to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). *See also Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). Undisputed facts as established by Registrant in this case<sup>[FN14]</sup> are that the mark, ROMANTIC ROAD, was coined in 1950 to offer travel services and promote tourism to an area of occupied Germany and the term continues to be used by registrant in connection with these services and the term, now in use for over fifty (50) years, has become a known travel destination. Thus, Registrant has set out a prima facie case that ROMANTIC ROAD functions primarily as a mark and qualifies for protection under the *Pebble Beach* analysis.

\*3 Petitioner, in responding to the motion and attempting to counter the prima facie case, has not presented countervailing facts sufficient to raise a genuine issue of material fact.

In this case, we find no genuine issue that, as a term coined by Registrant to promote tourism, ROMANTIC ROAD is a mark that is used variously by Registrant and those authorized by Registrant to promote tourism among the member cities. It is not merely or primarily a geographic term, but has always been a term associated with Registrant and its services. The fact that the coined term has developed a reputation connoting tourism in a particular geographic region does not necessarily make that term primarily geographically descriptive under Section 2(e)(2). Indeed, the undisputed fact that the mark ROMANTIC ROAD is well known, and that people may be familiar with the tourism area comprising the ROMANTIC ROAD, establishes that it functions primarily as a mark, because it is through Registrant's efforts that the name given by Registrant and its predecessors in interest to the region has come to be recognized as a source of tourism-related services, albeit in a particular location. *In re Pebble Beach*, 19 USPQ2d at 1688-89.

Therefore, because the Board finds that there is no genuine issue of material fact, and because Registrant is entitled to judgment as a matter of law on this issue, Registrant's motion for summary judgment is granted and summary judgment in favor of Registrant is hereby entered. The petition to cancel is dismissed with prejudice.

FN1. The application which matured into the subject registration was filed under the Madrid Protocol, Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f). The application as filed was based on International Registration No. 0837370, which was itself based on German Registration No. 302 39 858.

FN2. U.S. Reg. No. 3011652 is for "Promotion of tourism through marketing and advertising; distribution of advertising material, preparing signboard advertising for others; conducting promotional events in the field of tourism and marketing in connection with tourism and exhibitions for commercial and advertising purposes; providing of commercial information for business purposes about all members and partners; advertising for flat rate offers for providing of food, drink and temporary accommodation" in Class 035 and "Publication of printed information material in different languages, publication of printed matter, printed information material and printed media notes; publication of brochures, prospectuses, accommodation lists, events calendars, cards and stickers conducting of seminars and lectures in the field of tourism for commercial and advertising purposes" in Class 041. It is noted that registrant also owns U.S. Reg. No. 3085665 for ROMANTIC ROAD and Design in connection with services in Classes 35, 41 and 43.

FN3. Petitioner alleges that he has operated the Internet domain [www.romanticroad.com](http://www.romanticroad.com) since 1997 and currently hosts forty websites on it. (Resp. at p. 22). Petitioner alleges that his service is related to registrant's because he provides information about the Romantic Road region of Germany. (*Id.*).

FN4. Petitioner filed two motions of his own, namely, a “motion to cancel amendments” and a “motion to void” the application, both based on allegedly incorrect owner names on the U.S. registration. The ministerial change to the list of owner names on the U.S. registration was a technical correction initiated by the International Bureau in regard to the international registration and subsequently effected by the USPTO in regard to the Madrid Protocol extension filing. *See* 37 C.F.R. § 7.14. Additionally, the International Registration has been assigned and the assignment recorded in the USPTO. Accordingly, the new owner, as reflected in the Assignment Branch records, recorded at Reel 3472/Frame 0712 on February 1, 2007 with an execution date of October 6, 2006, is hereby substituted as the registrant.

We note that the petition for cancellation contains only a single claim, geographic descriptiveness, against only one (1) class in the involved registration. The two motions directed to ownership are essentially motions that seek entry of judgment for petitioner based on unpleaded issues and therefore are denied for that reason, apart from their being rendered moot by the International Bureau's actions.

FN5. Registrant also argues that Petitioner does not have standing to bring this petition. However, to the extent Petitioner alleges that he is being sued in Germany by registrant to obtain the domain name [www.romanticroad.com](http://www.romanticroad.com), and registrant is using ownership of its U.S. registration in support of that suit, Petitioner has pleaded standing.

FN6. In German the term, as translated, is Romantische Straße.

FN7. Petitioner states that the explicitly English term “Romantic Road” does not appear in the minutes and that the German National Tourist Board officially gave the series of roads the name “Romantic Road”. There is no genuine dispute that Registrant's predecessors created the term.

FN8. Petitioner challenges registrant's translation of a German term, contending it does not translate to joint venture, but rather to working group. This is not, however, an issue of fact material to the involved claim.

FN9. Excerpts from the minutes of the 1950 meeting (as translated) provide, in pertinent part:

The actual promotion shall only encompass the route between Wuerzburg and Fuessen to be designated as “The Romantic Road between Main River and the Alps”. Said route leads from Wuerzburg through the Taubertal valley via Weikersheim, Creglingen, Dettwang,

...

As the joint venture's activities are planned in the long term, it is intended to launch further promotional activities in the course of time, such as the issuance of promotional mark, a poster, a pictorial work, a tour guide, as well as a special signage for the “Romantic Road”.

FN10. Petitioner again challenges the translation of the minutes contending that the words translating as “set up guided tour” is really a proposal for a committee to organize a tour along the new street “for members of the press and relevant tourist offices in order to promote the new street.” (Br. at ¶ 3). This is not, however, an issue of fact material to the involved claim.

FN11. The “Official Website” of registrant is [www.romantischestrassen.de/](http://www.romantischestrassen.de/), and the romantischestrassen portion translates as romantic road. The “.de” is a top-level domain, specifically, the country code for Germany.

FN12. The agreement established Touristik-verbandsgemeinschaft Romantische Strasse, GbR. (Ex. C at p. 15).

FN13. Petitioner's challenges to respondent's translations do not raise any genuine disputes as to any material

fact.

FN14. The minutes of a joint venture in 1950; and a shareholder's agreement that went into effect on January 1, 2005 establish these facts.

2007 WL 1849136 (Trademark Tr. & App. Bd.)  
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# **EXHIBIT 8**

# **EXHIBIT 8**

2007 WL 2344691 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

VIRGIN ENTERPRISES LIMITED  
v.  
ALBION MOTORS FORD MERCURY, INC.

OPPOSITION 91153575, 91153612 & 91154161 TO APPLICATION SERIAL 76256596, 7625149 & 76256597

August 10, 2007

James Dabney, Victoria J.B. Doyle, Carrie B. Kingsley and Randy Eisensmith of Fried, Frank, Harris, Shriver & Jacobson LLP for Virgin Enterprises Limited

Daniel Van Dyke and Karl D. Ondersma of Van Dyke, Gardner, Linn & Burkhart, LLP for Albion Motors Ford Mercury, Inc.

Before Hairston, Drost and Walsh  
Administrative Trademark Judges  
Opinion by Walsh  
Administrative Trademark Judge:

In these consolidated proceedings, Virgin Enterprises Limited (opposer) opposes three intent-to-use applications filed by Albion Motors Ford Mercury, Inc. (applicant) to register the marks VIRGIN VEHICLE, VIRGIN PURCHASE and VIRGIN SALE on the Principal Register in standard-character form. In all three applications applicant identifies its services as "automobile and truck dealerships" in International Class 35. Also, in each of the respective applications applicant disclaims the words "VEHICLE," "PURCHASE" and "SALE."

The notices of opposition are identical in all respects other than in the references to the specific application at issue. As grounds for the oppositions opposer asserts both likelihood of confusion under § 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), and dilution under § 43(c) of the Act, 15 U.S.C. § 1125(c). In the notices of opposition opposer states, "Opposer, VEL, and its related companies (collectively, the "Virgin Group"), are now and for many years past have been engaged in the sale and distribution of a wide variety of goods and services under the world-famous VIRGIN mark." Notices of Opp. at ¶ 1. The notices state further that the goods and services offered under the VIRGIN mark include, among others, airline services, transportation services, travel-related services, cargo services, retail store services, alcoholic and nonalcoholic beverages, telecommunications products and services, clothing, luggage, compact discs, computer games, umbrellas, books, records, CDs, audio tapes and videotapes. Opposer relies on several registrations for its VIRGIN marks in these proceedings. *Id.* at ¶ 2. In its answers applicant has denied the essential allegations in the notices of opposition.

### I. The Record

The record in these consolidated proceedings is enormous. The record includes the files of the three opposed applications and the pleadings in these proceedings. In addition, opposer filed trial testimony from nine witnesses, including eight officials connected with opposer and one official connected with applicant, along with hundreds of exhibits consisting of thousands of documents, as well as evidence in electronic form. Both opposer and applicant have filed notices of reliance, each relying on hundreds of documents.

\*2 Opposer and applicant have filed briefs.

### II. Applicant's Objections

Before we address the merits, we must dispose of numerous evidentiary and procedural objections and motions. In its brief applicant lists twenty-eight separate objections related to opposer's main brief and opposer's evidence.

Opposer has also filed a motion requesting acceptance of its reply brief which was filed one day late. The reply brief was due on Friday, July 7, 2006. Opposer filed the reply brief electronically, and it was received in the USPTO on Saturday, July 8, 2006. Applicant opposes the motion for acceptance of opposer's late-filed reply brief.

Also, at the close of opposer's testimony period, applicant filed a motion to strike certain documents opposer submitted under its notice of reliance. In an action dated November 21, 2005 on that motion, the Board deferred action with respect to applicant's substantive objections and sustained certain objections as to the form of opposer's notice of reliance. In that action, the Board advised applicant that applicant must raise the substantive objections in applicant's trial brief. In accordance with the Board action, opposer has resubmitted the notice of reliance with corrections as to form. Accordingly, we will assume that applicant has raised all remaining substantive objections regarding the evidence, as directed, in applicant's brief. *See Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007).

First we will address the objections and motion related to the consideration of opposer's briefs. In objection 11, applicant objects to our consideration of opposer's main brief on the ground that opposer failed to serve the brief on applicant in accordance with 37 C.F.R. § 2.119(d). Applicant's Brief at 37. More specifically, applicant asserts that opposer served its main brief on applicant by email, a means of service not provided for in the rules, though permitted if the parties agree to service by email. Applicant further asserts that applicant had not agreed to receipt of opposer's main brief by email. It is apparent that applicant did receive opposer's main brief on time. Applicant, in fact, responded to opposer's main brief. In view of the totality of the circumstances, we exercise our discretion to accept and consider opposer's main brief. We find that the email transmission in no way prejudiced applicant. In fact, it appears that applicant received the brief sooner than it would have if the brief had been mailed. Nonetheless, we urge parties to discuss and reach an agreement concerning these logistics to avoid unnecessary disputes over form.

Opposer has filed a motion requesting acceptance of its reply brief, which was apparently filed one day late. While applicant has objected to the acceptance of opposer's reply brief, it has not pointed to any prejudice to itself. Under the circumstances of this case, we grant opposer's motion to accept its reply brief although we add, the brief does not change the outcome of this case.

**\*3** Next, in applicant's objection 1, applicant objects to "... any attempted reliance by VEL [opposer] to any registrations or applications or other purported marks that were not pleaded in VEL's Notice of Opposition." Applicant's Brief at 33. Applicant's objection is well taken, and accordingly we sustain the objection.

Furthermore, applicant notes that opposer referred to eighteen registrations and three applications for VIRGIN marks in each of the notices of opposition, and that opposer provided status and title copies of only eighteen registrations under opposer's notice of reliance. With its notice of reliance opposer did provide status and title copies of numerous additional registrations which opposer failed to plead in the notices of opposition. Opposer made no attempt to amend its notice of opposition for this purpose. Accordingly, for the purposes of these proceedings, we have limited our consideration to the marks and goods and services covered by the eighteen registrations owned by opposer which opposer both pleaded in its notices of opposition, and as to which opposer filed status and title copies in its notice of reliance. We identify the particulars of those eighteen registrations below. We hasten to add that applicant has vastly underestimated the importance and scope of these eighteen registrations as we discuss below.

We note further that the marks in these eighteen registrations are the only VIRGIN marks which opposer has pleaded. Therefore, in accordance with applicant's objections, we also have limited our consideration in these proceedings to those marks identified in the eighteen registrations. This determination effectively disposes of applicant's objections 2 and 3 related to evidence regarding the VIRGIN LIMO mark, one of the VIRGIN marks which opposer failed to plead.

Next in objections 4 and 5 applicant objects to certain of opposer's evidence related to its use of the VIRGIN marks with respect to limousine services. *Id.* at 35. We note that among the eighteen VIRGIN registrations before us are opposer's Reg. No. 1851817 for the mark VIRGIN in standard-character form and Reg. No. 1852776 for the VIRGIN mark in special form shown below. Each covers, among other services, "transportation of ... passengers by road..." Also, Reg. No. 2482726 for the mark VIRGIN ATLANTIC VACATIONS in standard-character form, which is also before us, covers, among other services, "transportation of ... passengers by road ... transportation of human beings by means of land vehicles ... chauffeur services." Therefore, opposer's registrations effectively cover use of the VIRGIN marks with respect to limousine services. Accordingly, we need not and do not rely on any other evidence, including the evidence applicant objects to here, for the purpose of opposer's use of the VIRGIN marks with respect to limousine services.

In objection 6, applicant objects to Opposer's Test. Exh. 13, a brochure promoting certain services under the VIRGIN ATLANTIC and VIRGIN marks for lack of foundation because Mr. Bershefsky, the authenticating witness, indicated that he did not know whether the brochure had been distributed to the public. *Id.* at 36. We sustain the objection; we have not considered this brochure in reaching our decision here.

**\*4** In objection 7, applicant objects to the testimony from opposer's witness, Mr. Block, with regard to the number of "views" of bags used by Virgin Megastores, as speculative. *Id.* We sustain the objection. We will consider only the number of bags in our decision of the case.

In objection 8, applicant objects to "opposer's reliance on Board proceedings and court proceedings to establish the fame of its mark." *Id.* We sustain the objection to the extent that we will not adopt any findings of fact or conclusions of law reached in those proceedings. The parties, marks and evidence in those proceedings differ from those in the proceedings before us. We will consider the evidence of these proceedings for the limited purpose of evaluating the extent to which opposer has policed the VIRGIN marks, and for whatever bearing those



policing efforts might have on the strength of opposer's VIRGIN marks.

In objection 9 applicant objects to "... any attempted reliance by VEL to (sic) the 'VIRGIN SALE' mark." *Id.* We sustain the objection; opposer did not plead the VIRGIN SALE mark.

In objection 10 applicant objects to opposer's reliance on Test. Exh. 212, the book *The World's Greatest Brands, an International Review by Interbrand* as hearsay. *Id.* at 37. We overrule the objection. Opposer's witness, Ms. Levin-Hyams, adequately authenticated the publication. Furthermore as to the hearsay issue, we regard this and similar publications both opposer and applicant have submitted as being submitted to show that the content of the publications appeared before the public, not for the truth of that content. To the extent applicant raises hearsay objections in any of its enumerated objections to any other similar publications opposer placed in evidence, we likewise overrule those objections.

With regard to applicant's objection 12 to opposer's submission of additional pages from the article in Exh. 141 to Opposer's Notice of Reliance, we sustain the objection. *Id.* at 38. We will not consider the additional pages to the exhibit which opposer provided only with its substitute notice of reliance.

In objection 13, applicant objects to Exhs. 147-150 to Opposer's Notice of Reliance. *Id.* We first note that opposer withdrew Exh. 147 when it filed its substitute notice of reliance. As to Exhs. 148 to 150, we sustain applicant's objection on the grounds that the printouts from certain web sites are not proper subject matter for a notice of reliance under 37 C.F.R. § 2.122 because they are copies from web sites and, as applicant alleges, there is no indication in the record that these materials are available to the public in printed form.

\*5 In objection 14 applicant objects to Exhs. 135, 139, 145, 146 and 151 to Opposer's Notice of Reliance. *Id.* With regard to Exhs. 135, 139 and 151 applicant asserts that the publications are not generally available to the public because the documents state that they are published in the United Kingdom, with no indication that they were distributed or otherwise available in the United States. We concur and sustain the objection with regard to this evidence. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298 n.3 (TTAB 1986), *aff'd*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

With regard to Exhs. 145 and 146, applicant does not explain specifically why we should not regard these publications as generally available to the public. In fact, each of these documents bears a stamp indicating that the documents were obtained through the Burrelle's clipping service and an indication of the publication name, and the date and place of publication, indicating that both were published in the United States. We overrule the objection as to these exhibits.

In objection 15 applicant objects to opposer's Test. Exh. 1 for failure to authenticate and lack of foundation. *Id.* at 39. The exhibit is a printout from opposer's web site. We overrule the objection. The authenticating witness, Mr. Bershefsky, an official with Virgin Atlantic Airlines, one of the Virgin Group companies, is competent to recognize and authenticate a printout from a Virgin Group web site, even though he did not print it out himself and even though he did not know precisely who did print it out.

In objection 16 applicant objects to Test. Exh. 3 "to the extent the document contains merely prospective budgeted advertising figures." *Id.* at 40. We sustain the objection.

In objection 17 applicant objects to Test. Exh. 4 because it is an advertisement which ran in the United Kingdom only, and on other grounds. *Id.* We sustain the objection on the grounds that there is no evidence that

the advertisement was run or seen in the United States.

In objection 18 applicant objects to Test. Exh. 5 arguing that opposer's authenticating witness, Mr. Bershefsky, testified that it was "not an advertisement." *Id.* In its argument applicant quotes the witness in misleading fashion. In cross examination, the witness explains quite clearly, "...this piece as we were describing was used to — used within specific companies or places we were going to alert the people in the company that the road trip truck was outside the location." Bershefsky Test. at 121-122. The exhibit is clearly admissible as a promotional piece to show how opposer promoted its mark in relation to airline services, the focus of the "road trip" promotion. Accordingly, we overrule the objection.

\*6 In objection 19 applicant objects to opposer's Test. Exhs. 22-28 for failure to authenticate and lack of foundation. *Id.* The exhibits are copies of a promotional piece, duty-free catalogs and inflight magazines used in conjunction with opposer's airline services. Applicant argues that the exhibits should be excluded because the authenticating witness did not create them or retrieve them from the company archive personally. The witness, Mr. Bershefsky, as the brand marketing manager for Virgin Atlantic Airlines, is competent to recognize and authenticate these documents. We overrule the objection.

In objections 20 and 21, applicant objects to Test. Exhs. 214-217, 235 and 236 as hearsay, for failure to authenticate and/or for lack of foundation. *Id.* at 41. The exhibits are portions of various published books about Richard Branson, the principal owner of and moving force behind the Virgin Group of companies, or about the Virgin Group's brands. We overrule the objections. The books would qualify for submission under a notice of reliance under 37 C.F.R. § 2.122. It would be illogical to exclude the same type of material when introduced by a witness — here Ms. Levin-Hyams, an official with the Virgin Group of companies. We will consider the material for whatever probative value it possesses.

In objection 22 applicant objects to Test. Exh. 239 because "VEL's identifying witness testified that she did not know where the exhibit came from." *Id.* In fact, the witness, again Ms. Levin-Hyams, testified that the article came from Bacon's clipping service. We overrule the objection.

In objections 23 and 24 applicant objects to Opposer's Test. Exhs. 240 and 241 which are CDs containing footage related to Virgin Group promotional activities. *Id.* Although Ms. Levin-Hyams testified that she was familiar with the content applicant objects because the witness did not personally witness the transfer of the material to CDs for submission in the case. We overrule the objection.

In objection 25 applicant objects to Opposer's Test. Exhs. 242 and 243, copies of articles regarding the Virgin Group from the *New York Times* because the authenticating witness, again Ms. Levin-Hyams, did not clip and copy the articles herself. *Id.* at 42. In fact, the witness testified that she had read the articles herself when they appeared and directed the copying of the articles; she thus went beyond what would be required to authenticate the exhibits under the circumstances. We overrule the objection.

In objection 26 applicant objects to Test. Exhs. 244 and 245, copies of pages from the Fox TV website promoting "The Rebel Billionaire — Branson's Quest for the Best" again because Ms. Levin-Hyams, the authenticating witness, did not personally obtain the copies. *Id.* The witness testified that she had the pages in her own records and recognized them. We overrule the objection.

\*7 In objection 27 applicant objects to Test. Exh. 57 because opposer failed to provide a copy to applicant. The exhibit appears to be a media plan for August 2004 related to future advertising of the Virgin Megastores. Op-

poser did not respond to this objection in its reply brief. Accordingly, we sustain the objection.

In objection 28 applicant objects to Test. Exhs. 1 through 248, which includes all such exhibits, for failure to make the exhibits available prior to the testimonial depositions and for failure to supplement answers to certain related interrogatories propounded by applicant. We overrule the objections.

Opposer was under no obligation to make exhibits presented through testimony available to applicant in advance of the testimonial depositions. Applicant elected to take part in the depositions by telephone. Applicant could have attended the depositions and viewed the exhibits at that time. Furthermore, it appears most of the exhibits were made available to applicant prior to or at the time of the depositions, as evidenced by the extensive cross examination applicant conducted with regard to specific exhibits. There is no evidence that opposer intentionally withheld documents. In fact, it appears that opposer tried to accommodate applicant when problems arose — problems which are inevitable when so many documents are involved.

Furthermore, we will not entertain a global objection of this sort based on failure to meet discovery obligations without particulars as to the exhibits and other circumstances, including evidence as to responses and documents which were, in fact, provided during discovery. Cf. *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d at 1106. See also *CareFirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1500 (TTAB 2005).

Finally, we note that opposer has referred to certain uses of its VIRGIN marks outside the United States in its notices of opposition and in its arguments. Furthermore, certain of opposer's evidence either relates to use outside the United States or comingles use within and outside the United States. Although applicant has not specifically objected to these claims or opposer's evidence on this ground, we note here that we have not considered any use by opposer of its marks outside the United States nor any evidence relating to such use in reaching our decision here.

### III. Standing

Opposer has shown that it has used the VIRGIN marks in the United States and that it is the owner of numerous U.S. registrations for those marks. Accordingly, opposer has established standing. See generally *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987).

### IV. Priority

For purposes of the likelihood-of-confusion claim, priority is not at issue in these proceedings. Opposer has made of record valid and subsisting registrations for various VIRGIN marks which it owns. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

### V. Findings of Fact

\*8 At the outset we note that both opposer and applicant have submitted certain information regarding their businesses, principally specific financial information, under claims of confidentiality. Both parties' claims are appropriately narrow and within reason, and therefore we will respect those claims. Consequently, we are somewhat constrained in our discussion of specific information regarding the activities of both parties.

#### A. Opposer

Opposer is the owner of various marks consisting in whole or in part of the word VIRGIN which it uses through

a number of related companies. The related companies include the Virgin Group of companies, referenced above, which are substantially owned and controlled by Richard Branson, and certain licensees not owned by Mr. Branson. James Test. at 6. The scope of the businesses which the Virgin Group operates is expansive to say the least; there are in excess of 200 businesses. Test. Exh. 95.

More importantly for our purposes, as noted above, opposer is the current owner of eighteen valid and subsisting registrations for the VIRGIN marks which are in evidence in these proceedings. Those registrations include the following:

Reg. No. 1413664 for the mark VIRGIN in standard-character form for air travel services, in International Class 39;

Reg. No. 1469618 for the mark VIRGIN in standard-character form for pre-recorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph records, in International Class 9;

Reg. No. 1597386 for the mark VIRGIN in standard-character form for printed sheet music; mounted photographs; posters, fictional and non-fictional books, biography and autobiography books, periodicals, namely, journals, paperback books all dealing with music, films and entertainment; paper for packaging, paper cases; stationery and office supplies, playing cards, in International Class 16, and belts, articles of outer clothing, namely, shirts, t-shirts, sweat shirts, jackets, hats, clothing caps, clothing belts, in International Class 25;

Reg. No. 1851817 for the mark VIRGIN in standard-character form for transportation of goods and passengers by road, air freight transportation services; travel agency services, in International Class 39; and bars; and retail store services in the fields of cameras, records, audio and video tapes, computers and electronic apparatus, and watches, sheet music, books and photography, handbags, purses, luggage and leather goods, clothing, games, video game machines and video game cartridges, in International Class 42;

Reg. No. 2586162 for the mark VIRGIN in standard-character form for articles of luggage, namely, suitcases; bags; namely, back packs, rucksacks, school bags, school satchels, travelling bags, sports bags, all purpose sports bags for campers and climbers, textile shopping bags; wallets; umbrellas and parasols, in International Class 18;

Reg. No. 2625455 for the mark VIRGIN in standard-character form for providing an on-line shopping mall via a global computer network; providing business information via a global computer network, in International Class 35, and computerized communication services, namely, electronic mail services, and providing networks for the purpose of transmission and reception of electronic mail, computer generated music, news and other data and information; and broadcasting services by radio and over a global computer network of a wide variety of programs, namely, current events, economics, politics, sports, entertainment, the arts and business, in International Class 38;

\*9 Reg. No. 1517801 for the mark shown below for pre-recorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph records; photographic and cinematographic films, in International Class 9;

A stylized, handwritten-style logo of the word "Virgin". The letters are thick and black. A single, thick diagonal line starts from the bottom left of the 'V' and extends upwards to the right, crossing through the 'i' and 'n'.

Reg. No. 1591952 for the mark shown below for printed sheet music; fictional and non-fictional books, biography and autobiography books, periodicals, namely, paperback books all dealing with music, films and entertainment; paper for packaging, paper cases; writing instruments, namely, pens, pencils, ball point pens, stationery and office supplies, namely, writing and note paper, playing cards, in International Class 16, and articles of outer clothing, namely, shirts, t-shirts, sweat shirts, jackets, hats, clothing caps, clothing belts, in International Class 25;

A stylized, handwritten-style logo of the word "Virgin". The letters are thick and black. A single, thick diagonal line starts from the bottom left of the 'V' and extends upwards to the right, crossing through the 'i' and 'n'.

Reg. No. 1852776 for the mark shown below for transportation of goods and passengers by road, air freight transportation services, in International Class 39; and bars; rental of food service equipment; namely, vending machines; portrait and aerial photography; typesetting and printing services; and retail store services in the fields of cameras, records, audio and video tapes, computers and electronic apparatus; and watches; sheet music, books and photography; handbags, purses, luggage and leather goods; clothing; games, video game machines and video game cartridges, in International Class 42;

Reg. No. 2600080 for the mark shown below for non-alcoholic beverages, namely, soft drinks, in International Class 32, and stating "The drawing of the trademark is lined for the color red.";

Reg. No. 2482726 for the mark VIRGIN ATLANTIC VACATIONS in standard-character form for transportation of and arranging transportation of goods and passengers by road, rail, air and sea; transportation of human beings by means of land vehicles; automobile and motorcycle rental services; chauffeur services; tourist agency services; travel agency services, namely, making reservations and bookings for transportation; arranging and/or conducting travel tours; and arranging visits to places of interest, in International Class 39, and making hotel reservations for others; arranging, organizing and providing facilities for exhibitions and conferences; and providing beauty salons and hairdressing, massage, manicure and pedicure services, in International Class 42, with "VACATIONS" disclaimed;

Reg. No. 2488605 for the mark VIRGIN CARGO WINGS in standard-character form for freight airline services; arranging of transportation of goods by air; packaging and storage of goods, in International Class 39, with "CARGO" disclaimed;

Reg. No. 2536973 for the mark shown below for charitable fundraising, in International Class 36, with "HEALTHCARE FOUNDATION" disclaimed;



Reg. No. 1863353 for the mark VIRGIN MEGASTORE in standard-character form for retail department store services, in International Class 42, with "MEGASTORE" disclaimed;

\*10 Reg. No. 2237092 for the mark VIRGIN VACATIONS in standard-character form for arranging the transport of passengers by air and road, arranging and conducting travel tours, travel agency services, namely, making reservations and bookings for transportation, and transportation reservation services, in International Class 39; and resort hotel and hotel reservation; travel agency services, namely, making reservations and bookings for temporary lodging, in International Class 42;

Reg. No. 2151589 for the mark VIRGIN VODKA in standard-character form for vodka, in International Class 33, with "VODKA" disclaimed;

Reg. No. 2507654 for the mark shown below for non-alcoholic beverages, namely, soft drinks, and syrups and preparations for making soft drinks, in International Class 32, and spirits, in International Class 33, with "TRADING COMPANY" disclaimed;



and

Reg. No. 2639079 for the mark VIRGIN HOLIDAYS in standard-character form for transportation of passengers and goods by road, rail and air; arranging of package holidays; arranging and organizing tours; arranging visits to places of interest; tourist office services; travel agency services, namely, making reservations and bookings for transportation; transportation reservation services, in International Class 39 and travel agency services, namely, making reservations and bookings for temporary lodging, in International Class 43, with "HOLIDAYS" disclaimed.

Applicant has, perhaps, overlooked the forest for the trees in presenting its case. The scope and importance of these eighteen registrations cannot be underestimated. The registrations, shown above, cover a significant num-

ber of variations on the VIRGIN marks. More importantly, the registrations for marks which consist of either VIRGIN alone in standard-character form or of VIRGIN alone in stylized script cover a vast variety of goods and services. They identify services ranging from transportation and travel, to bar services, to communications services, to online sales and retail store services for a wide variety of goods. The goods identified in the registrations range from audio and video recordings in varied forms, to clothing, to luggage, to publications, to stationary and office supplies, to alcoholic and nonalcoholic beverages.

As we stated above, among the eighteen VIRGIN registrations before us are opposer's Reg. No. 1851817 for the mark VIRGIN in standard-character form and Reg. No. 1852776 for the VIRGIN mark in special script. Each covers, among other services, "transportation of ... passengers by road..." Also, Reg. No. 2482726 for the mark VIRGIN ATLANTIC VACATIONS in standard-character form, which is also before us, covers, among other services, "transportation of ... passengers by road ... transportation of human beings by means of land vehicles ... automobile and motorcycle rental services; chauffeur services."

The registrations for variations on the VIRGIN mark identify still more goods and services. Mr. Branson, the Virgin Group and the VIRGIN brands have been the subject of numerous books and features. *See, e.g.*, Opposer's Test. Exh. 212-217. Mr. Branson has appeared on numerous telecasts in the United States, including on CNN, NBC and Fox where he has promoted the VIRGIN marks. Levin-Hyams Test. at 26-35. Thus, Mr. Branson's notoriety has attracted significant attention for himself, for the companies he owns and controls and for the VIRGIN marks.

\*11 In the United States, one of the principal services opposer offers under the VIRGIN mark is airline services. Opposer has offered this service since 1984. The service has operated between the United Kingdom and certain U.S. cities, including Boston, Las Vegas, Los Angeles, Miami, Newark, New York, Orlando, San Francisco and Washington, D.C. Bershefsky Test. at 9-10. Opposer offers many "extras" with its airline service, most notably limousine service to and from airports for departure and on arrival, including at airports opposer serves in the United States. Bershefsky Test. at 27-28. The "extras" have also included an amenities kit, a catalog and magazines featuring the VIRGIN marks. James Test. at 22.

While opposer is not one of the largest air carriers operating in the United States, the service it has provided is significant in terms of both length of service, revenue and numbers of passengers carried. *Id.* at 10 *et seq.* Opposer has conducted significant advertising related to its airline service in media including print, radio and television. *Id.* at 13. For example, opposer has run ads in major U.S. newspapers and magazines, including, *The New York Times*, *The Wall Street Journal*, *The Washington Post*, *The Boston Herald*, *The San Francisco Chronicle*, *The Los Angeles Times*, *Newsweek*, *Forbes*, *Fortune*, *The Economist*, and *Business Week*. *Id.* at 16-17.

The Virgin Group has also sold significant numbers of musical recordings under the VIRGIN mark in the United States since the early 1990s. James Testimony at 85. The Virgin Group has operated retail stores under the VIRGIN and VIRGIN MEGASTORE marks in as many as twenty major U.S. cities since 1992 (Test. Exh. 185); the Virgin Group also sells VIRGIN MEGASTORES' products online. The stores carry musical recordings, DVDs, clothing, books and magazines, games and other products. Many of the stores are located in prime, high visibility locations, such as, Times Square and Union Square in New York City, Michigan Ave. in Chicago, Mass. Ave. and Newbury St. in Boston, Market St. in San Francisco and Sunset Blvd. in Los Angeles. Block Test. at 19. The signage at these locations, as illustrated in Test. Exh. 189 showing the Time Square location, is highly visible.



Opposer has experienced substantial sales at its retail and online stores. Opposer has placed a substantial amount of advertising with regard to its stores in local and national print media, and on television and radio in the cities where the stores operate. *Id.* at 12. Over 31,000,000 people visited the stores in 2003. *Id.* at 19. The stores use/distribute approximately 8,000,000 shopping bags per year using the VIRGIN and VIRGIN MEGASTORE marks. *Id.* at 31. *See* Test. Exhs. 89 and 208. Opposer logs between 30,000 to 50,000 hits at its VIRGIN MEGASTORE web site each month. Opposer hosts approximately 300 in-store events per year at its stores. Block Test. at 51.

\*12 Opposer also provides a wide variety of communications services under the VIRGIN and VIRGIN MOBILE marks. Reg. No. 2625455, noted above, for the mark VIRGIN in standard character form, among other services, covers “computerized communication services, namely, electronic mail services, and providing networks for the purpose of transmission and reception of electronic mail, computer generated music, news and other data and information; and broadcasting services by radio and over a global computer network of a wide variety of programs, namely, current events, economics, politics, sports, entertainment, the arts and business.” Although the registration arguably does not cover cellular telephone service, Virgin Mobile renders the services referenced here, along with its cellular telephone service. Stohrer Test. at 13 and 67.

The rights conferred by the registration date from the filing date of December 17, 1998. Virgin Mobile began actively marketing its communication services in July 2002. *Id.* at 86.

Opposer uses both the VIRGIN and VIRGIN MOBILE marks consistently in the rendering of these communications services. Although, the VIRGIN MOBILE mark is not among the marks pleaded here, the VIRGIN MOBILE mark is consistently used/displayed in a manner where VIRGIN creates a distinct commercial impression apart from the generic MOBILE element which is consistently displayed less prominently and separate from VIRGIN as shown here:



VIRGIN appears in the familiar script form shown above. *See, e.g.,* Opposer Test. Exhs. 135-165 and 178. Thus, opposer has used the VIRGIN mark covered by its registration in conjunction with the communications services identified in the registration.

Opposer's use of the VIRGIN mark in conjunction with communications services has been extensive. Opposer has promoted the VIRGIN mark for its communications services primarily to the youth market over a wide geographic area. *Id.* at 11. Opposer offers its communications services through 12,000 outlets, including its own Virgin Megastores and major retailers, such as, Best Buy and Target. Opposer has expended significant sums in advertising and promoting its VIRGIN mark in connection with its communications services. *Id.* at 6. Opposer has advertised in virtually all forms of print and electronic media, in major magazines, through radio and over

national television, including MTV, BET, and Comedy Central, and on stations on the ABC, CBS, NBC and Fox networks. *Id.* st 54. Opposer has also conducted extensive promotions in relation to its communications services.

As a consequence of these efforts opposer has, in a relatively short period of time, secured significant recognition of its VIRGIN mark in connection with communications services. *Stohrer Test.* at 83.

**\*13** What is most impressive about opposer's advertising and promotional activities in general is the effectiveness of its public relations activities in addition to the placement of paid advertising. This applies to its airline services, its retail services and its communications services.

The promotions take many forms. For example, opposer conducted a "Virgin Across America" road show to promote its airline services. In this promotion opposer outfitted a tractor trailer to replicate the interior of its aircraft. The tour visited numerous locations across the United States and generated substantial publicity in the process. *See e.g., Test. Exh. 5, Bershefsky Test.* 122-123.

As we indicated, opposer conducts approximately 300 in-store events at its retail stores per year. These events include appearances by celebrities, such as recording artist Ricky Martin. *See Opposer's Test. Exh. 191, Newsday* article dated May 22, 2003.

The events also include promotions, such as one conducted in nine U.S. cities in conjunction with VOLVO, which featured the introduction of a new VOLVO model. The cars were displayed inside and outside the stores, and test drives were offered. The event featured a sweepstakes where the winner was flown from the United States to London and then Sweden where the winner selected a VOLVO automobile which was then shipped to the winner in the United States. *Egelhoff Test.* at 29. Another similar program was conducted in the stores with BMW in 2003. *Id.* at 50. The BMW promotion was conducted at all U.S. stores, and again, BMW automobiles were given to certain individuals. *Id.* at 51.

Opposer also ran the "Virgin College MegaTour" promotional program wherein its goods and services were promoted along with the goods of other companies, including auto companies, at numerous college campuses in the United States. *Id.* at 51. There was extensive media coverage of the college tour. *Test. Exh. 54.*

The impact of these promotions is evident. The record includes copies of several hundred articles featuring the Virgin Group and its VIRGIN branded goods and services. The publications where the articles appeared run the full gamut, from national to local, from magazines to newspapers, from general interest to special interest. They include local newspapers, among others, in Columbus (OH), Las Vegas, St. Petersburg, Spokane, Austin, Reading (PA), and Grand Rapids, as well as, *The Wall Street Journal*, *The Boston Globe*, *The New York Times*, *The Salt Lake Tribune*, *Newsday*, *The Washington Post*, and *The Arkansas Democrat Gazette*, and major magazines, such as *Forbes*, *Women's Wear Daily*, *Black Enterprise*, *Consumer Electronics*, *Daily Variety*, *Rolling Stone*, *The National Enquirer*, *People*, *Harper's*, *Business Week*, and many others. *See Test. Exhs. 30, 218-234 and 191-193.* The subject matter of the articles ranges from Mr. Branson, the performance of the Virgin Group businesses, the Virgin Group products and services and primarily opposer's promotional activities and events. In virtually all instances the VIRGIN marks are referenced. A *Wall St. Journal* article of May 14, 2004 even discusses the opposer's environmental programs. *Test. Exh. 191.*

**\*14** In sum, the record establishes that opposer's extensive and varied advertising and promotional activities have resulted in a widespread awareness of the VIRGIN marks.

Furthermore, opposer has provided an impressive record of its policing activities to enforce its rights in the VIRGIN marks. *See* Opposer's Notice of Rel. Exhs. 50-122.

#### B. Applicant

Applicant is a family-owned Ford and Mercury auto and truck dealership in Albion, Michigan where applicant sells and services new and used vehicles from one location. Vann Test. at 9, 15-16. William Ward Vann is part owner and principal manager of the business. *Id.* at 15-16. Applicant also sells vehicles through its dealership online. *Id.* at 35. In addition, applicant offers vehicle rentals in conjunction with its dealership in association with ENTERPRISE car rental. *Id.* at 9.

Applicant offers a program whereby customers may custom order a vehicle either at the dealership or online. Applicant uses the VIRGIN SALE, VIRGIN VEHICLE and VIRGIN PURCHASE marks in conjunction with this program. Applicant states, "The business strategy behind custom ordered new vehicles in conjunction with the marks is based on the perceived strong association that a consumer will make with the marks to custom ordered vehicles, the manufacturing element of the word 'virgin,' and 'the newness, purity, first-time element of the custom-ordered vehicle,'" Applicant's Brief quoting from Vann Test. 54 and 64. Applicant maintains an Internet site and uses its VIRGIN marks on that site. *Id.* at 17; App. Test. Exh. 6. Applicant states the following on its web site with regard to each of its VIRGIN marks:

**Virgin Vehicles** ® — Any vehicle of transportation custom ordered and custom manufactured for the first end user; not previously available to others; Virgin Ford.

**Virgin Purchase** ® — To acquire something by custom order and custom manufactured first, genuine and pure by sacrifice (money), to acquire a **Virgin Vehicle**®.

**Virgin Sale** ® - Selling or being sold that is custom ordered and custom manufactured for and by the first end user; genuine and pure, selling a **Virgin Vehicle**®.

App. Test. Exh. 6.

Applicant has used its VIRGIN marks since 2002. Vann Test. at 25. Ford Motor Company has asked applicant not to use the term "VIRGIN" in conjunction with its FORD mark. Vann Test. at 44. Applicant generally advertises locally. *Id.* at 15-16.

### VI. Discussion

#### A. Likelihood of Confusion

We first address opposer's claim of likelihood of confusion. The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977), sets forth the factors to be considered in determining likelihood of confusion. We must determine the issue of likelihood of confusion in each case based on the evidence of record relating to the factors. *In re Majestic Distilling Co.*, 315 F.3d 1301, 65 USPQ2d 1201, 1203-04 (Fed. Cir. 2003). Accordingly, we will discuss each of the factors as to which opposer or applicant have presented evidence or arguments.

#### **1. Fame**

**\*15** We begin our discussion with the *du Pont* factor related to the fame of opposer's mark because fame of the prior mark, if it exists, plays a dominant role in likelihood of confusion cases. *Recot, Inc. v. M. C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000).

In determining fame in this case we focus our attention on the VIRGIN mark itself, that is, VIRGIN alone in

standard-character form and VIRGIN in stylized script, as shown above. We conclude that VIRGIN has achieved significant fame in the fields of airline services, in the retail store and online sale of recorded music and related products and in the field of communications. In reaching these conclusions we have relied primarily on opposer's evidence with regard to (1) the length of time it has provided the relevant services under the VIRGIN mark, (2) the sales and advertising activities related to those services, and most importantly (3) the evidence opposer provided of the public recognition of the VIRGIN mark as used in conjunction with these services. The principal evidence of the public recognition of the mark is the evidence of the media attention opposer generated with regard to the VIRGIN mark as used in connection with these services as a result of opposer's advertising and promotional efforts. This evidence is impressive both in quality and quantity.

Applicant argues that the VIRGIN mark is not famous. Applicant questions both the quality and quantity of the evidence opposer presented to show fame. In particular, applicant asserts that opposer failed to show fame within a particular product or service category and that opposer failed to establish through its evidence that opposer is a leader in any of the fields in which it uses its mark. Applicant also asserts that opposer's evidence of fame should be rejected because it relates to a period after the filing of the applications and after the filing of these proceedings. Applicant's Brief at 19.

As to the quantity of evidence, in its argument applicant sets the bar very high. In so doing applicant fails to recognize the important difference between the standard for establishing fame for likelihood-of-confusion purposes as opposed to establishing fame for dilution purposes. As the Court of Appeals for the Federal Circuit has stated, "Fame for likelihood of confusion purposes and fame for dilution purposes, however, are distinct concepts. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (T.T.A.B. 2001). While dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame 'varies along a spectrum from very strong to very weak.' *In re Coors Brewing Co.* 343 F.3d 1340, 1341 [68 USPQ2d 1059] (Fed. Cir. 2003)." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

**\*16** We have concluded that opposer has established significant fame here for purposes of our consideration of likelihood of confusion. We need not and do not consider here whether or not opposer has established the high degree of fame required as an element of a dilution claim. Cf. *NASDAQ Stock Market Inc. v. Antarctica S.r.l.*, 69 USPQ2d 1718 (TTAB 2003); *Toro Co. v. ToroHead Inc.*, 61 USPQ 1164, 1173 (TTAB 2001).

As to the quality of opposer's evidence, here also applicant assumes a standard which is overly rigid. Applicant dismisses sales and advertising information as being insufficient and implies that opposer must show that it is an industry leader in the field in which it claims fame.

The evidence of fame in this case, when viewed in its totality, is more than sufficient to establish the fame of the VIRGIN mark in the field of airline services, communications and in the retail store and online sale of recorded music and related products. In fact, the type of evidence of record in this case parallels the evidence of fame in the *Palm Bay* case. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1695. Here we have evidence of use of the VIRGIN mark over a significant period of time, significant sales and significant advertising and promotional expenditures and activities. As we noted, the evidence of public recognition of the VIRGIN mark in the media, large and small, local and national, print and electronic, general interest and special interest, is critical to our finding of fame.

Contrary to applicant's contentions, we find none of the weaknesses in the evidence here the Board noted in the

*Blue Man Productions* case. Cf. *Blue Man Productions Inc. v. Tarrmann*, 75 USPQ2d 1811, 1819 (TTAB 2005). We note, in particular, that virtually all of the many hundreds of articles are, in fact, about opposer and its services. The mentions of opposer and the VIRGIN marks are not merely passing references.

We also reject applicant's implication that opposer must establish itself as an industry leader in relevant fields to show fame. We find no support in the cases for such an inflexible approach. Such an arbitrary rule would unduly limit the consideration of legitimate evidence of fame.

We likewise reject applicant's argument regarding the fields of use. In fact, we have considered fame in relation to specific goods and services, and we have limited our conclusion with regard to fame appropriately in that regard, that is, to the fields of airline services, communications and to the retail store and online sale of recorded music and related products.

Finally, we reject applicant's contention that we should not consider opposer's evidence of fame which relates to a period after the filing of its applications or after the filing of these proceedings. We find no support for this proposition. Again, there is an important distinction between likelihood of confusion and dilution in this regard. The Trademark Act requires that a party asserting dilution in an opposition proceeding must establish that its mark had become famous prior to the filing date of an intent-to-use application. *Toro Co. v. ToroHead Inc.*, 61 USPQ at 1174. In contrast the Trademark Act provides no such limitation in the presentation of evidence of distinctiveness. For example, Trademark Act § 2(f) simply provides that a prima facie claim of distinctiveness assert use "... for the five years before the date on which the claim of distinctiveness is made." 15 U.S.C. 1052(f). Also, the Board generally accepts and considers evidence related to likelihood of confusion and similar issues for the period up to the time of trial. We see no reason to treat evidence of fame differently. Accordingly, we have considered opposer's evidence of fame without regard to whether it relates to a time period before or after the filing of the applications at issue here or these proceedings.

\*17 Accordingly, we conclude that opposer's VIRGIN mark has achieved significant fame in the fields of airline services, communications services and in the retail store and online sale of recorded music and related products.

The degree of fame shown here entitles opposer to a significantly broader scope of protection than would otherwise apply for its VIRGIN marks. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). This factor favors opposer.

## 2. The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692.

As a preliminary matter we must address opposer's claim that it has a family of VIRGIN marks. The Federal Circuit characterizes a family of marks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but also the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

*J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

The Board has specified the following requirements to establish a family of marks: "... it must be shown by competent evidence 'first, that prior to the entry into the field of the opponent's mark, the marks containing the claimed "family" feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the "family" feature; and second, that the "family" feature is distinctive (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark).' *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 65-66 (TTAB 1983)." *Marion Laboratories v. Biochemical/Diagnostics*, 6 USPQ2d 1215, 1218 (TTAB 1988).

Although opposer refers to its family of marks in the notices of opposition, opposer does not identify which marks are members of that family in the notices. Notices of Opp. ¶¶ 19 and 22. *Cf. Marion Laboratories v. Biochemical/Diagnostics*, 6 USPQ2d at 1216-17. Likewise, in its briefs opposer fails to identify the marks it considers within the family. Nor does opposer address the "family-of-marks" issue in general directly in its brief. Accordingly, in determining whether the VIRGIN marks constitute a family of marks, we have considered all of the marks identified in the eighteen registrations noted above as potential members of the family. Furthermore, we have considered whether "a substantial number of them were used and promoted together." *Id.* In this enormous record, we have identified a few examples of instances where a number of the VIRGIN marks appeared together. For example, in Test. Exh. 56, taken from one of opposer's web sites, we noted uses of the VIRGIN mark along with VIRGIN ATLANTIC, and VIRGIN VACATIONS, as well as a number of unpleaded variations of the VIRGIN marks, such as, VIRGIN MOBILE, and READIOFREEVIRGIN. However, we have not found sufficient evidence of the type of use and promotion of the potential marks in the family to conclude that there is a family of VIRGIN marks. Accordingly, for purposes of our comparison of the marks in this case, we will not consider the VIRGIN marks as a family of marks. Therefore, we must compare each of opposer's VIRGIN marks at issue in this proceeding with the marks in the opposed applications.

**\*18** We begin that analysis by noting that, while we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, "... in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

With regard to opposer's marks, we first note the registrations which opposer has pleaded and made of record, shown above, which cover either VIRGIN alone in standard-character form or VIRGIN alone in stylized script, that is, ten of the eighteen registrations which are properly of record. As we noted above, these registrations, considered alone, cover a wide variety of goods and services, most notably, all of the services in connection with which we have concluded the VIRGIN mark has become famous.

Secondly, we consider those registrations for standard-character marks which consist of only the word VIRGIN and disclaimed wording which is either descriptive or generic, that is, VIRGIN MEGASTORES, VIRGIN VACATIONS, VIRGIN VODKA and VIRGIN HOLIDAYS. These four registrations add marginally to the scope of the goods and services covered by the ten registrations noted above. In fact, the ten registrations noted cover substantially all of the significant goods and services covered by the eighteen registrations.

Accordingly, for purposes of our consideration of opposer's marks, we have considered only the marks in the ten registrations noted above, those which consist of VIRGIN without any other wording or separate design element. We conclude that the word VIRGIN is either the only or the dominant element in each of these marks. The design element, that is, the script and underlining in the special-form marks, in no way detracts from the dominance of VIRGIN in these marks. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

Likewise, in analyzing applicant's marks, VIRGIN VEHICLE, VIRGIN PURCHASE and VIRGIN SALE, we conclude that the dominant element in each of these marks is also VIRGIN. Here also, the only additional element in each case is a disclaimed term which is either descriptive or generic, VEHICLE, PURCHASE and SALE, respectively. Therefore, we conclude that the additional elements in each of these marks in no way detracts from the dominance of VIRGIN in each of applicant's marks.

Furthermore, as to the marks of both opposer and applicant before us here, we note that in each of the marks VIRGIN is the first word. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("... [it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.").

\*19 The only significant arguments applicant raises with regard to the similarity or dissimilarity of the parties' marks are (1) that the marks, when viewed in their entirety, differ, and (2) that VIRGIN is a weak, suggestive term.

It is apparent from our discussion here that we reject applicant's argument regarding the comparison of the marks in their entirety. We have considered the marks in their entirety and conclude that VIRGIN is the dominant element in the marks of both parties.

Turning to applicant's argument regarding the strength of VIRGIN, we will address applicant's argument and evidence on that point below under the appropriate factor.

Finally, we have concluded that each of opposer's VIRGIN marks in the ten registrations noted here is similar to each of applicant's marks. In reaching these conclusions we have considered the marks, in every instance, in their entirety. This factor favors opposer.

### **3. The Number and Nature of Similar Marks in Use on Similar Goods.**

Applicant argues that opposer's VIRGIN marks are weak as a result of third-party uses of "virgin." At the outset we note our conclusion above that opposer's VIRGIN mark has achieved significant fame, a conclusion which necessarily requires the further conclusion that opposer's mark is strong and not weak.

Applicant introduced evidence in support of its position, specifically: records of active and dead third-party registrations, not owned by opposer, for marks which include "VIRGIN"; records of live and dead approved, pending applications fitting the same description; records of Board proceedings brought by opposer against marks which include "VIRGIN "; copies of certain responses by opposer to applicant's discovery; certain exhibits from opposer's testimony deposition of Mr. Vann; and examples of various uses of "virgin" in publications. Applicant introduced all of this evidence by notice of reliance. We have reviewed all of the evidence carefully and conclude that it fails to establish that opposer's VIRGIN mark is weak.

First we note that third-party registrations are entitled to little weight on the question of likelihood of confusion. *See, e.g., In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Such registrations are not evidence that the marks are in use or that the public is familiar with them. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). As the Federal Circuit has stated, “[t]he probative value of third-party trademarks depends entirely upon their usage.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d at 1693. As to the dead registrations, such registrations ordinarily have no evidentiary weight. *See Mattel, Inc. v. Funline Merchandise Co., Inc.*, 81 USPQ2d 1372 (TTAB 2006). Likewise, records of pending applications, regardless of status, lack probative value for our purposes here.

**\*20** Furthermore, the active registrations applicant submitted provide no support for its position. First, the majority of the registrations involve marks which simply have no relevance to the issues in these proceedings. The majority of the active registrations, all but five of the forty-two provided, involve marks which either (1) include VIRGIN or EXTRA VIRGIN used generically as applied to olive oil or similar goods, or (2) marks which include VIRGIN ISLANDS used in its geographical sense.

The remaining five registrations are: VIRGIN SPRINGS for bottled water (Applicant's Not. of Rel. Exh. 3); VIRGIN BOURBON for whiskey (Exh. 5); K PORT NATURAL SPRING WATER EXTRA VIRGIN and design with “EXTRA VIRGIN” disclaimed for natural spring water (Exh. 18); VIRGIN HAIR & AFRO on the Supplemental Register with “VIRGIN HAIR” disclaimed for hair styling preparations and skin moisturizers (Exh. 33); and REBORN VIRGIN for books (Exh. 34). Even if we were to presume that these marks were in use, and we do not, the use would be insufficient to establish that opposer's VIRGIN marks are weak.

The records of the proceedings brought by opposer with regard to third-party VIRGIN marks, in fact, provide evidence of opposer's policing efforts and, on balance, support the conclusion that opposer's VIRGIN mark is a strong mark.

As to the publications, the only exhibits which have any relevance with regard to the strength or weakness of opposer's mark are: a *Chicago Tribune* article referencing the EXTRA VIRGIN restaurant opening eight weeks earlier in Chicago (Exh. 205); an article from the *Washington Times* referencing the opening of another EXTRA VIRGIN restaurant in Virginia (Exh. 106); and an item from the *Las Vegas Review Journal* referencing a contract involving “the Virgin River hotel-casinos in Mesquite” (Exh. 207). (Ex. 218 refers to the Virgin mountains and the Virgin River Gorge in Arizona which may be related.)

The remainder of the publications include uses of “virgin” in its descriptive or generic sense, not as a mark or even part of a mark -- for example, “virgin snow” (Exh. 220), “virgin aluminum” (Exh. 255), “virgin iron ore” (Exh. 256) and “virgin forest” (Exh. 269). Applicant also includes a dictionary definition of “virgin” (Exh. 201). Furthermore, applicant includes exhibits related to its own use from the Vann deposition to support its general argument that opposer's VIRGIN marks are weak, arguing that its own uses are suggestive.

We find none of applicant's evidence intended to show that opposer's VIRGIN mark is weak persuasive. The fact that “virgin” has a dictionary meaning and is used in its dictionary sense in no way precludes a party, such as opposer, from adopting it as a mark and developing a strong or famous mark. *Chicago Bears Football Club Inc. v. 12th Man/Tennessee LLC*, 83 USPQ2d 1073, 1081-82 (TTAB 2007). Applicant's evidence shows either use of “virgin” in its dictionary sense, and a few isolated potential uses of “virgin” in marks. There is no evidence of any significant use by third parties of VIRGIN marks. Furthermore, we have no evidence that applicant's own use of VIRGIN in the marks at issue here, whether suggestive or not, has in any way detracted from the strength



of opposer's VIRGIN marks. Accordingly, we conclude that opposer's VIRGIN mark is a strong mark possessing a significant degree of fame. This factor favors opposer.

#### 4. The Goods and Services and Channels of Trade

**\*21** The goods and services of opposer and applicant need not be identical to find likelihood of confusion under Section 2(d) of the Trademark Act. They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods or services originate from the same source. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). See also *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods and services we must consider the goods and services as identified in the application and registrations. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

Applicant argues that its "automobile and truck dealerships" are far removed from any of the goods and services offered by opposer under its VIRGIN marks. Applicant states, "In response to discovery requests, VEL [opposer] acknowledged that it does not have a retail facility for selling vehicles in the United States, that it has never sold vehicles in the United States, and that it possesses no documents evidencing plans to utilize any mark with the term VIRGIN in association with the retail sale of automobiles and trucks in the United States. (App. NOR EXS. 198-200)." Applicant's Brief at 9. Applicant also points out that certain Virgin Group officials indicated in testimony that they had no knowledge of any Virgin Group plans to sell vehicles in the United States. *Id.* at 10-11. Applicant also asserts that opposer failed to provide any evidence that opposer's goods and services are related to applicant's services.

On the other hand, opposer states, "The services specified in the opposed applications, "automobile and truck dealerships," are closely related to automobile transportation, retail store, and online shopping services recited in Opposer's registrations and actually provided by the Virgin Group companies as described above." Opposer's Brief at 27. Opposer also points to its BMW and Volvo promotions as evidence that the goods and services of the parties are related.

**\*22** We conclude that the goods and services identified in opposer's eighteen registrations are related to the automobile and truck dealership services identified in the applications at issue in view of the wide variety of goods and services identified in opposer's registrations and the fame of the VIRGIN mark. We might reach a different conclusion if we looked at each of opposer's goods and services in isolation in relation to applicant's services. However, the circumstances surrounding the marketing of opposer's goods and services when viewed as a whole, that is, considering the wide variety in opposer's goods and services, and the fame of opposer's mark, lead us to conclude that relevant purchasers would perceive that the goods and services of the parties are related.

Below, we discuss further the impact of opposer's use of its VIRGIN marks on the wide variety of goods and services identified in the registrations under eighth *du Pont* factor.

Although opposer did present evidence of its use of the VIRGIN mark in the United Kingdom in conjunction with the sale of automobiles, that use is not relevant for purposes of these proceedings and we have not considered that use in reaching our conclusion here. We reject opposer's argument that those activities somehow extend into the United States. We note that none of the registrations which are of record here cover those services, nor did opposer otherwise plead use of its mark on such services in the United States.

We also agree with applicant that the mere fact that one can navigate from opposer's sites to sites which do offer cars for sale establishes the necessary relationship in the minds of consumers between opposer's goods and services and applicant's automobile and truck dealerships and we have not relied on that evidence in reaching our conclusion here. The relationship here is too attenuated; taken to its logical limit, the argument would support a relationship between virtually any goods or services which are offered online.

Likewise, we agree with applicant that opposer's limited sales of vehicles used by Virgin Limo fails to establish that the goods and services of the parties are related. Again, opposer did not plead that it used its VIRGIN mark in the sale of automobiles, nor is this service covered by opposer's registrations which are before us in these proceedings. Furthermore, the sales of cars here is merely incidental to the rendering of the limousine service. The cars were merely purchased for use in conducting the business and disposed of when they were no longer suitable for such use.

On the other hand, applicant attaches undue probative value to the statements by opposer's witnesses that they had no knowledge of any plans by opposer to sell automobiles or trucks under the VIRGIN mark in the United States. This testimony is not probative of the perception of relevant purchasers. In fact, the record includes a *Wall Street Journal* article discussing opposer's innovative methods for selling automobiles of varied manufacturers under the VIRGIN mark in the United Kingdom. The article discusses both opposer's interest in the doing the same in the United States and obstacles in bringing that business to the United States. This article shows that at least some people in the United States may be aware of opposer's use of the VIRGIN mark in relation to automobile sales and the possibility it might do so in the United States. We hasten to add that it is the wide variety of opposer's goods and services and the fame of its mark which leads us to conclude that the goods and services of the parties are related, and not this specific evidence.

**\*23** Accordingly, we conclude that the goods and services of the parties are related. This factor favors opposer.

Turning to the channels of trade, here also we must look to the goods and services identified in the registrations and applications of the parties to determine whether there are related. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991).

Based on the same analysis we conducted with regard to the parties' goods and services, we conclude that the channels of trade are related. Applicant's goods and services, as identified, for the most part would be sold or rendered to the general public. Applicant's services, as identified, would also be rendered to the general public. Again, the wide variety of opposer's goods and services likewise travel in varied trade channels. Under the circumstances potential customers are likely to perceive that the trade channels could extend to applicant's trade channels. Accordingly, we also conclude that the parties' trade channels are related. This factor favors opposer.

#### **5. The Variety of Goods on Which a Mark is Used**

The *du Pont* case directs us to consider evidence regarding the variety of goods [or service] with which the mark is used under the eighth *du Pont* factor. As already discussed, in this case we have significant evidence on this

factor. As we noted above, the eighteen registrations on which opposer relies identify a wide variety of goods and services covering a diverse collection of goods and services. *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1662 (TTAB 2002). The registrations which cover the VIRGIN mark by itself either in standard form or script identify services ranging from transportation and travel, to bar services, to communications services, to online sales and retail store services for a wide variety of goods. The goods identified in these registrations range from audio and video recordings in varied forms, to clothing, to luggage, to publications, to stationary and office supplies, to alcoholic and nonalcoholic beverages. On the basis of these registrations we conclude that opposer's goods and services include a wide variety and that this factor favors opposer.

We also note the significance of this factor in our overall analysis - if consumers have been exposed to use of a mark, especially a famous mark, on a wide variety of goods and services from one party they are more likely to believe that the use of the mark has been extended by the same party to additional goods or services.

#### **6. Actual Confusion**

Applicant argues that there has been no actual confusion, presumably to support its position that there is no likelihood of confusion. Applicant's Brief at 28. It is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990).

\*24 In this case, Mr. Vann, who is an owner of applicant and the only witness connected with applicant, states that applicant used its VIRGIN marks since 2002; he is noncommittal as to any earlier use. Vann Test. at 25. Applicant operates from a single location in Albion, Michigan and generally advertises locally. *Id.* at 15-16. Applicant maintains an Internet site and uses its VIRGIN marks on that site. *Id.* at 17; Test. Exh. 34. Mr. Vann indicated that so far as he knew applicant did not maintain records regarding the numbers of visitors to applicant's web site. *Id.* at 24. The applications at issue here are intent-to-use applications; the record shows use of the marks in a limited area for a limited period of time. We have no evidence regarding the impact of the use of the marks on the Internet. Accordingly, on this record, we must conclude that the opportunity for confusion is minimal.

Under the circumstances, the absence of actual confusion is of little or no probative value with regard to the likelihood of confusion. The Federal Circuit has stated, "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight (citation omitted) ..." *Majestic*, 65 USPQ2d at 1205. See also *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-27 (TTAB 1984).

Accordingly, we conclude that the actual-confusion factor is neutral in this case.

#### **7. Purchaser Sophistication**

Applicant states, "Further, the Board will recognize that automobiles and trucks are expensive goods and consumers and potential consumers of Albion Motors' services are, thus, elevated to the standard of 'discriminating purchasers.'" (Citations omitted.) Applicant's Brief at 24. Opposer disagrees and notes, among other things, the potential for initial interest confusion. Opposer's Reply Brief at 15.

We agree with applicant's point that potential purchasers of automobiles and trucks are likely to exercise a higher degree of care than purchasers of less expensive items. However, those purchasers would include the general

public; the class of purchasers is not restricted to persons possessing special knowledge or expertise. Even sophisticated purchasers are not immune from trademark confusion. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

On this record, on balance we conclude that applicant's customers are not less likely to be confused as a result of the higher level of care associated with vehicle purchases. Accordingly, we conclude that the evidence in this application bearing on the sophistication of the potential purchasers fails to indicate a diminished likelihood of confusion. This factor is neutral.

### 8. Bad Faith

\*25 Opposer has suggested, at least indirectly, that applicant adopted its VIRGIN marks in bad faith. Applicant disputes this implication. We must look to the record to see whether opposer has established bad faith. *See Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1899; *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d at 1820. Although Mr. Vann was somewhat evasive in responding to questions regarding applicant's intent in adopting the marks, we conclude that there is no evidence here of bad faith.

Therefore, we have not considered bad faith as a factor in this case.

### 9. Conclusion

We have considered all evidence properly of record in these proceedings bearing on the factors set forth in *du Pont* and conclude that there is a likelihood of confusion between opposer's VIRGIN marks when used in connection with the goods and services identified in the registrations relied upon here and applicant's VIRGIN VEHICLE, VIRGIN PURCHASE and VIRGIN SALE marks for automobile and truck dealerships. We conclude so principally based on the similarity of the marks of the parties, the fame of opposer's mark and the variety of goods and services with which opposer's mark is used. We note finally that we have given full consideration to all competent evidence and all arguments raised in this case whether or not we have discussed them specifically.

### B. Dilution

Opposer also asserts dilution as a ground for opposition. In view of our decision to sustain the oppositions on the ground of likelihood of confusion, it is not necessary for us to consider opposer's dilution claim.

**Decision:** The opposition is sustained on the ground of likelihood of confusion and registration is refused in each of the three applications in these proceedings.

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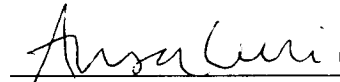
I hereby certify that this paper or fee, **APPENDIX OF CASES TO TRIAL BRIEF OF OPPOSER UMG RECORDINGS, INC., PURSUANT TO OFFICIAL GAZETTE NOTICE OF 23 JANUARY 2007**, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" on the date indicated above and is addressed to: UNITED STATES PATENT AND TRADEMARK OFFICE, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451.



Alexa L. Lewis

**CERTIFICATE OF SERVICE**

I hereby certify that on this 12th day of January, 2010, a true and correct copy of the foregoing **APPENDIX OF CASES TO TRIAL BRIEF OF OPPOSER UMG RECORDINGS, INC., PURSUANT TO OFFICIAL GAZETTE NOTICE OF 23 JANUARY 2007**, was served upon Opposer's counsel of record by hand delivery, to the following address: Lawrence Y. Iser, Patricia A. Millett, Chad R. Fitzgerald, Kinsella, Weitzman, Iser, Kump & Aldisert LLP, 808 Wilshire Boulevard, 3rd Floor, Santa Monica, CA 90401.



Alexa L. Lewis